

BULKY DOCUMENTS

W/ Exhibits (exceeds 300 pages)

Proceeding/Serial No: 91170863

Filed: 09-11-2007

Title: Deposition of Mark Stiller

Part 6 of 6

Document contains two DVD disk marked "Exhibit 34 and 35" concerning mark.



This page was generated by the TARR system on 12/12/2002 10:37:44 ET

Serial Number: 78041895

Registration Number: 2659435

Mark (words only): HYDRA-DETENTE

Current Status: Registered.

Date of Status: 2002-12-10

Filing Date: 2001-01-05

Registration Date: 2002-12-10

Law Office Assigned: TMO Law Office 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 650 - Publication And Issue Section

Date In Location: 2002-12-10

CURRENT APPLICANT(S)/OWNER(S)

1. Beaute Createurs (Societe Anonyme)

Address:

Beaute Createurs (Societe Anonyme) 10 RUE DE LA PAIX 75002 Paris, France

State or Country of Incorporation: France

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Non-medicated skin care and cleaning preparations, namely, cream, milk, lotion, serum, gel, fluid, and oil for moisturizing the body, face and eyes; non-medicated cellulite-reducing skin lotions and skin gels; cleansing, moisturizing, anti-aging, and non-medicated anti-wrinkle facial masks; non-medicated moisturizing lip masks; anti-wrinkle cream for eyes; massage oil; talcum powder; sun products, namely, sun screen, suntanning oils and lotions, sun block, after-sun cream, self-tanning milk and cream, accelerated tanning cream; cosmetics, namely, skin soap, make-up remover, lip and eye make-up remover, nail polish, dentifrices, depilatories, liquid foundation, tinted skin creams, make-up, powder and cream blusher, lipstick, mascara, eye shadow, eye-liner pencil; perfumes, namely, perfumed water,

toilet water, cologne water, scented water, perfumed talcum powder, perfumed skin cream, perfumed body oils, perfumed skin cleansing foam, essential oils for personal use; perfumed bath products, namely, body lotions, body powder, body oils and personal deodorants; hair care preparations, namely, shampoo, conditioners, sprays, lotions, hair gels, mousse, masks, foams, sun screen and hair color; Nonmedicated skin care and cleaning preparations, namely, cream, milk, lotion, serum, gel, fluid, and oil for moisturizing the body, face and eyes; non-medicated cellulite-reducing skin lotions and skin gels: cleansing, moisturizing, anti-aging, and non-medicated anti-wrinkle facial masks; non-medicated moisturizing lip masks; anti-wrinkle cream for eyes; massage oil; talcum powder; sun products, namely, sun screen, suntanning oils and lotions, sun block, after-sun cream, self-tanning milk and cream, accelerated tanning cream; cosmetics, namely, skin soap, make-up remover, lip and eye make-up remover, nail polish, dentifrices, depilatories, liquid foundation, tinted skin creams, make-up, powder and cream blusher, lipstick, mascara, eye shadow, eye-liner pencil; perfumes, namely, perfumed water, toilet water, cologne water, scented water, perfumed talcum powder, perfumed skin cream, perfumed body oils, perfumed skin cleansing foam, essential oils for personal use; perfumed bath products, namely, body lotions, body powder, body oils and personal deodorants; hair care preparations, namely, shampoo, conditioners, sprays, lotions, hair gels, mousse, masks, foams, sun screen and hair color **International Class: 003**

First Use Date:

First Use in Commerce Date:

Basis: 44(e)

ADDITIONAL INFORMATION

Translation: APPLICANT SUBMITS THAT "HYDRA" IS THE ABBREVIATION OF THE WORD MEANING "MOISTURIZING" AND THE ENGLISH TRANSLATION OF THE WORD DETENTE IS "RELAXATION".

Foreign Application Number: 0087380 Foreign Registration Number: 0087380 Foreign Registration Date: 2000-07-07

Country: Benelux

Foreign Filing Date: 2000-07-07 Foreign Expiration Date: 2010-07-07

PROSECUTION HISTORY

2002-12-10 - Registered - Principal Register

2002-05-30 - Extension of time to oppose - Filed

2002-04-16 - Published for opposition

2002-03-27 - Notice of publication

2001-11-09 - Section 44(d) claim - Deleted

2001-12-17 - Approved for Pub - Principal Register (Initial exam)

Latest Status Info Page 3 of 3

2001-11-09 - ITU claim deleted

2001-11-09 - Communication received from applicant

2001-10-30 - Letter of suspension mailed

2001-08-15 - Communication received from applicant

2001-06-13 - Non-final action mailed

2001-05-25 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Elizabeth H. Cohen (Attorney of record)

ELIZABETH H. COHEN
ARENT FOX KINTNER PLOTKIN & KAHN PLLC
1050 CONNECTICUT AVE NW
WASHINGTON DC 20036-5303
United States

Domestic Representative ELIZABETH H. COHEN





UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Thu Dec 12 04:10:42 EST 2002

	TRADEMARK Next List	TESS HOME FIRST DOC			FREE FORM		Воттом	HELP	PREV LIST	
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Typed Drawing

Word Mark I.D. INDIVIDUAL DEMANDS

Goods and **Services**

IC 003. US 001 004 006 050 051 052. G & S: Hair Products, namely, shampoos, conditioners, hairspray, reconstructor and Styling Preparations, styling pomade, styling gel, styling wax, and haircolor; For Skin Care Products, namely, moisturizers, toners, lotions, foaming bath, face cream, bar soap, facial scrub, liquid soap, shower gel; For Men's Prepatory Products, namely shaving cream, shaving lotion, after shave lotion, after shave gel, cologne, perfume, deodorant, fragranced body sprays, body washes, suntanning creams. FIRST USE: 20000501. FIRST USE IN COMMERCE: 20000501

Mark

Drawing

(1) TYPED DRAWING

Code

Serial Number

78018522

Filing Date

July 26, 2000

Published for

August 28, 2001

Opposition

Registration

2510582

Number

Registration

November 20, 2001

Date Owner

(REGISTRANT) Hawaii Beauty Products, Inc. CORPORATION CALIFORNIA 3190

S. Bascom Ave. #100 San Jose CALIFORNIA 95124

Type of

Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead Indicator

LIVE

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CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

This page was generated by the TARR system on 12/12/2002 10:42:51 ET

Serial Number: 78018522

Registration Number: 2510582

Mark (words only): I.D. INDIVIDUAL DEMANDS

Current Status: Registered.

Date of Status: 2001-11-20

Filing Date: 2000-07-26

Registration Date: 2001-11-20

Law Office Assigned: TMEG Law Office 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 - Warehouse (Newington)

Date In Location: 2001-12-04

CURRENT APPLICANT(S)/OWNER(S)

1. Hawaii Beauty Products, Inc.

Address:

Hawaii Beauty Products, Inc. 3190 S. Bascom Ave. #100 San Jose, CA 95124 United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hair Products, namely, shampoos, conditioners, hairspray, reconstructor and Styling Preparations, styling pomade, styling gel, styling wax, and haircolor; For Skin Care Products, namely, moisturizers, toners, lotions, foaming bath, face cream, bar soap, facial scrub, liquid soap, shower gel; For Men's Prepatory Products, namely shaving cream, shaving lotion, after shave lotion, after shave gel, cologne, perfume, deodorant, fragranced body sprays, body washes, suntanning creams

International Class: 003 First Use Date: 20000501

First Use in Commerce Date: 20000501

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-03-15 - TEAS Change of Correspondence Received

2001-11-20 - Registered - Principal Register

2001-08-28 - Published for opposition

2001-08-08 - Notice of publication

2000-12-29 - Approved for Pub - Principal Register (Initial exam)

2000-12-22 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
DAVID H. JAFFER
PILLSBURY WINTHROP LLP
2550 HANOVER STREET
PALO ALTO CA 94304-1115
United States



UNITED STATES PATENT AND TRADEMARK OFFICE



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Please logout when you are done to release system resources allocated for you.									
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Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark

BODY INVEST

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: shampoo, conditioner, hair spray, gel and mousse, body and face moisturizers and lotions, body oils, soap, shaving cream and gel, and suntanning preparations. FIRST USE: 20000103. FIRST USE IN

COMMERCE: 20000103

Mark Drawing

(1) TYPED DRAWING

Code

Serial Number 76353239

Filing Date

December 31, 2001

Published for

August 27, 2002

Opposition

Registration Number

ⁿ 2651844

Registration

Regist Date November 19, 2002

Owner

(REGISTRANT) NORVELL, GREGORY A. INDIVIDUAL UNITED STATES 115

Edgewood Street Alexandria TENNESSEE 37012

Attorney of

Record

Donn K. Harms, Esq.

Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BODY" APART

FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead Indicator

LIVE

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSEDIET TOP HELP PREV LIST CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

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Serial Number: 76353239

Registration Number: 2651844

Mark (words only): BODY INVEST

Current Status: Registered.

Date of Status: 2002-11-19

Filing Date: 2001-12-31

Registration Date: 2002-11-19

Law Office Assigned: TMEG Law Office 107

If you are the applicant or applicant's attorney and have questions about this file, please contact

the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2002-11-19

CURRENT APPLICANT(S)/OWNER(S)

1. NORVELL, GREGORY A.

Address:

NORVELL, GREGORY A. 115 Edgewood Street Alexandria, TN 37012

United States

Country of Citizenship: United States

Legal Entity Type: Individual

GOODS AND/OR SERVICES

shampoo, conditioner, hair spray, gel and mousse, body and face moisturizers and lotions, body oils, soap, shaving cream and gel, and suntanning preparations

International Class: 003 First Use Date: 20000103

First Use in Commerce Date: 20000103

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "BODY"

PROSECUTION HISTORY

2002-11-19 - Registered - Principal Register

2002-08-27 - Published for opposition

2002-08-07 - Notice of publication

2002-04-29 - Approved for Pub - Principal Register (Initial exam)

2002-04-25 - Case file assigned to examining attorney

2002-04-25 - Examiner's amendment mailed

2002-04-19 - Non-final action mailed

2002-04-11 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Donn K. Harms, Esq. (Attorney of record)

DONN K. HARMS, ESQ.
PATENT & TRADEMARK LAW CENTER
12702 VIA CORTINA
SUITE 100
DEL MAR, CA 92014
United States



UNITED STATES PATENT AND TRADEMARK OFFICE



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Check S	Status (T.A.	RR conta	ins curre	nt status. d	correspon	dence ada	lress and	attorney	of record f	or this	

mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark COSMETOTALE

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Non-medicated cosmetic preparations for slimming purposes, namely, creams for cellulite reduction, lotions for cellulite reduction, non-medicated suntanning preparations, namely, sun creams, sun tan gel, sun tan lotion, sun tan oil, aromatherapy oils, astringents for cosmetic purposes, non-medicated cosmetic preparations for bath and shower, namely, bath beads, bath gel, shower gel, bath oil, non-medicated bath salts, beauty masks, non-medicated mouthwash, hair lotions, cosmetic kits comprised of skin creams, skin lotions, hair gel, hair pomade, nail cream, nail strengtheners, gel for tired legs; cosmetics pencils, skin creams, make-up removers, dentifrices, depilatories, personal deodorants, scented body spray, toilet water, essential oils for personal use, make-up, non-medicated body oil, non-medicated body milk, skin lotions, facial lotions, body lotions, non-medicated after-shave lotions, nail care preparations, perfumes, make-up powder, non-medicated shaving preparations, lipsticks, toilet soaps, disinfectant cosmetic soaps, hair shampoo, hair care preparations, talcum powder, lip cream

IC 005. US 006 018 044 046 051 052. G & S: medicated sunburn ointments, dietary drink mix for use as a meal replacement, medicated mouthwash, dietary food supplements, diet capsules, medicinal herbs, herbal tea for medicinal purposes, nutritional supplements containing **preparations** of trace elements comprised of amino acids, mineral salts, metallic salts of natural origin, lactoferments, macro-elements and plant extracts for human use; medicated skin care **preparations**, mineral food supplements, pharmaceutical **preparations** for the treatment of perspiration, vitamin supplements

Mark

Drawing

(1) TYPED DRAWING

Code

Serial

76005301

Number Filing Date

March 20, 2000

Filed ITU

FILED AS ITU

Published

for

August 6, 2002

Opposition

Registration 2641616

Number

Registration Date

October 29, 2002

Owner

(REGISTRANT) LABORATOIRES ROBERT SCHWARTZ CORPORATION FRANCE Parc d'Innovation Boulevard Gonthier d'Andernach 67400 ILLKIRCH

GRAFFENSTADEN FRANCE

Attorney of

Record

Lawrence E. Abelman

Section 44

SECT44

Indicator

Priority Date

October 6, 1999

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead

Indicator

LIVE

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT

TOP

CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

This page was generated by the TARR system on 12/12/2002 10:45:29 ET

Serial Number: 76005301

Registration Number: 2641616

Mark (words only): COSMETOTALE

Current Status: Registered.

Date of Status: 2002-10-29

Filing Date: 2000-03-20

Registration Date: 2002-10-29

Law Office Assigned: TMO LAW OFFICE 116

If you are the applicant or applicant's attorney and have questions about this file, please contact

the Trademark Assistance Center at Trademark Assistance Center@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-12-02

CURRENT APPLICANT(S)/OWNER(S)

1. LABORATOIRES ROBERT SCHWARTZ

Address:

LABORATOIRES ROBERT SCHWARTZ
Parc d'Innovation Boulevard Gonthier d'Andernach
67400 ILLKIRCH GRAFFENSTADEN,
France

State or Country of Incorporation: France

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Non-medicated cosmetic preparations for slimming purposes, namely, creams for cellulite reduction, lotions for cellulite reduction, non-medicated suntanning preparations, namely, sun creams, sun tan gel, sun tan lotion, sun tan oil, aromatherapy oils, astringents for cosmetic purposes, non-medicated cosmetic preparations for bath and shower, namely, bath beads, bath gel, shower gel, bath oil, non-medicated bath salts, beauty masks, non-medicated mouthwash, hair lotions, cosmetic kits comprised of skin creams, skin lotions, hair gel, hair pomade, nail cream, nail strengtheners, gel for tired legs; cosmetics pencils, skin creams, make-up removers, dentifrices, depilatories, personal deodorants, scented body spray, toilet water, essential oils for personal use, make-up, non-medicated body oil, non-medicated body milk, skin

lotions, facial lotions, body lotions, non-medicated after-shave lotions, nail care preparations, perfumes, make-up powder, non-medicated shaving preparations, lipsticks, toilet soaps, disinfectant cosmetic soaps, hair shampoo, hair care preparations, talcum powder, lip cream

International Class: 003

First Use Date:

First Use in Commerce Date:

Basis: 44(e)

medicated sunburn ointments, dietary drink mix for use as a meal replacement, medicated mouthwash, dietary food supplements, diet capsules, medicinal herbs, herbal tea for medicinal purposes, nutritional supplements containing preparations of trace elements comprised of amino acids, mineral salts, metallic salts of natural origin, lactoferments, macro-elements and plant extracts for human use; medicated skin care preparations, mineral food supplements, pharmaceutical preparations for the treatment of perspiration, vitamin supplements

International Class: 005

First Use Date:

First Use in Commerce Date:

Basis: 44(e)

ADDITIONAL INFORMATION

Foreign Application Number: 99816417 Foreign Registration Number: 99816417 Foreign Registration Date: 1999-10-06

Country: France

Foreign Filing Date: 1999-10-06 Foreign Expiration Date: 2014-10-06

PROSECUTION HISTORY

2002-10-29 - Registered - Principal Register

2002-08-06 - Published for opposition

2002-07-17 - Notice of publication

2002-05-16 - PAPER RECEIVED

2002-05-08 - Approved for Pub - Principal Register (Initial exam)

2002-03-13 - ITU claim deleted

2002-03-13 - Communication received from applicant

2002-04-03 - Inquiry as to suspension mailed

2002-03-13 - PAPER RECEIVED

2001-04-10 - Letter of suspension mailed

2001-02-28 - Communication received from applicant

2000-09-05 - Non-final action mailed

2000-08-28 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Lawrence E. Abelman (Attorney of record)

LAWRENCE E. ABELMAN ABELMAN FRAYNE & SCHWAB 150 E 42ND ST NEW YORK NY 10017-5612 United States

Domestic Representative ABELMAN FRAYNE & SCHWAB



UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Thu Dec 12 04:10:42 EST 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSED ICT

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark

JOHNSON'S ULTRA SENSITIVE

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: cosmetics and toiletries, namely, hair shampoo, skin lotion, skin cleansers, skin cream, body soap. FIRST USE: 19960131.

FIRST USE IN COMMERCE: 19960131

Mark Drawing

Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search

Code

011525

Serial Number

75085119

Filing Date

April 8, 1996

Filed ITU

FILED AS ITU

Published for

May 20, 1997

Opposition Registration

2155403

Number

Registration Date

May 5, 1998

Owner

(REGISTRANT) JOHNSON & JOHNSON CORPORATION NEW JERSEY One

Johnson & Johnson Plaza New Brunswick NEW JERSEY 089337001

Attorney of

Record

Richard F. Biribauer

Prior.

0620110;1341920;1385670;1441713;AND OTHERS

Registrations

Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ULTRA

SENSITIVE" APART FROM THE MARK AS SHOWN

Description of

Mark

The stippling is a feature of the mark and does not indicate color.

Type of Mark

TRADEMARK

Register

PRINCIPAL .

Live/Dead

Indicator

LIVE

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT

This page was generated by the TARR system on 12/12/2002 10:25:45 ET

Serial Number: 75085119

Registration Number: 2155403

Mark

Johnson CHRA: SENSITIVI

(words only): JOHNSON'S ULTRA SENSITIVE

Current Status: Registered.

Date of Status: 1998-05-05

Filing Date: 1996-04-08

Registration Date: 1998-05-05

Law Office Assigned: TMEG Law Office 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 - Warehouse (Newington)

Date In Location: 1998-05-07

CURRENT APPLICANT(S)/OWNER(S)

1. JOHNSON & JOHNSON

Address:

JOHNSON & JOHNSON One Johnson & Johnson Plaza New Brunswick, NJ 089337001 United States

State or Country of Incorporation: New Jersey

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

cosmetics and toiletries, namely, hair shampoo, skin lotion, skin cleansers, skin cream, body soap

International Class: 003 First Use Date: 19960131

First Use in Commerce Date: 19960131

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "ULTRA SENSITIVE"

Lining and Stippling: The stippling is a feature of the mark and does not indicate color.

Prior Registration Number(s):

620110

1341920

1385670

1441713

PROSECUTION HISTORY

1998-05-05 - Registered - Principal Register

1998-03-16 - Allowed for Registration - Principal Register (SOU accepted)

1998-03-08 - Statement of use processing complete

1998-01-21 - Amendment to Use filed

1997-08-12 - Notice of allowance - mailed

1997-05-20 - Published for opposition

1997-04-18 - Notice of publication

1997-03-21 - Approved for Pub - Principal Register (Initial exam)

1997-03-18 - Examiner's amendment mailed

1997-03-18 - Previous allowance count withdrawn

1997-02-21 - Approved for Pub - Principal Register (Initial exam)

1997-02-18 - Case file assigned to examining attorney

1997-02-13 - Examiner's amendment mailed

1996-12-16 - Communication received from applicant

1996-10-25 - Non-final action mailed

1996-09-30 - Case file assigned to examining attorney

1996-09-27 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Richard F. Biribauer (Attorney of record)

RICHARD F. BIRIBAUER ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7001 United States



UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Thu Dec 12 04:10:42 EST 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM



Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

(TARR contains current status, correspondence address and attorney of record for this Check Status mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark

TCB

Goods and Services

IC 003. US 051 052. G & S: Hair Shampoo, Hair Conditioner, Hair Lotion, ((Skin

Lotion,)) Hair Relaxer, Hair Spray. FIRST USE: 19750327. FIRST USE IN

COMMERCE: 19750327

Mark Drawing

Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number

73383739

Filing Date

September 7, 1982

Published for

August 16, 1983

Opposition Registration

1256544

Number

Registration Date November 8, 1983

Owner

(REGISTRANT) Alberto-Culver Company CORPORATION DELAWARE 2525

Armitage Ave. Melrose Park ILLINOIS 60160

Attorney of

Record

JO E. OSBORN

Prior

1201691

Registrations

Type of Mark

TRADEMARK

Register

PRINCIPAL

Affidavit Text

SECT 15. SECT 8 (6-YR).

Live/Dead

Indicator

LIVE

FTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DIET TOP HELP

This page was generated by the TARR system on 12/12/2002 10:27:12 ET

Serial Number: 73383739

Registration Number: 1256544

Mark



(words only): TCB

Current Status: A Section 15 affidavit has been acknowledged.

Date of Status: 1989-07-10

Filing Date: 1982-09-07

Registration Date: 1983-11-08

Law Office Assigned: TMEO Law Office #7

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 - Warehouse (Newington)

Date In Location: 1999-01-07

CURRENT APPLICANT(S)/OWNER(S)

1. Alberto-Culver Company

Address:

Alberto-Culver Company 2525 Armitage Ave. Melrose Park, IL 60160

United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hair Shampoo, Hair Conditioner, Hair Lotion, ((Skin Lotion,)) Hair Relaxer, Hair Spray

International Class: 003 First Use Date: 19750327

First Use in Commerce Date: 19750327

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

1201691

PROSECUTION HISTORY

1989-07-10 - Section 15 acknowledged

1989-07-01 - Post Registration action correction

1989-04-10 - Section 15 affidavit received

1989-03-29 - Section 8 (6-year) accepted

1988-12-22 - Section 8 (6-year) and Section 15 Filed

1983-11-08 - Registered - Principal Register

1983-08-16 - Published for opposition

1983-11-08 - Registered - Principal Register

1983-08-16 - Published for opposition

1983-07-27 - Notice of publication

1983-07-22 - Notice of publication

1983-07-21 - Notice of publication

1983-07-20 - Notice of publication

1983-07-19 - Notice of publication

1983-06-10 - Approved for Pub - Principal Register (Initial exam)

1983-05-25 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
JO E. OSBORN (Attorney of record)

JO E. OSBORN ALBERTO-CULVER CO. 2525 ARMITAGE AVE. MELROSE PARK, IL 60160 United States



UNITED STATES PATENT AND TRADEMARK OFFICE



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PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DIET BOTTOM

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark

GLY SILK

Goods and **Services**

IC 003. US 001 004 006 050 051 052. G & S: skin and hair care products, namely, hair shampoo, facial cleanser, body wash, hand cream, body lotion, face toner, facial peels, foot cream, sunblock, face creams, and moisturizers. FIRST USE: 19950610.

FIRST USE IN COMMERCE: 19950610

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number 74728821

Filing Date

September 14, 1995

Published for

Opposition

November 26, 1996

Registration

2038351

Number

Registration

Date

February 18, 1997

Owner

(REGISTRANT) M.D. Dermaceuticals, Inc. CORPORATION ILLINOIS 3501

Woodhead Drive Northbrook ILLINOIS 60062

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead

LIVE

Indicator

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT

This page was generated by the TARR system on 12/12/2002 10:29:11 ET

Serial Number: 74728821

Registration Number: 2038351

Mark (words only): GLY SILK

Current Status: Registered.

Date of Status: 1997-02-18

Filing Date: 1995-09-14

Registration Date: 1997-02-18

Law Office Assigned: TMEG Law Office 107

If you are the applicant or applicant's attorney and have questions about this file, please contact

the Trademark Assistance Center at Trademark Assistance Center @uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1997-03-04

CURRENT APPLICANT(S)/OWNER(S)

1. M.D. Dermaceuticals, Inc.

Address:

M.D. Dermaceuticals, Inc. 3501 Woodhead Drive Northbrook, IL 60062

United States

State or Country of Incorporation: Illinois

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

skin and hair care products, namely, hair shampoo, facial cleanser, body wash, hand cream, body lotion, face toner, facial peels, foot cream, sunblock, face creams, and moisturizers

International Class: 003 First Use Date: 19950610

First Use in Commerce Date: 19950610

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1997-02-18 - Registered - Principal Register

1996-11-26 - Published for opposition

1996-10-25 - Notice of publication

1996-09-30 - Approved for Pub - Principal Register (Initial exam)

1996-08-12 - Communication received from applicant

1996-02-27 - Non-final action mailed

1996-02-19 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
M.D. DERMACEUTICALS, INC.
3501 WOODHEAD DRIVE
NORTHBROOK, IL 60062
United States



UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Thu Dec 12 04:10:42 EST 2002

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Record 1 out of 1

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ALMERS

Word Mark PALMER'S

Goods and Services

IC 005. US 018. G & S: MEDICATED SKIN OINTMENT, ASTRINGENT CLEANSER AND ANTISEPTIC CLEANSING LOTION. FIRST USE: 19730424.

FIRST USE IN COMMERCE: 19730424

IC 003. US 040 051 052. G & S: COCOA BUTTER, SUNTAN OIL CREAM, MOISTURIZING LOTION AND CREAM, HOME PERMANENT KIT CONSISTING PRIMARILY OF CURLERS AND PERMANENT SOLUTION FOR HOME PERMANENTS, HAIR SHAMPOO AND CONDITIONERS, HAIR POMADES, FADE CREAM, HAIR COLOR, HAIR HOLDING SPRAY, HAIR SHEEN SPRAY, CURL ACTIVATORS AND MOISTURIZERS, SPOT MOISTURIZER, HAIR MOISTURIZERS, LIP BALM, SKIN WHITENING CREAM, DEPILATORIES, AFTER SHAVE, HAIR CURLING KIT CONSISTING OF CURLING SOLUTION, NEUTRALIZER, ACTIVATOR, MOISTURIZER AND SHEEN SPRAY, HAIR RELAXER CREAM AND KITS, TOILET SOAPS, LIQUID SOAPS, SKIN TONERS, HAIR TREATMENT FOR DRY AND BREAKING HAIR, HAIR LOTION, STYLING MOUSSE, AND SHAVE CREAM. FIRST USE: 19730424. FIRST USE IN COMMERCE: 19730424

Mark **Drawing**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Code

73799200

SH 2250

Serial

Number

Filing Date May 11, 1989

Published for May 29, 1990

Opposition

Registration Number

1610344

Registration

August 21, 1990

Date Owner

(REGISTRANT) E. T. BROWNE DRUG CO., INC. CORPORATION NEW JERSEY

440 SYLVAN AVENUE ENGLEWOOD CLIFFS NEW JERSEY 07632

Attorney of Record

DAVID S. KASHMAN

Prior

0305091;0305635;0613793;1005155;1301116;AND OTHERS

Registrations

Type of

TRADEMARK

Mark

PRINCIPAL-2(F)

Register **Affidavit**

Text

SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20010215.

Renewal

1ST RENEWAL 20010215

Live/Dead

Indicator

LIVE

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HELP

This page was generated by the TARR system on 12/12/2002 10:30:15 ET

Serial Number: 73799200

Registration Number: 1610344

Mark

PALMER'S

(words only): PALMER'S

Current Status: This registration has been renewed.

Date of Status: 2001-02-15

Filing Date: 1989-05-11

Registration Date: 1990-08-21

Law Office Assigned: TMEO Law Office #7

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-02-20

CURRENT APPLICANT(S)/OWNER(S)

1. E. T. BROWNE DRUG CO., INC.

Address:

E. T. BROWNE DRUG CO., INC. 440 SYLVAN AVENUE ENGLEWOOD CLIFFS, NJ 07632

United States

State or Country of Incorporation: New Jersey

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

COCOA BUTTER, SUNTAN OIL CREAM, MOISTURIZING LOTION AND CREAM, HOME PERMANENT KIT CONSISTING PRIMARILY OF CURLERS AND PERMANENT SOLUTION FOR HOME PERMANENTS, HAIR SHAMPOO AND CONDITIONERS, HAIR POMADES, FADE CREAM, HAIR COLOR, HAIR HOLDING SPRAY, HAIR SHEEN SPRAY, CURL ACTIVATORS AND MOISTURIZERS, SPOT MOISTURIZER, HAIR MOISTURIZERS, LIP BALM, SKIN WHITENING CREAM, DEPILATORIES, AFTER SHAVE, HAIR CURLING KIT CONSISTING OF CURLING SOLUTION, NEUTRALIZER, ACTIVATOR, MOISTURIZER AND SHEEN SPRAY, HAIR RELAXER CREAM AND KITS, TOILET SOAPS, LIQUID SOAPS, SKIN TONERS, HAIR TREATMENT FOR DRY AND BREAKING HAIR, HAIR LOTION, STYLING MOUSSE, AND SHAVE CREAM

International Class: 003 First Use Date: 19730424

First Use in Commerce Date: 19730424

Basis: 1(a)

MEDICATED SKIN OINTMENT, ASTRINGENT CLEANSER AND ANTISEPTIC CLEANSING

LOTION

International Class: 005 First Use Date: 19730424

First Use in Commerce Date: 19730424

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

305091

305635

613793

1005155

1301116

PROSECUTION HISTORY

2001-02-15 - Registration renewed - 10 year

2001-02-15 - Section 8 (10-year) accepted/ Section 9 granted

2000-08-17 - Combined Section 8 (10-year)/Section 9 filed

1996-06-12 - Section 8 (6-year) accepted & Section 15 acknowledged

1995-11-13 - Section 8 (6-year) and Section 15 Filed

1990-08-21 - Registered - Principal Register

1990-05-29 - Published for opposition

1990-04-28 - Notice of publication

1990-03-16 - Approved for Pub - Principal Register (Initial exam)

1990-02-12 - Communication received from applicant

1989-09-21 - Non-final action mailed

CONTACT INFORMATION

Correspondent (Owner)
DAVID S. KASHMAN (Attorney of record)

DAVID S. KASHMAN GOTTLIEB, RACKMAN & REISMAN, P.C. 270 MADISON AVENUE NEW YORK, NY 10016 United States



United States Patent and Trademark Office



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Check Status

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Word Mark

PAUL MITCHELL THE CONDITIONER

Goods and Services

IC 003. US 051. G & S: NON-MEDICATED HAIR AND SKIN CARE

CONDITIONER FOR DETANGLING HAIR, MOISTURIZING HAIR, TREATING SCALP AND SKIN, THERMAL CONTROL DURING WAVING AND DRYING, SHAVING LOTION, SKIN MASSAGE AND SKIN PROTEIN ADDITIVE. FIRST

USE: 19800201. FIRST USE IN COMMERCE: 19800201

Mark Drawing (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Code

Design Search 261701 261704

Code

Serial Number 73818383

August 11, 1989

Filing Date Published for

November 17, 1992

Opposition

1750932

Registration Number

Registration

February 9, 1993

Date Owner (REGISTRANT) JOHN PAUL MITCHELL SYSTEMS CORPORATION CALIFORNIA P.O. BOX 10597 BEVERLY HILLS CALIFORNIA 902133597

Attorney of

Record

DONALD J FITZPATRICK

Prior

1242495;1247496;AND OTHERS

Registrations Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CONDITIONER"

APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register

PRINCIPAL-2(F)

Affidavit Text SECT 15. SECT 8 (6-YR).

Other Data

"PAUL MITCHELL" does not not refer to a living individual.

Live/Dead

Indicator

LIVE

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HELP

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Serial Number: 73818383

Registration Number: 1750932

Mark



(words only): PAUL MITCHELL THE CONDITIONER

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1998-07-03

Filing Date: 1989-08-11

Registration Date: 1993-02-09

Law Office Assigned: TMEO Law Office 11

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 -Warehouse (Newington)

Date In Location: 1998-09-03

CURRENT APPLICANT(S)/OWNER(S)

1. JOHN PAUL MITCHELL SYSTEMS

Address:

JOHN PAUL MITCHELL SYSTEMS

P.O. BOX 10597

BEVERLY HILLS, CA 902133597

United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

NON-MEDICATED HAIR AND SKIN CARE CONDITIONER FOR DETANGLING HAIR, MOISTURIZING HAIR, TREATING SCALP AND SKIN, THERMAL CONTROL DURING WAVING AND DRYING, SHAVING LOTION, SKIN MASSAGE AND SKIN PROTEIN ADDITIVE

International Class: 003 First Use Date: 19800201

First Use in Commerce Date: 19800201

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "CONDITIONER"

Name Portrait Consent: "PAUL MITCHELL" does not not refer to a living individual.

Prior Registration Number(s):

1242495 1247496

PROSECUTION HISTORY

1998-07-03 - Section 8 (6-year) accepted & Section 15 acknowledged

1998-04-10 - Section 8 (6-year) and Section 15 Filed

1993-09-20 - Reprinting registration certificate

1993-04-26 - Section 7 amendment filed

1993-02-09 - Registered - Principal Register

1992-11-17 - Published for opposition

1992-10-16 - Notice of publication

1992-05-28 - Approved for Pub - Principal Register (Initial exam)

1992-05-12 - Examiner's amendment mailed

1992-02-10 - Communication received from applicant

1991-09-30 - Non-final action mailed

1991-04-01 - Jurisdiction restored to examiner

1990-08-10 - Final refusal mailed

1990-05-07 - Communication received from applicant

1989-11-03 - Non-final action mailed

CONTACT INFORMATION

Correspondent (Owner)
DONALD J FITZPATRICK (Attorney of record)

DONALD J FITZPATRICK
PEPER MARTIN JENSEN MAICHEL AND HETLEAGE
720 OLIVE ST 24TH FL
ST LOUIS MO 63101-2396
United States



UNITED STATES PATENT AND TRADEMARK OFFICE



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Word Mark

NEXXUS

Goods and **Services**

IC 005. US 018. G & S: VITAMINS AND DIETARY FOOD SUPPLEMENTS.

FIRST USE: 19791200. FIRST USE IN COMMERCE: 19791200

IC 003. US 051 052. G & S: HAIR SHAMPOO, HAIR CONDITIONERS, HAIR SPRAYS, HAIR DYE SOLUTIONS AND NEUTRALIZING PREPARATIONS FOR USE IN PERMANENT HAIR WAVING, SKIN CLEANING PREPARATIONS,

AND SKIN CONDITIONERS. FIRST USE: 19791200. FIRST USE IN

COMMERCE: 19791200

Mark

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Drawing Code

Serial Number 73263568

Filing Date

May 27, 1980

Published for

July 30, 1985

Opposition Registration

1376635

Number

Registration

December 31, 1985

Date Owner

(REGISTRANT) NEXXUS PRODUCTS COMPANY CORPORATION CALIFORNIA 618 EAST GUTIERREZ STREET SANTA BARBARA

CALIFORNIA 93103

Attorney of Record

JOHN R. RYDELL, II

Type of Mark TRADEMARK

Register

PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead

LIVE

Indicator

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This page was generated by the TARR system on 12/12/2002 10:32:08 ET

Serial Number: 73263568

Registration Number: 1376635

Mark



(words only): NEXXUS

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1992-01-02

Filing Date: 1980-05-27

Registration Date: 1985-12-31

Law Office Assigned: TMEO Law Office # 2

If you are the applicant or applicant's attorney and have questions about this file, please contact

the Trademark Assistance Center at Trademark Assistance Center@uspto.gov

Current Location: 900 - Warehouse (Newington)

Date In Location: 1992-01-13

CURRENT APPLICANT(S)/OWNER(S)

1. NEXXUS PRODUCTS COMPANY

Address:

NEXXUS PRODUCTS COMPANY 618 EAST GUTIERREZ STREET SANTA BARBARA, CA 93103

United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

HAIR SHAMPOO, HAIR CONDITIONERS, HAIR SPRAYS, HAIR DYE SOLUTIONS AND NEUTRALIZING PREPARATIONS FOR USE IN PERMANENT HAIR WAVING, SKIN CLEANING PREPARATIONS, AND SKIN CONDITIONERS

International Class: 003 First Use Date: 19791200

First Use in Commerce Date: 19791200

Basis: 1(a)

VITAMINS AND DIETARY FOOD SUPPLEMENTS

International Class: 005 First Use Date: 19791200

First Use in Commerce Date: 19791200

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1992-01-02 - Section 8 (6-year) accepted & Section 15 acknowledged

1991-07-24 - Post Registration action mailed Section 8 & 15

1991-03-04 - Section 8 (6-year) and Section 15 Filed

1985-12-31 - Registered - Principal Register

1985-07-30 - Published for opposition

1985-07-01 - Notice of publication

1985-04-30 - Approved for Pub - Principal Register (Initial exam)

1985-04-18 - Ex parte appeal dismissed as moot

1983-07-06 - Ex parte appeal - Instituted

1981-08-14 - Non-final action mailed

1981-06-09 - Case file assigned to examining attorney

1980-10-27 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
JOHN R. RYDELL, II (Attorney of record)

GRIFFITH AND THORNBURGH P.O. DRAWER A SANTA BARBARA, CALIFORNIA 93102-0009 United States



UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Thu Dec 12 04:10:42 EST 2002

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Typed Drawing

Word Mark

REDKEN

Goods and Services

IC 003. US 051. G & S: HAIR CONDITIONERS, WAVE SETS, HAIR SPRAYS, PERMANENT WAVE LOTIONS, HAIR LIGHTENERS, HAND LOTIONS, AND

FACE AND SKIN CREAMS. FIRST USE: 19600000. FIRST USE IN

mark. Use the "Back" button of the Internet Browser to return to TESS)

COMMERCE: 19600000

IC 003. US 052. G & S: HAIR SHAMPOOS AND WOMEN'S BEAUTY SOAP.

FIRST USE: 19600000. FIRST USE IN COMMERCE: 19600000

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number 72412601

Filing Date

January 14, 1972

Registration Number

0971521

Registration

Date

October 23, 1973

Owner

(REGISTRANT) REDKEN LABORATORIES, INC. CORPORATION CALIFORNIA 14721 CALIFA ST. VAN NUYS CALIFORNIA 91401

(LAST LISTED OWNER) REDKEN LABORATORIES, INC. CORPORATION BY

MERGER WITH DELAWARE 6625 VARIEL AVENUE CANOGA PARK

CALIFORNIA 91309

Assignment Recorded

ASSIGNMENT RECORDED

Prior

0915199

Registrations

Type of Mark TRADEMARK

Register

PRINCIPAL

Affidavit Text

SECT 15. SECT 8 (6-YR).

Renewal

1ST RENEWAL 19931222

Live/Dead

Indicator

LIVE

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 12/12/2002 10:35:06 ET

Serial Number: 72412601

Registration Number: 971521

Mark (words only): REDKEN

Current Status: This registration has been renewed.

Date of Status: 1993-12-22

Filing Date: 1972-01-14

Registration Date: 1973-10-23

Law Office Assigned: Unknown

If you are the applicant or applicant's attorney and have questions about this file, please contact

the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 - Warehouse (Newington)

Date In Location: 1994-02-08

CURRENT APPLICANT(S)/OWNER(S)

1. REDKEN LABORATORIES, INC.

Address:

REDKEN LABORATORIES, INC. 6625 VARIEL AVENUE

CANOGA PARK, CA 91309

United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

HAIR CONDITIONERS, WAVE SETS, HAIR SPRAYS, PERMANENT WAVE LOTIONS, HAIR LIGHTENERS, HAND LOTIONS, AND FACE AND SKIN CREAMS

U.S. Class: 051 (International Class 003)

First Use Date: 19600000

First Use in Commerce Date: 19600000

Basis: 1(a)

SH 2,267

12/12/2004

HAIR SHAMPOOS AND WOMEN'S BEAUTY SOAP

U.S. Class: 052 (International Class 003)

First Use Date: 19600000

First Use in Commerce Date: 19600000

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

915199

PROSECUTION HISTORY

1993-12-22 - Registration renewed - 10 year

1993-10-14 - Response received for Post Registration action

1993-09-01 - Post Registration action mailed - Section 9

1993-07-19 - Section 9 filed/check record for Section 8

1980-01-28 - Section 8 (6-year) accepted & Section 15 acknowledged

CONTACT INFORMATION

Correspondent (Owner)

KURT B. BLOEDEL REDKEN LABORATORIES, INC. 6625 VARIEL AVENUE CANOGA PARK, CA 91309 United States



BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500

> FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

BALTIMORE, MD
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC
WILMINGTON, DE

June 17, 2003

James M. Durlacher, Esquire Woodard, Emhardt, Naughton, Moriarty Bank One Center Tower 111 Monument Circle Suite 3700 Indianapolis, IN 46204-5137

Re: Sexy Hair Concepts v. Australian Gold, Inc. ("SEXY THING")

Our File: 080492

Dear Mr. Durlacher:

This has reference to the decision of the Trademark Trial and Appeal Board sustaining Opposition No. 91153992 to your client's application for "SEXY THING". We note that your client's application was filed based on Intent to Use. We trust that your client has decided against proceeding with use of this mark. However, please note that if the mark is used in the United States, our client reserves its rights to take further action to prevent such use.

Sincerely,

Roberta Jacobs-Meadway

RJ/af

cc: Mr. Mark Stiller

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500

> FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

BALTIMORE, MD DENVER, CO SALT LAKE CITY, UT VOORHEES, NJ WASHINGTON, DC

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

July 16, 2002

BOX TTAB FEE Commissioner Trademarks 2009 Crystal Drive Arlington, VA 22202-3513

Dear Sir:

We are enclosing herewith the following documents set forth below, which are to be filed in the Patent and Trademark Office.

Please charge all government filing fees with respect to the enclosed documents to our Miscellaneous Account No. 02-0755.

Very truly yours,

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

Enclosures: Notice of Opposition

By: Sexy Hair Concepts, LLC v. California Tan, Inc.

Serial No.: 76/251,899 for SEXY TAN

Fee: \$300.00

Attorney Docket No. 895969

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513 ON THE DATE INDICATED BELOW

DATE: 07/16/102

RJM/CDA

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on the date indicated below.

BOX TTAB FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Sexy Hair Concepts, LLC	:
Opposer,	: :
v.	: Opposition No
California Tan, Inc.	: :
Applicant.	: :

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513

Dear Sir/Madam:

Date:

In the matter of Trademark Application Serial No. 76/251899 for the mark "SEXY TAN", filed May 4, 2001 and published for opposition in the Official Gazette on June 18, 2002.

Sexy Hair Concepts, LLC a California corporation having a place of business at 9232 Eton Avenue, Chatsworth, California 91311 ("Opposer"), believes that it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes the same. The grounds for opposition are as follows:

1. California Tan, Inc., a Delaware ("Applicant"), seeks to register "SEXY TAN" as a trademark for use in connection with skin and hair care products, namely sun tanning

preparations; non-medicated skin care preparations, namely, gels, lotions, oils, moisturizers, mousses, cleansers, sprays, mists, creams and foundations as evidenced by the publication of said mark in the Official Gazette on June 18, 2002.

- 2. The application herein opposed was filed May 4, 2001 on the basis of "intent to use". Applicant claims no date earlier than May 4, 2001 for the purpose of claiming priority.
- 3. Opposer is, itself and through its predecessor and related companies in interest ("Opposer") has been engaged in the development, manufacture and sale of hair and skin care preparations for men, women and children and has built a successful business in connection therewith.
- 4. Opposer has since at least as early as June 15, 1998 used the mark "SEXY HAIR" for hair care preparations for men, women and children, including shampoo and conditioner. Opposer has since at least as early as December 21, 1998 used such mark in commerce for such goods.
- 5. Use of the "SEXY HAIR" mark by Opposer has been continuous and commercially significant. Promotional material showing Opposer's use of "SEXY HAIR" is attached as Exhibit A.
- 6. Opposer has taken steps to protect the "SEXY HAIR" mark and has secured U.S. Trademark Registration No. 2,403,396 for such mark for the hair care preparations for men, women and children identified therein. Registration No. 2,403,396 is valid and subsisting and the copy of the pertinent information about such registration from the PTO database is attached as Exhibit B.

- 7. Opposer has since 1998 taken steps to develop a family of "SEXY" marks for hair care, including: "SEXY HAIR CONCEPTS"; "HOT SEXY HIGHLIGHTS"; and "HEALTHY SEXY HAIR". Promotional material showing the "SEXY" marks of Opposer is attached as Exhibit C.
- 8. Opposer has under the "SEX SYMBOL" trademark developed and sold tanning preparations. Promotional material showing such use is attached as Exhibit D.
- 9. Opposer has since prior to August 15, 2000 used Sexy Hair Concepts as a trade name as well as a mark in connection with its business of developing and marketing hair care and skin care preparations, including tanning preparations.
- 10. Opposer's registered trademark "SEXY HAIR", and Opposer's family of "SEXY" marks, and the "Sexy Hair Concepts" name are inherently distinctive as applied to Opposer's skin care and hair care preparations and business.
- 11. By virtue of Opposer's continuous use in commerce of its registered "SEXY HAIR" trademark and its family of "SEXY" marks and the "Sexy Hair Concepts" name in connection with such goods and business, such goods and business have become favorably known to the relevant trade and public under such marks and name.
- 12. Opposer is the owner of a U.S. trademark registration for "SEXY HAIR"; accordingly, priority is not in issue.
- 13. In the application herein opposed, there are no restrictions on trade channels, so it must be assumed that the goods identified in the application will travel through all trade channels appropriate for goods of such type.

- 14. In the application herein opposed, Applicant has disclaimed the exclusive right to use the term "TAN" apart from the mark as a whole. Accordingly, "SEXY" is the dominant component of Applicant's mark.
- 15. Applicant's mark as intended to be used in connection with the goods identified in the application herein opposed is confusingly similar to Opposer's registered "SEXY HAIR" trademark and also to the family of "SEXY", marks established by Opposer, and to Opposer's "Sexy Hair Concepts" trade name as used in connection with Opposer's goods and business.
- 16. Each of the marks has as its dominant element the identical term,"SEXY", followed by a descriptive or generic designation.
- 17. The goods of Opposer and the goods of applicant are, in part, identical and are otherwise closely related, being hair care and skin care preparations, including tanning preparations.
- 18. Hair care preparations, skin care preparations and other personal health and beauty products such as are sold by Opposer and are identified in the application herein opposed are customarily sold and marketed through the same and overlapping channels of trade.
- 19. It is common and therefore expected for companies to use the same mark for hair care preparations and skin care preparations as part of a line of related health and beauty products, all distributed under a common mark. The following third party registrations demonstrate the related nature of hair care and skin care preparations and other health and beauty products:

Mark	Registration No.	Goods
JOHNSON'S ULTRA SENSITIVE and Design	2,155,403	Cosmetics and toiletries, namely, hair shampoo, skin lotion, skin cleansers, skin cream, body soap

TCB (Stylized)	1,256,544	Hair shampoo, hair conditioner, hair lotion, skin lotion, hair relaxer, hair spray
GARNIER EXPERT	1,889,558	Non-medicated hair care preparations, namely, shampoo, conditioner, lotion, spray and mousse; hair color preparations; skin and body creams and lotions; shave cream, after-shave lotion
GLY SILK	2,038,351	Skin and hair care products, namely, hair shampoo, facial cleanser, body wash, hand cream, body lotion, face toner, facial peels, foot cream, sunblock, face creams, and moisturizers
PALMER'S (Stylized)	1,610,344	Inter alia, cocoa butter, suntan oil cream, moisturizing lotion and cream, hair shampoo and conditioners, hair color, hair holding spray, hair moisturizers
PAUL MITCHELL THE CONDITIONER and Design	1,750,932	Non-medicated hair and skin care conditioner for detangling hair, moisturizing hair, treating scalp and skin, thermal control during waving and drying, shaving lotion, skin massage and skin protein additive
NEXXUS (Stylized)	1,376,635	Inter alia, hair shampoo, hair conditioners, hair sprays, skin cleaning preparations, and skin conditioners
REDKEN	971,521	Hair conditioners, wave sets, hair sprays, permanent wave lotions, hair lighteners, hand lotions, and face and skin creams; hair shampoos and women's beauty soap

Copies of printouts from the PTO database showing the pertinent information about these registrations are attached hereto as Exhibit E.

20. The preparations marketed and sold under Opposer's registered "SEXY HAIR" trademark and Opposer's family of "SEXY" marks, and through Opposer's "Sexy Hair Concepts" business, and the preparations intended to be sold under Applicant's "SEXY TAN" mark, are such as would be sold to the same and to overlapping classes of purchasers, namely men, women and children, generally; and through the same and overlapping channels of trade.

- 21. Tanning products such as those identified in the application herein opposed are typically advertised in the same trade publications as hair care products.
- 22. Applicant's "SEXY TAN" trademark as applied to the goods set forth in the application herein opposed so resembles Opposer's registered "SEXY HAIR" trademark, and also Opposer's family of "SEXY" marks as applied to Opposer's products and Opposer's "Sexy Hair Concepts" name as used in connection with Opposer's business, that it is likely to cause confusion, mistake, and/or deception.
- 23. If Applicant is permitted to register "SEXY TAN" for the goods set forth in the application, confusion of the relevant trade and public is likely to result, which will damage and injure Opposer.
- 24. On seeing Applicant's "SEXY BATH & BODY" mark used in connection with Applicant's goods, purchasers and potential purchasers are likely to believe in error that such goods are offered by or in association with or under license from Opposer, that Opposer and Applicant are affiliated, or that Opposer's goods and Applicant's goods are sold as components of a single line of health and beauty products.
- 25. Any defect, objection to or fault found with Applicant's goods sold under its mark "SEXY TAN" would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods and business.
- 26. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Sexy Hair Concepts, LLC prays that registration of the mark of Application Serial No. 76/251899 be refused and that this opposition be sustained.

A duplicate copy of this Notice of Opposition is enclosed herewith.

The required fee of \$300 may be charged to Deposit Account No. 02-0755 and any overpayment may be credited to this account.

Respectfully submitted,

Roberta (acobs-Meadway

Lynn Rzopca Richard Pierce

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 Market Street, 51st Floor

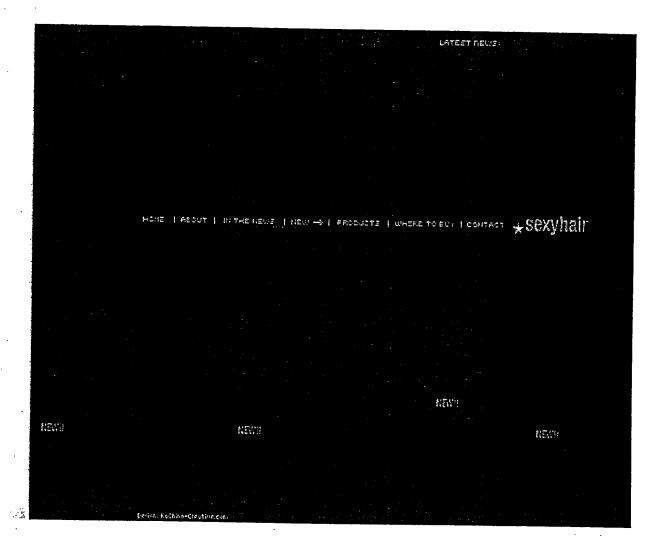
Philadelphia, Pennsylvania 19103-7599

(215) 665-8500

Dated: 3/16/02

ATTORNEYS FOR OPPOSER

EXHIBIT 'A'





Sexy Hair Concepts CEO Michael O'Rourke Works Magic at Spray & Play Braiding

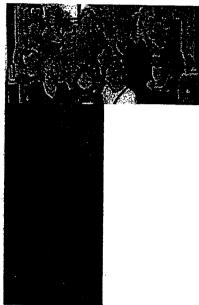
American Salon features Michael O'Rourke's Sexy Styles

Sexy Hair Products on the Big Screen

Michael O'Rourke Performs Makeovers on **National TV**

Sexy Hair Concepts Increases Distributor Base And Continues To Lead The Industry

Sexy Hair Concepts Founder, Michael O'Rourke, Shares Techniques With Entertainment **Industry Stylists At Spray & Play Gathering**



SEXY HAIR CONCEPTS CEO MICHAEL O'ROURKE WORKS MAGIC AT SPRAY & **PLAY BRAIDING**

SEMINAR(CHATSWORTH, CA) — As creator of cutting-edge styles, innovative techniques and up-to-the-minute hair care products, Michael O'Rourke, Founder and CEO of Sexy Hair Concepts, spiraled into the Summer season with the Spray & Play Braiding Seminar. On Saturday, May 18 at the Sexy Hair Concepts Educational Center, O'Rourke brought together eight hairstylists from the entertainment industry to introduce his unique techniques for braiding and twisting using Healthy Sexy Hair Soyl Braiding and Sculpting Clay.

"The response from the entertainment industry has been phenomenal. These stylists are the true trend-setters and I am thrilled to offer them the tools and techniques to help them impact the world," said O'Rourke. "This marks the third Spray & Play seminar and we look forward to hosting many more."

Among the attendees were hairstylists from television

Among the attendees were hairstylists from television shows including "Just Shoot Me," "The Tonight Show," "Felicity," and films such as "Sorority Boys," "In The House" (featuring Steve Martin, Queen Latifah and Jean Smart) and "Angry Management" (with Jack Nicholson).

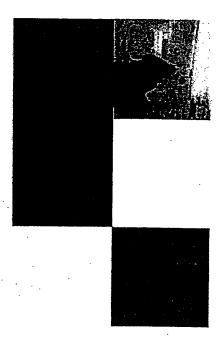
Spray & Play Seminars are open to stylists exclusively in the entertainment industry.



AMERICAN SALON FEATURES MICHAEL O'ROURKE'S SEXY STYLES

Don't miss the May 2002 issue of American Salon Magazine! The cover and several pages titled 'Braid in America" feature the creative genius of Sexy Hair Concepts' founder, CEO and visionaire Michael O'Rourke assisted by Creative Director Douglas Little. Quoting Michael, the article states: "These days, what's going on in the street—all the urban, punk, and ethnic influences— is having a huge impact on hair. It's not enough for hairdressers to just use linear thinking anymore. When creating looks, being multi-dimensional is key." There are several beautiful braiding styles pictured and Michael stares a few "how-to" tips for using Healthy Sexy Hair Soyl Sculpting and Braiding Clay. The entire Sexy Hair Concepts team applauds Michael and takes pride in this fabulous work.

SEXY HAIR PRODUCTS ON THE BIG



See Sexy Hair products on the big screen in "Sorority Boys", thanks to Emmy Award Winning Television and Motion Picture Hairstylist DONNA GILBERT. Donna loves Sexy Hair Concept's products and has been using them in many of her projects over the past two years! Donna also participated in the Spray & Play Gathering for Celebrity Stylists in October last year (see article below) which was led by Michael O'Rourke.

For more information about Donna Gilbert's work and "Sorority Boys", please see http://www.hairagain.com/sorority.html or http://bventertainment.go.com/movies/sororityboys/index.html

MICHAEL O'ROURKE PERFORMS MAKEOVERS ON NATIONAL TV

Michael O'Rourke made two fabulous guest appearances on the national daytime television talk show "The Other Half" (hosted by Dick Clark, Mario Lopez and Danny Bonaduce).

Michael's first appearance on the show that aired on Monday, February 4, 2002 simply amazed the audience and viewers with his signature performance of "The 2-Minute Makeover." Michael, along with his Creative Director, Douglas Little gave three unsuspecting audience members a beautiful makeover.

For the first model, Michael transformed her straight hair to curly using Curly Sexy Hair Hot Curl Curling Lotion with his unique and user-friendly curling iron.

For the second model who had curty hair, O'Rourke straightened her locks using Soya Want Flat Hair with his specially designed flat iron.

For the third model that had long straight hair of an estimated 30 inches, Michael drastically altered her look by cutting-off over 15 inches of her hair.

Also, with summer quickly approaching, Michael demonstrated a safe, fast and easy way of tanning by using Aero Tan. At the end of the show, Michael mingled with the hosts.

Michael O'Rourke versus the Mullet Men! In his triumphant return to national television on "The Other Half" (aired on Monday, February 18, 2002), Michael performed his magic along with his Creative Artistic Director, Douglas Little to make over men with mullet hairstyles. "The Other Half" challenged Michael to transform two men sporting 1980's mullet hairstyles into men with the latest hairstyles for 2002. Was Michael up for the challenge to create a new hairstyle for the "Mullet Men" tag-team?

Round one: The first man, a Tennessean, arrived to the studio with his mullet hair in tact and a full beard. Michael stepped-up to the challenge and changed his 1980's hairstyle to a hairstyle more fitting of today. Due to the bushiness of the beard, Michael decided to trim that down to a Chin Strap Beard that rimmed his chin. Giving him a bit of a more aggressive image to counter his baby face looks. Michael cut his hair so that it was even and Structured and a lot more modern.

Round two: The second man was a studio employee with the atypical mullet style who was also sporting a thick moustache and long hair. Michael got his scissors and dippers and knocked-out a new look for the show's employee. Michael shaped down his moustache transforming it into a Soul Patch, a very classical and

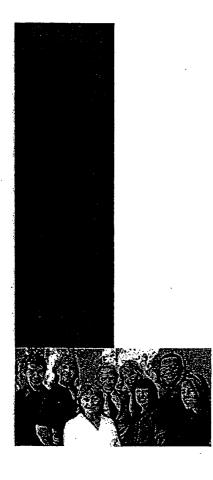
elegant look. He kept his hair almost the same length around, but current with the latest trend for mens' hairstyles.

Michael also gave the men products and styling tips so they won't slip back into their old mullet ways. Needless to say, Michael wins the match and claims his victory as champion!



SEXY HAIR CONCEPTS INCREASES DISTRIBUTOR BASE AND CONTINUES TO LEAD THE INDUSTRY

World-renowned beauty care company, Sexy Hair Concepts, announces new distributors as it brands one of the fastest growing hair care companies in the world.



Giving Sex Symbol, Sexy Hair brands (Healthy, Big, Short, Straight and Curly) and Hot Sexy Highlights an international identity, Sexy Hair Concepts adds several new distributors including Aurora Beauty Supply of Anchorage, Alaska (serving Alaska), Maly's in Grand Rapids, Michigan (serving Michigan and Indiana), Salon Qonsultants International from Honolulu, Hawaii (serving Hawaii) and Can-Rad Beauty Limited of Downsview, Ontario, Canada (serving Metropolitan Toronto and Ontario, Canada).

"Our distributors are part of the Sexy Hair Concepts team. Together, our goal is to strategically develop a household name for the Sexy Hair collections," says Michael O'Rourke, visionaire, founder, and CEO of Sexy Hair Concepts.

All Sexy Hair Concepts products including its makeup accessories line, Sex Symbol, are available in professional salons in more than 20 countries.

SEXY HAIR CONCEPTS FOUNDER, MICHAEL O'ROURKE, SHARES TECHNIQUES WITH ENTERTAINMENT INDUSTRY STYLISTS AT SPRAY & PLAY GATHERING

Michael O'Rourke, CEO and beauty futurist at Sexy Hair Concepts, pulled together some of the biggest named hair stylists in the entertainment industry, to create, invent and share ideas at the first-ever *Spray & Play Gathering* on Saturday, October 13th at the Sexy Hair Concepts headquarters in Chatsworth, California.

Designed especially for hair stylists working in film and television, the Spray & Play Gathering presented the opportunity for O'Rourke to bridge the gap between Corporate Business and Artisan Creativity. The workshop gave the stylists the chance to meet and work with O'Rourke while the native South African presented his newest cutting technique, Structure in Motion and shared tips on how best to use Sexy Hair Concepts products.

Everyone got into the action - cutting, styling, and crafting. Stylists including Emmy Award-Winning Donna Gilbert ("Local Boys" and "Sorority Boys"), Maria Valdivla ("Just Shoot Me" and "Nikki"), Margaret Dempsey ("The Tonight Show with Jay Leno"), Linda Flowers ("Sports Night"), Rudy Icezalaya ("Smokey Joe's Café") and Linda Armold ("Legally Blonde" and "My First Mister") were on hand at the special workshop. Sexy Hair Concepts has also made their presence known by receiving product placements on television shows (MTV's "Undressed", "The Tonight Show with Jay Leno") and in film ("Martin & Orloff" and "Sorority Boys"). Stylists have also used Sexy Hair Concepts products on stars on "N.Y.P.D. Blue," "Philly," "Everybody Loves Raymond," and "Providence."

"The workshop was incredible! Upon meeting the stylists, we connected immediately," says O'Rourke. "The new cutting system that we showed the stylists is going to be one of those cuts that every woman wants."

With the success of the first Spray & Play Gathering, Sexy Hair Concepts will host more of these workshops in the future.

> close <

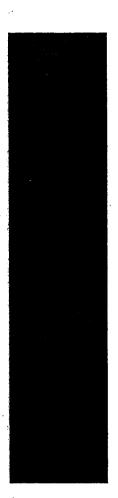


EXHIBIT 'B'

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 07/16/2002 11:08:49 ET

Serial Number: 75634213

Registration Number: 2403396

Mark (words only): SEXY HAIR

Current Status: Registered.

Date of Status: 2000-11-14

Filing Date: 1999-02-05

Registration Date: 2000-11-14

Law Office Assigned: TMEG Law Office 104

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

State or Country of Incorporation: California

* Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse

International Class: 003
First Use Date: 19980615

First Use in Commerce Date: 19981221

→ Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

SH 1882

PROSECUTION HISTORY

2000-11-14 - Registered - Principal Register

2000-08-22 - Published for opposition

2000-07-21 - Notice of publication

2000-06-03 - Approved for Pub - Principal Register (Initial exam)

1999-12-14 - Letter of suspension mailed

1999-10-18 - Communication received from applicant

1999-08-17 - Non-final action mailed

1999-08-04 - Case file assigned to examining attorney

1999-07-30 - Case file assigned to examining attorney

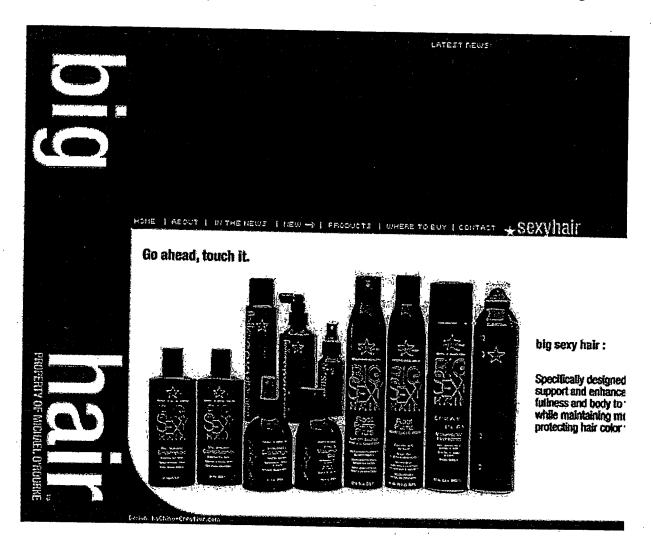
CONTACT INFORMATION

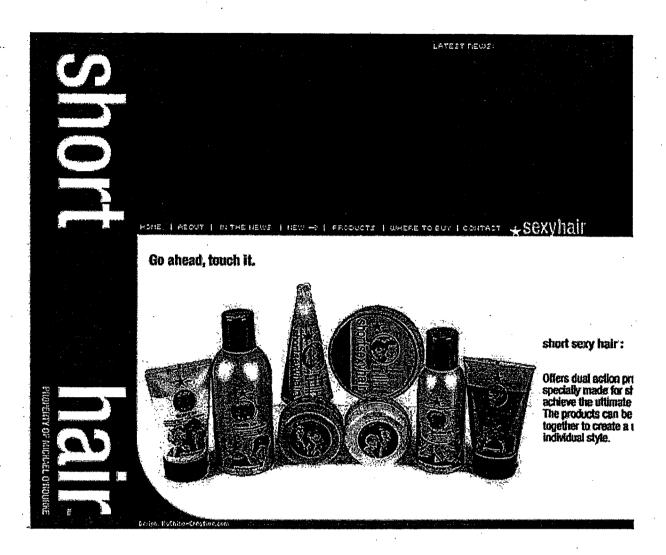
Correspondent (Owner)

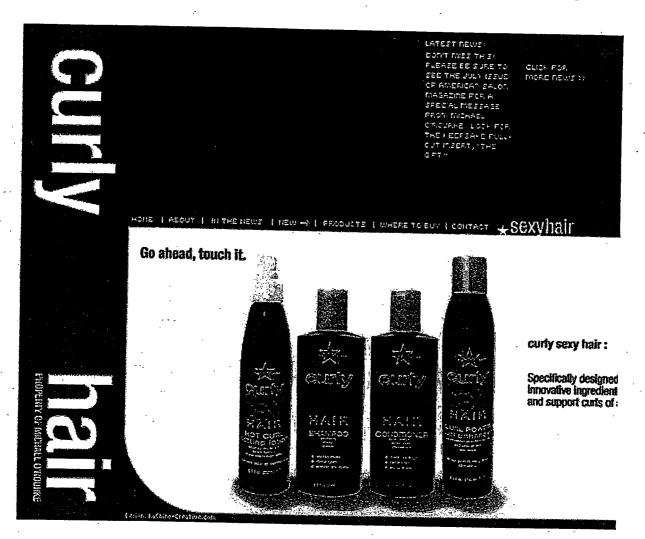
Roberta Jacobs-Meadway (Attorney of record)

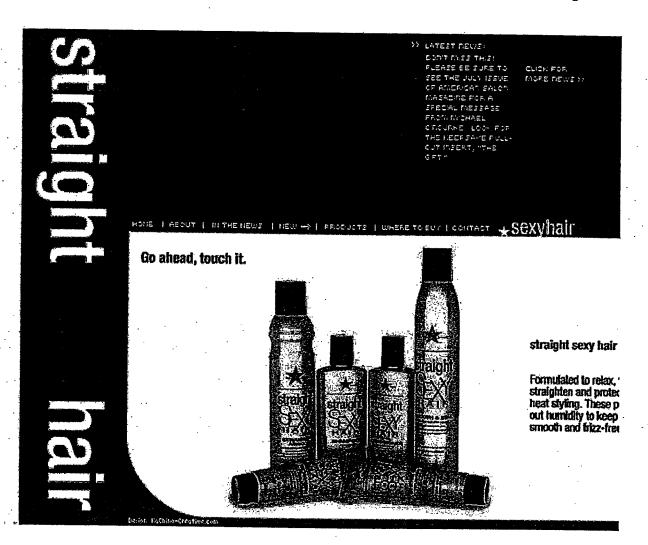
ROBERTA JACOBS-MEADWAY
AKIN GUMP STRAUSS HAUER & FELD LLP
ONE COMMERCE SQ STE 2200
2005 MARKET ST
PHILADELPHIA PA 19103
United States

EXHIBIL ,C,









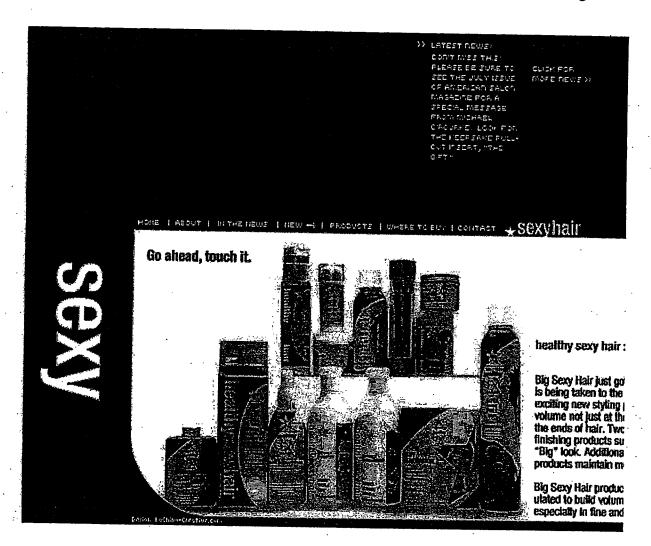


EXHIBIT 'D'

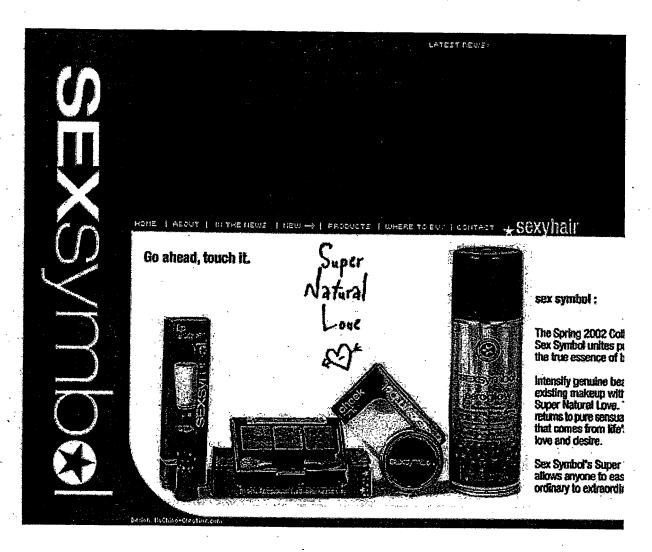


EXHIBIT 'E'

This page was generated by the TARR system on 07/16/2002 11:12:00 ET

Serial Number: 75085119

Registration Number: 2155403

Mark

Johnnons Lilika Sensitivi

(words only): JOHNSON'S ULTRA SENSITIVE

Current Status: Registered.

Date of Status: 1998-05-05

Filing Date: 1996-04-08

Registration Date: 1998-05-05

Law Office Assigned: TMEG Law Office 106

CURRENT APPLICANT(S)/OWNER(S)

₺ 1. JOHNSON & JOHNSON

Address:

JOHNSON & JOHNSON One Johnson & Johnson Plaza New Brunswick, NJ 089337001

United States

State or Country of Incorporation: New Jersey

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

cosmetics and toiletries, namely, hair shampoo, skin lotion, skin cleansers, skin cream, body soap

International Class: 003 First Use Date: 19960131

First Use in Commerce Date: 19960131

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "ULTRA SENSITIVE"

Lining and Stippling: The stippling is a feature of the mark and does not indicate color.

Prior Registration Number(s):

620110

1341920

1385670

1441713

PROSECUTION HISTORY

1998-05-05 - Registered - Principal Register

1998-03-16 - Allowed for Registration - Principal Register (SOU accepted)

1998-03-08 - Statement of use processing complete

1998-01-21 - Amendment to Use filed

1997-08-12 - Notice of allowance - mailed

1997-05-20 - Published for opposition

1997-04-18 - Notice of publication

1997-03-21 - Approved for Pub - Principal Register (Initial exam)

1997-03-18 - Examiner's amendment mailed

1997-03-18 - Previous allowance count withdrawn

1997-02-21 - Approved for Pub - Principal Register (Initial exam)

1997-02-18 - Case file assigned to examining attorney

1997-02-13 - Examiner's amendment mailed

1996-12-16 - Communication received from applicant

1996-10-25 - Non-final action mailed

1996-09-30 - Case file assigned to examining attorney

1996-09-27 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
Richard F. Biribauer (Attorney of record)

RICHARD F. BIRIBAUER
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7001
United States

This page was generated by the TARR system on 07/16/2002 11:12:30 ET

Serial Number: 73383739

Registration Number: 1256544

Mark



(words only): TCB

Current Status: A Section 15 affidavit has been acknowledged.

Date of Status: 1989-07-10

Filing Date: 1982-09-07

Registration Date: 1983-11-08

Law Office Assigned: TMEO Law Office #7

CURRENT APPLICANT(S)/OWNER(S)

1. Alberto-Culver Company

- Address:

Alberto-Culver Company 2525 Armitage Ave. Melrose Park, IL 60160 United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hair Shampoo, Hair Conditioner, Hair Lotion, ((Skin Lotion,)) Hair Relaxer, Hair Spray

International Class: 003 First Use Date: 19750327

First Use in Commerce Date: 19750327

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

1201691

PROSECUTION HISTORY

1989-07-10 - Section 15 acknowledged

1989-07-01 - Post Registration action correction

1989-04-10 - Section 15 affidavit received

1989-03-29 - Section 8 (6-year) accepted

1988-12-22 - Section 8 (6-year) and Section 15 Filed

1983-11-08 - Registered - Principal Register

1983-08-16 - Published for opposition

1983-11-08 - Registered - Principal Register

1983-08-16 - Published for opposition

1983-07-27 - Notice of publication

1983-07-22 - Notice of publication

1983-07-21 - Notice of publication

1983-07-20 - Notice of publication

1983-07-19 - Notice of publication

1983-06-10 - Approved for Pub - Principal Register (Initial exam)

1983-05-25 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

JO E. OSBORN (Attorney of record)

JO E. OSBORN ALBERTO-CULVER CO. 2525 ARMITAGE AVE.

MELROSE PARK, IL 60160 United States

This page was generated by the TARR system on 07/16/2002 11:12:49 ET

Serial Number: 74454847

Registration Number: 1889558

Mark (words only): GARNIER EXPERT

Current Status: Registration canceled under Section 8.

Date of Status: 2002-04-27

Filing Date: 1993-11-02

Registration Date: 1995-04-18

Law Office Assigned: TMEO Law Office # 08

CURRENT APPLICANT(S)/OWNER(S)

1. LABORATOIRE GARNIER & CIE

Address:

LABORATOIRE GARNIER & CIE 281 Rue Saint-Honore

75008 Paris.

French Republic

State or Country Where Organized: French Republic

Legal Entity Type: Other

GOODS AND/OR SERVICES

non-medicated hair care preparations, namely shampoo, conditioner, lotion, spray and mousse; hair color preparations; skin and body creams and lotions; shave cream, after-shave lotion

International Class: 003

First Use Date:

First Use in Commerce Date:

Basis: 44(e)

ADDITIONAL INFORMATION

Foreign Application Number: 93/469471 Foreign Registration Number: 93/469471 Foreign Registration Date: 1993-05-25

Country: French Republic

Foreign Filing Date: 1993-05-25 Foreign Expiration Date: 2003-05-25

PROSECUTION HISTORY

2002-04-27 - Canceled Section 8 (6-year)

1995-04-18 - Registered - Principal Register

1995-01-24 - Published for opposition

1994-12-23 - Notice of publication

1994-07-01 - Approved for Pub - Principal Register (Initial exam)

1994-06-06 - Communication received from applicant

1994-06-06 - ITU claim deleted

1994-03-29 - Non-final action mailed

1994-03-24 - Case file assigned to examining attorney

1994-03-24 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Russell H. Falconer (Attorney of record)

-RUSSELL H. FALCONER

"BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

30 ROCKEFELLER PLAZA

NEW YORK, NY 10112

United States

Domestic Representative

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

This page was generated by the TARR system on 07/16/2002 11:13:09 ET

Serial Number: 74728821

Registration Number: 2038351

Mark (words only): GLY SILK

Current Status: Registered.

Date of Status: 1997-02-18

Filing Date: 1995-09-14

Registration Date: 1997-02-18

Law Office Assigned: TMEG Law Office 107

CURRENT APPLICANT(S)/OWNER(S)

1. M.D. Dermaceuticals, Inc.

Address:

M.D. Dermaceuticals, Inc. 3501 Woodhead Drive Northbrook, IL 60062 **United States**

State or Country of Incorporation: Illinois

*Legal Entity Type: Corporation

GOODS AND/OR SERVICES

skin and hair care products, namely, hair shampoo, facial cleanser, body wash, hand cream, body lotion, face toner, facial peels, foot cream, sunblock, face creams, and moisturizers

International Class: 003 First Use Date: 19950610

First Use in Commerce Date: 19950610

»Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1997-02-18 - Registered - Principal Register

1996-11-26 - Published for opposition

1996-10-25 - Notice of publication

1996-09-30 - Approved for Pub - Principal Register (Initial exam)

1996-08-12 - Communication received from applicant

1996-02-27 - Non-final action mailed

1996-02-19 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
M.D. DERMACEUTICALS, INC.
3501 WOODHEAD DRIVE
NORTHBROOK, IL 60062
United States

This page was generated by the TARR system on 07/16/2002 11:13:32 ET

Serial Number: 73799200

Registration Number: 1610344

Mark

PALMER'S

(words only): PALMER'S ...

Current Status: This registration has been renewed.

Date of Status: 2001-02-15

Filing Date: 1989-05-11

Registration Date: 1990-08-21

Law Office Assigned: TMEO Law Office #7

CURRENT APPLICANT(S)/OWNER(S)

. 1. E. T. BROWNE DRUG CO., INC.

« Address:

E. T. BROWNE DRUG CO., INC.

440 SYLVAN AVENUE

ENGLEWOOD CLIFFS, NJ 07632

United States

² State or Country of Incorporation: New Jersey

-Legal Entity Type: Corporation

GOODS AND/OR SERVICES

COCOA BUTTER, SUNTAN OIL CREAM, MOISTURIZING LOTION AND CREAM, HOME PERMANENT KIT CONSISTING PRIMARILY OF CURLERS AND PERMANENT SOLUTION FOR HOME PERMANENTS, HAIR SHAMPOO AND CONDITIONERS, HAIR POMADES, FADE CREAM, HAIR COLOR, HAIR HOLDING SPRAY, HAIR SHEEN SPRAY, CURL ACTIVATORS AND MOISTURIZERS, SPOT MOISTURIZER, HAIR MOISTURIZERS, LIP BALM, SKIN

Latest Status Info Page 2 of 3

WHITENING CREAM, DEPILATORIES, AFTER SHAVE, HAIR CURLING KIT CONSISTING OF CURLING SOLUTION, NEUTRALIZER, ACTIVATOR, MOISTURIZER AND SHEEN SPRAY, HAIR RELAXER CREAM AND KITS, TOILET SOAPS, LIQUID SOAPS, SKIN TONERS, HAIR TREATMENT FOR DRY AND BREAKING HAIR, HAIR LOTION, STYLING MOUSSE, AND SHAVE CREAM

International Class: 003 First Use Date: 19730424

First Use in Commerce Date: 19730424

Basis: 1(a)

MEDICATED SKIN OINTMENT, ASTRINGENT CLEANSER AND ANTISEPTIC CLEANSING

LOTION

International Class: 005 First Use Date: 19730424

First Use in Commerce Date: 19730424

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

305091

305635

613793

1005155

1301116

PROSECUTION HISTORY

2001-02-15 - Registration renewed - 10 year

2001-02-15 - Section 8 (10-year) accepted/ Section 9 granted

2000-08-17 - Combined Section 8 (10-year)/Section 9 filed

1996-06-12 - Section 8 (6-year) accepted & Section 15 acknowledged

1995-11-13 - Section 8 (6-year) and Section 15 Filed

1990-08-21 - Registered - Principal Register

1990-05-29 - Published for opposition

1990-04-28 - Notice of publication

1990-03-16 - Approved for Pub - Principal Register (Initial exam)

SH 1905

1990-02-12 - Communication received from applicant

1989-09-21 - Non-final action mailed

CONTACT INFORMATION

Correspondent (Owner)
DAVID S. KASHMAN (Attorney of record)

DAVID S. KASHMAN GOTTLIEB, RACKMAN & REISMAN, P.C. 270 MADISON AVENUE NEW YORK, NY 10016 United States

This page was generated by the TARR system on 07/16/2002 11:13:55 ET

Serial Number: 73818383

Registration Number: 1750932

Mark



(words only): PAUL MITCHELL THE CONDITIONER

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1998-07-03

Filing Date: 1989-08-11

Registration Date: 1993-02-09

Law Office Assigned: TMEO Law Office 11

CURRENT APPLICANT(S)/OWNER(S)

1. JOHN PAUL MITCHELL SYSTEMS

Address:

JOHN PAUL MITCHELL SYSTEMS P.O. BOX 10597 BEVERLY HILLS, CA 902133597 United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

NON-MEDICATED HAIR AND SKIN CARE CONDITIONER FOR DETANGLING HAIR, MOISTURIZING HAIR, TREATING SCALP AND SKIN, THERMAL CONTROL DURING WAVING AND DRYING, SHAVING LOTION, SKIN MASSAGE AND SKIN PROTEIN ADDITIVE

International Class: 003

First Use Date: 19800201

First Use in Commerce Date: 19800201

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "CONDITIONER"

Name Portrait Consent: "PAUL MITCHELL" does not not refer to a living individual."

Prior Registration Number(s):

1242495 1247496

PROSECUTION HISTORY

1998-07-03 - Section 8 (6-year) accepted & Section 15 acknowledged

1998-04-10 - Section 8 (6-year) and Section 15 Filed

1993-09-20 - Reprinting registration certificate

1993-04-26 - Section 7 amendment filed

1993-02-09 - Registered - Principal Register

1992-11-17 - Published for opposition

1992-10-16 - Notice of publication

1992-05-28 - Approved for Pub - Principal Register (Initial exam)

1992-05-12 - Examiner's amendment mailed

1992-02-10 - Communication received from applicant

1991-09-30 - Non-final action mailed

1991-04-01 - Jurisdiction restored to examiner

1990-08-10 - Final refusal mailed

1990-05-07 - Communication received from applicant

1989-11-03 - Non-final action mailed

CONTACT INFORMATION

Correspondent (Owner)
DONALD J FITZPATRICK (Attorney of record)

DONALD J FITZPATRICK
PEPER MARTIN JENSEN MAICHEL AND HETLEAGE
720 OLIVE ST 24TH FL
ST LOUIS MO 63101-2396
United States

This page was generated by the TARR system on 07/16/2002 11:14:10 ET

Serial Number: 73263568

Registration Number: 1376635

Mark



(words only): NEXXUS

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1992-01-02

Filing Date: 1980-05-27

Registration Date: 1985-12-31

Law Office Assigned: TMEO Law Office # 2

CURRENT APPLICANT(S)/OWNER(S)

1. NEXXUS PRODUCTS COMPANY

Address:

NEXXUS PRODUCTS COMPANY 618 EAST GUTIERREZ STREET SANTA BARBARA, CA 93103

United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

HAIR SHAMPOO, HAIR CONDITIONERS, HAIR SPRAYS, HAIR DYE SOLUTIONS AND NEUTRALIZING PREPARATIONS FOR USE IN PERMANENT HAIR WAVING, SKIN CLEANING PREPARATIONS, AND SKIN CONDITIONERS

International Class: 003 First Use Date: 19791200

First Use in Commerce Date: 19791200

Basis: 1(a)

VITAMINS AND DIETARY FOOD SUPPLEMENTS

International Class: 005 First Use Date: 19791200

First Use in Commerce Date: 19791200

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1992-01-02 - Section 8 (6-year) accepted & Section 15 acknowledged

1991-07-24 - Post Registration action mailed Section 8 & 15

1991-03-04 - Section 8 (6-year) and Section 15 Filed

1985-12-31 - Registered - Principal Register

1985-07-30 - Published for opposition

1985-07-01 - Notice of publication

1985-04-30 - Approved for Pub - Principal Register (Initial exam)

1985-04-18 - Ex parte appeal dismissed as moot

№ 1983-07-06 - Ex parte appeal - Instituted

* 1981-08-14 - Non-final action mailed

1981-06-09 - Case file assigned to examining attorney

1980-10-27 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

JOHN R. RYDELL, II (Attorney of record)

GRIFFITH AND THORNBURGH P.O. DRAWER A SANTA BARBARA, CALIFORNIA 93102-0009

United States

This page was generated by the TARR system on 07/16/2002 11:14:26 ET

Serial Number: 72412601

Registration Number: 971521

Mark (words only): REDKEN

Current Status: This registration has been renewed.

Date of Status: 1993-12-22

Filing Date: 1972-01-14

Registration Date: 1973-10-23

Law Office Assigned: Unknown

CURRENT APPLICANT(S)/OWNER(S)

1. REDKEN LABORATORIES, INC.

Address:

REDKEN LABORATORIES, INC.

6625 VARIEL AVENUE

CANOGA PARK, CA 91309

United States

State or Country of Incorporation: Delaware

*Legal Entity Type: Corporation

GOODS AND/OR SERVICES

HAIR CONDITIONERS, WAVE SETS, HAIR SPRAYS, PERMANENT WAVE LOTIONS, HAIR

LIGHTENERS, HAND LOTIONS, AND FACE AND SKIN CREAMS

U.S. Class: 051 (International Class 003)

First Use Date: 19600000

First Use in Commerce Date: 19600000

: Basis: 1(a)

HAIR SHAMPOOS AND WOMEN'S BEAUTY SOAP

U.S. Class: 052 (International Class 003)

First Use Date: 19600000

First Use in Commerce Date: 19600000

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s): 915199

PROSECUTION HISTORY

1993-12-22 - Registration renewed - 10 year

1993-10-14 - Response received for Post Registration action

1993-09-01 - Post Registration action mailed - Section 9

1993-07-19 - Section 9 filed/check record for Section 8

1980-01-28 - Section 8 (6-year) accepted & Section 15 acknowledged

CONTACT INFORMATION

Correspondent (Owner)
KURT B. BLOEDEL
REDKEN LABORATORIES, INC.
6625 VARIEL AVENUE
CANOGA PARK, CA 91309
United States

TRADEMARK RETURN POSTCARD ATTY PLAN SECY COL DATEO 7/16/12 ATTY DOCKET NO. 875969

CERT OF MATLICERT OF SERVICE/EXPRESS MAIL LABEL NO.

(MAPPREGIOPPICANC # NO DE CALLI PUECL

OF: SEXY HOLD CONCERNS LLC V

FOR: (A) TOTAL TO THE

RECEIPT IS ACKNOWLEDGE BY THE USPTO FOR THE FOLLOWING: TRADEMARK APPLICATION: USE _ITU SPECIMENS _ DRAWING PAGE RENEWAL APPLICATION RESPONSE TO ACTION TRANSMITTAL LETTER ASSIGN/CHG NAME/MERGER/SEC INT _ASSIGNATION NAME/MERGENOSE II
NOTICE OF APPEAL/APPEAL BRIEF
_TOTICE OF OPPOSITION
PETITION TO CANCEL AFF/DEC 8 / 15 / 8&15 AMEND TO ALLEGE USE STATEMENT OF USE REQ.EXT. TIME TO OPPOSE REQ.EXT. TIME FOR SOU FOREIGN REG PET/MOT FOR EXT. OF TIME TRANSLATION COUNTRY APPOINT DOMESTIC REPRESENTATIVE REG. NO. REVOC/APPT. OF ATTORNEY AMEND/REQ. RECONSIDERATION OTHER (PAPER TITLE) FEE AUTH CHARGE B.S.A.I. DEPOSIT. ACCT. #02-0755 \$300.00

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P

ATTORNEYS AT LAW

AUSTIN
BRUSSELS
DALLAS
HOUSTON
LONDON
LOS ANGELES
MOSCOW
NEW YORK
PHILADELPHIA
SAN ANTONIO
WASHINGTON, D.C.

A REGISTERED LIMITED LIABILITY PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

ONE COMMERCE SQUARE, SUITE 2200 2005 MARKET STREET PHILADELPHIA, PA 19 103-7086 (215) 965-1200

FAX (215) 965-1210 www.akingump.com

WRITER'S DIRECT DIAL NUMBER (2 | 5) 965- | 240
WRITER'S E-MAIL ADDRESS RJACOB-MEADWAY@AKINGI IMP COM

RYADH - IN AFFILIATION WITH THE LAW OFFICE OF ABDULAZIZ H. FAHAD

October 13, 2000

VIA FEDERAL EXPRESS

Mr. Shawn Wiser
Big Sexy Face Cosmetics, Inc.
24600 S. Tamiami Trail
Suite 212-373
Bonita Springs, Florida 34134

Re: "BIG SEXY" Trademarks of Ecoly International, Inc.

Our File No.: 200055-5003

Dear Mr. Wiser:

This has reference to my letter of September 26, 2000, a copy of which is attached.

As stated previously, Ecoly is very concerned that your company's use of the "BIG SEXY" mark and the silhouette of a woman and Ecoly's "BIG SEXY" mark and logo are confusingly similar in sound, appearance and overall commercial impression. Since the parties' goods are competitive, directed to the same types of customers through the same trade channels, confusion is not only likely, it is inevitable.

Accordingly, any use of "BIG SEXY" and the silhouette logo cosmetics is deemed to constitute trademark infringement and unfair competition in violation of our client's rights under federal, state and common law.

If you do not provide to us written confirmation by the close of business on October 20, 2000 Big Sexy Face Cosmetics, Inc. will immediately take steps to:

- 1. Terminate its use of the "BIG SEXY" mark;
- 2. Provide Ecoly with an accounting, specifically, the amount of "BIG SEXY" products sold, identify to whom the product was sold

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.

Shawn Wiser October 13, 2000 Page 2

and indicate the amount of revenue generated from sales of the "BIG SEXY" product;

- 3. Terminate all advertising and recall all point-of-sale displays for the "BIG SEXY" mark:
- 4. Stop production of "BIG SEXY" products; and
- 5. Destroy all packaging, including bottles and/or containers, which include the "BIG SEXY" mark

Ecoly reserves the right to take all such further action as it deems appropriate to protect its trademark rights with no further notice to you.

Very truly yours,

AKIN, GUMP, STRAUSS, HAUER & FELD, LLP

ROBERTA JAZOBS-MEADWAY

RJM:EFS/cda Enclosure

cc: Mr. Mark Stiller

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P

ATTORNEYS AT LAW

AUSTIN
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A REGISTERED LIMITED LIABILITY PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS
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2005 MARKET STREET
PHILADELPHIA, PA 19103-7086
(215) 965-1 200

FAX (2!5) 965-1210 www.akingump.com

RYADH - IN AFFILIATION WITH THE LAW OFFICE OF ABDULAZIZ H, FAHAD WRITER'S DIRECT DIAL NUMBER 2 | 5-965-1 240
WRITER'S E-MAIL ADDRESS rjacobs-meadway@akingump.com

December 4, 2000

VIA FACSIMILE AND MAIL

Sanford M. Martin, Esquire 2500 Airport Road, South Suite 315 Naples, FL 34112

Re:

Big Sexy Face Cosmetics, Inc. Infringement of Ecoly's

"BIG SEXY" mark and logo Our File No. 200055.5003

Dear Mr. Martin:

We are in receipt of your letter of October 31, 2000. As you have requested, we have enclosed additional information which describes and identifies the reach of Ecoly International, Inc.'s "BIG SEXY" mark and line of products.

As the materials clearly demonstrate, Ecoly's "BIG SEXY" mark and the silhouette logo are favorably known within the beauty industry and solely associated with Ecoly's products. Ecoly's "BIG SEXY" line of products is advertised nationally and has received favorable unsolicited media recognition. For example, *Salon News*, a nationally circulated publication for salon owners, featured Ecoly's "BIG SEXY" line of products in its March 1999 issue. More recently, the February 2000 issue of *Redbook* recommended Ecoly's "BIG SEXY" line of products to its readers.

Ecoly has used "BIG SEXY" and the silhouette of a woman as its marks in connection with hair care products since at least as early as June 15, 1998. Ecoly's use of the "BIG SEXY" mark and silhouette logo clearly predates your client's use of the "BIG SEXY" mark. In addition, Ecoly sells beauty and hair products. Your client sells cosmetics. Such products are customarily sold and marketed through the same and overlapping channels of trade, to the same and overlapping classes of purchasers. Therefore, it is common and expected that companies will use the same mark for hair and skin care products. Examples of the use of the same mark for hair and skin care products include "AVON", Registration No. 633.318, and "NEXXUS", Registration No. 1,376,635.

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.

December 4, 2000 Page 2

Your client's use of the "BIG SEXY" mark and the silhouette of a woman in connection with cosmetics is confusingly similar in sound, appearance and overall commercial impression to Ecoly's mark and logo. Thus, it is evident that consumers will believe that your client's goods are another line of products emanating from Ecoly or are associated with Ecoly.

It is clear that your client seeks to capitalize on the success of Ecoly's "BIG SEXY" mark and name within the beauty industry. Accordingly, your client's continued use of "BIG SEXY" mark and the silhouette logo constitutes trademark infringement and unfair competition in violation of our client's rights under federal, state and common law.

Under the circumstances, we repeat our demand that your client provides us with written confirmation and without prejudice to any other claim or demand, that it will immediately take the following steps:

- 1. Terminate its use of the "BIG SEXY" mark;
- 2. Provide Ecoly with an accounting, specifically, the amount of "BIG SEXY" products sold, identify to whom the product was sold and indicate the amount of revenue generated from sales of the "BIG SEXY" product;
- Terminate all advertising and recall all point-of-sale displays for the "BIG SEXY" mark;
- 4. Stop production of "BIG SEXY" products; and
- 5. Destroy all packaging, including bottles and/or containers, which includes the "BIG SEXY" mark and/or logo.

Our client intends to enforce its trademark rights. Therefore, if we do not receive written commitment that the use of Ecoly's "BIG SEXY" mark and the silhouette logo will cease by December 15, 2000, we will proceed to take such action as is appropriate with no further notice to you or your client.

Sincerely,

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.

RJM:EFS/ral

Enclosures

cc: Mark Stiller

Sanford M. Martin, P.A.

Attorney at Law

55-5200

A Professional Law Association

2500 Airport Road, S. - Suite 315 Naples, Florida 34112

> (941) 774-4000 Fax: 774-9611

Licensed in Florida and Illinois

October 23, 2000

Roberta Jacobs-Meadway, Esquire Akin, Gump, Strauss, Hauer & Feld One Commerce Square, Suite 2200 2005 Market Street Philadelphia, PA 19103-7086

Alleged "Big Sexy" Trademark Infringement; Big Sexy Face Cosmetics, Inc.

Dear Ms. Jacobs-Meadway:

We have reviewed your letters of September 26, 2000, and October 13, 2000. In behalf of our client, Big Sexy Face Cosmetics, Inc., we wish to assure you that prompt attention will be given to your expressed concerns regarding alleged trademark infringement of the "Big Sexy" trademarks.

However, based on the information provided by you, our client is not persuaded that its use of the "Big Sexy Face" mark for certain cosmetics has any real or potential effect on the use of the Big Sexy marks by Ecoly International, Inc. for hair products. For example, you mention that our client's use of its mark creates inevitable confusion in the marketplace since the two companies compete for customers through the same trade channels. Information provided by you does not support this conclusion. Contrary to the assertion of your letter dated September, 26, 2000, BSFC did not adopt the name or the logo of your client to take advantage of your client's goodwill, if any.

Therefore, we assure you that BSFC, Inc. will further review the information provided by you as well as conduct its own study of this matter. If you have additional information describing and identifying the products and markets of your client, please send them to this office. We will appreciate your cooperation.

Sincerely,

SMM/tm

cc: Shawn Wiser

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500

> FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

BALTIMORE, MD
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

September 18, 2002

BOX TTAB - FEE Commissioner Trademarks 2900 Crystal Drive Arlington, VA 22202-3513

Dear Sir:

We are enclosing herewith the following documents set forth below, which are to be filed in the Patent and Trademark Office.

Please charge all government filing fees with respect to the enclosed documents to our Miscellaneous Account No. 02-0755.

Very truly yours,

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

ROBERTA JACOBS-MEA

Enclosures: Petition to Cancel

Sexy Hair Concepts, LLC v. Sexy Scissors, LLP

Reg. No.: 2,617,386 for SEXY SCISSORS & Design

Fee: \$300.00

Attorney Docket No. 891019

cc.

Dawn Deissler

Carolyn Andress

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513 ON THE DATE INDICATED BELOW

By: (Judith Laurene)

RJM/pgc

PHL A #1668541 v1

I HEREBY CERTIFY THAT THIS CORRES DENCE IS BEING DEPOSITED WITH THE UNITED STATES POS SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ALLESSED TO THE COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513 ON THE DATE INDICATED BELOW

By: Quith Coulties

DATE: Applember 18, 1002

BOX TTAB - FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SEXY HAIR CONCEPTS, LLC

Petitioner,

V.

Cancellation No.

SEXY SCISSORS, LLP

Respondent

PETITION TO CANCEL

The Honorable Commissioner of Trademarks 2900 Crystal Drive Arlington, VA 22202-3513

Dear Sir:

In the matter of Trademark Registration No. 2,617,386 issued September10, 2002 for the mark "SEXY SCISSORS & DESIGN"

Sexy Hair Concepts, LLC, a California corporation having a place of business at 9232 Eton Avenue, Chatsworth, California 91311 (SHC), believes it will be damaged by the continued registration of the mark sought to be canceled and hereby petitions to cancel the registration of said service mark. The grounds for the petition to cancel are as follows:

1. SHC develops and markets hair care products through beauty salons and other outlets.

- 2. Since at least as early at 1998, SHC and its predecessor in interest and title (collectively, "SHC") have used "SEXY" as the dominant element of its name and marks in United States commerce for its business and its hair care products.
- 3. Information about SHC's products can be found at its website, www.sexyhairconcepts.com. A printout from such website showing SHC's use of "SEXY" as the dominant element of its name and marks is attached as Exhibit A.
- 4. SHC has secured U.S. trademark registrations for marks which have as the dominant element "SEXY" for hair care products. SHC owns, <u>inter alia</u>, U.S. Registration Nos. 2,403,396; 2,472,793; 2,486,702; and 2,553,996. Printouts from the Trademark Office's online database directed to these registrations are attached as Exhibits B-E. These registrations are valid and subsisting.
- 5. As the Exhibits hereto demonstrate, SHC depicts the letter "X" in its logo in a stylized form that is distinctive.
- 6. The "SEXY" name and marks of SHC are inherently distinctive and have acquired distinctiveness in connection with hair care products sold through hair salons by virtue of the nature and extent of SHC's use of such name and marks in commerce.
- 7. Registration No. 2,617,386 for "SEXY SCISSORS & Design" issued for cosmetology and barbershop services, namely, hair cutting, hair styling and hair dressing to Sexy Scissors, LLP on September 10, 2002.
- 8. Respondent's mark is confusingly similar to SHC's previously used "SEXY" name and registered "SEXY" marks when used in connection with Respondent's services.

- 9. The design element of Respondent's mark mimics the stylization of the "X" in SHC's mark.
- 10. The dominant element of Respondent's mark is "SEXY", which is the dominant element of SHC's name and registered "SEXY" marks.
- 11. The addition of the generic term "SCISSORS" to the mark of the registration which is the subject of this petition is insufficient to obviate the likelihood of confusion created by the common use of "SEXY" as the dominant elements and the close similarity in the presentation of the letter "X", granted the close relationship between the goods and services of the parties.
- 12. The goods of SHC and the services of Respondent are closely related.

 SHC's products are sold through salons which do hair cutting, styling and dressing and cosmetology and which are used in connection with the rendering of such services.
- 13. SHC has priority with respect to the respective name and marks, as Respondent claims no date of use earlier than March 21, 2001.
- 14. Members of the relevant public and trade who are familiar with SHC's business and products seeing Respondent's mark used in connection with Respondent's services are likely to believe, and would be justified in believing, that SHC and Respondent are affiliated, that Respondent uses SHC's name and products with the authorization of SHC, or that Respondent's services are offered by or under license from SHC as a natural extension of SHC's business.
- 15. Granted the likelihood of confusion between SHC's name and marks and Respondent's mark as applied to the respective business, goods and services of the parties,

respondent's registration, if permitted to remain in force, is likely to cause injury and damage to Petitioner. Any objection to or fault found with Respondent's services rendered under Respondent's mark is likely to have an adverse impact on SHC and the goodwill associated with its name and marks.

16. Said registration, if permitted to remain in force, accords to respondent the prima facie exclusive right to use the mark for the services identified in the Certificate of Registration, which prima facie right is in derogation of SHC's rights in its "SEXY" name and "SEXY" marks, all constituting a source of damage to SHC.

WHEREFORE, Petitioner, Sexy Hair Concepts, LLC requests that Registration No. 2,617,386 for the "SEXY SCISSORS & DESIGN" mark be cancelled and that this Petition to Cancel be granted.

A duplicate of this Petition to Cancel is enclosed herewith.

Please charge the filing fee of \$300.00 to Miscellaneous Account No. 02-0755.

Respectfully submitted,

Date: 9/18/02

By: Mohard Jacobs-Meadway

Roberta Jagobs-Meadway

Richard E. Peirce Patricia G. Cramer

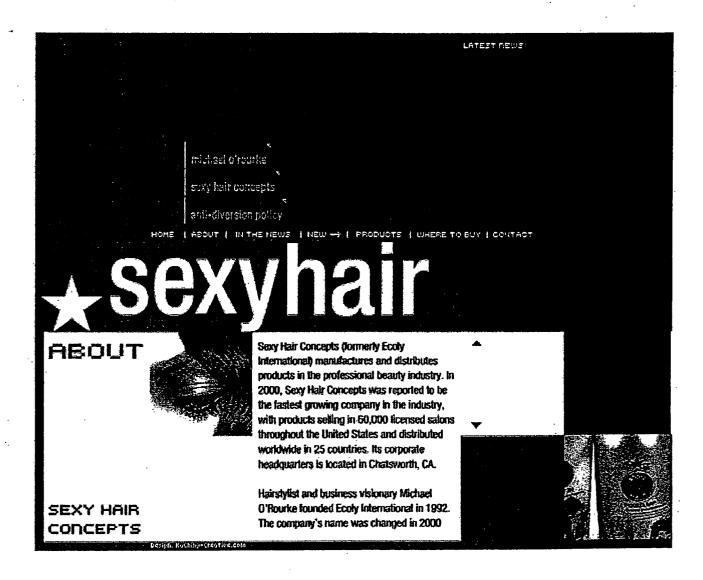
Ballard Spahr Andrews & Ingersoll, LLP

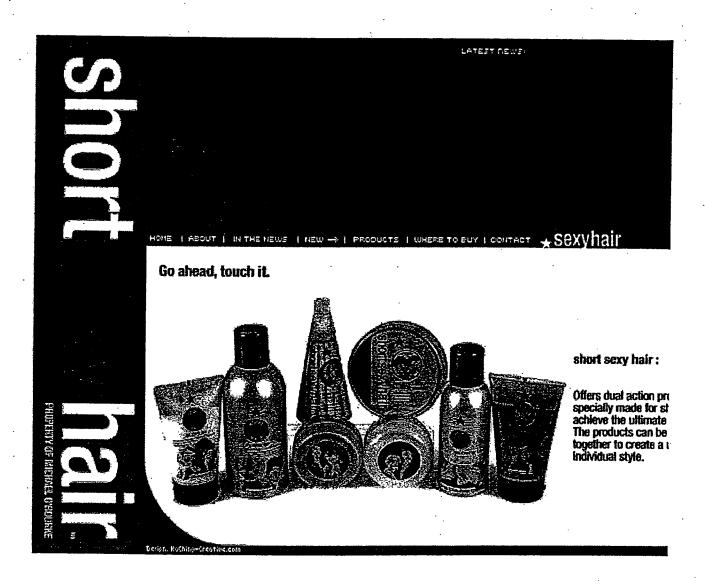
1735 Market Street, 51st Floor Philadelphia, PA 19103-7599

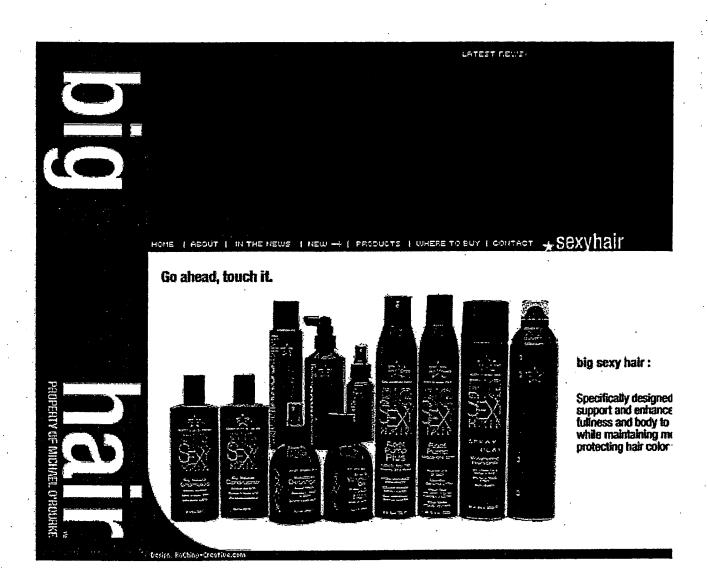
(215) 862-8201 - phone

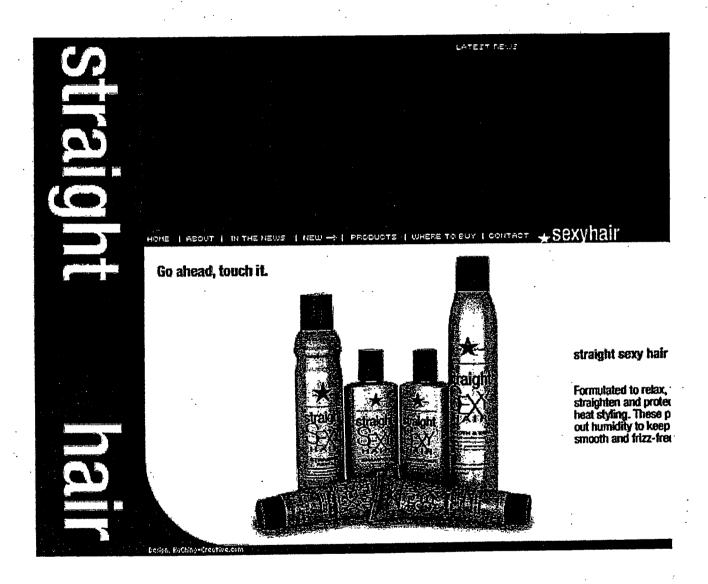
(215) 864-9950 - fax

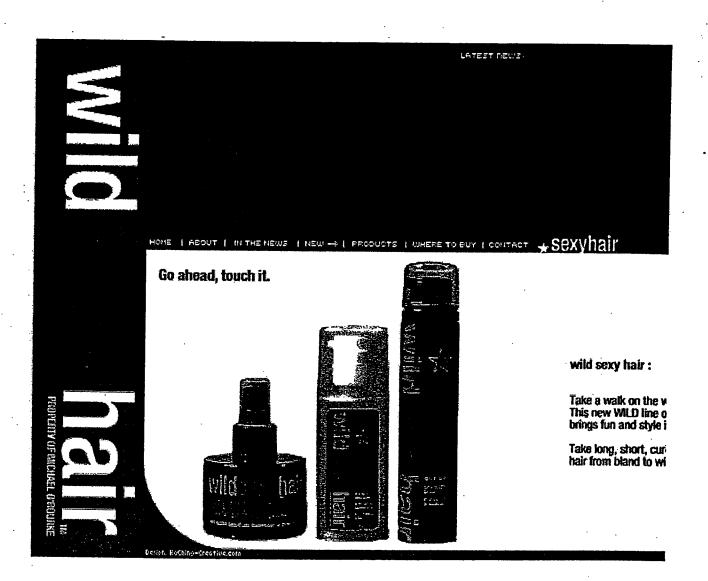
ATTORNEYS FOR PETITIONER













UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Wed Sep 18 04:32:44 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DIGT BOTTOM

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark

SEXY HAIR

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels,

hair sprays, hair color, hair dyes, hair rinses, hair mousse. FIRST USE: 19980615.

FIRST USE IN COMMERCE: 19981221

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number 75634213

Filing Date

February 5, 1999

Published for

Opposition

August 22, 2000

Registration

Number

2403396

Registration

Date

November 14, 2000

Owner

(REGISTRANT) Ecoly International, Inc. CORPORATION CALIFORNIA 9232

Eton Avenue Chatsworth CALIFORNIA 91311

Attorney of

Record

Roberta Jacobs-Meadway

Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAIR" APART

FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register

PRINCIPAL

Live/Dead

Indicator

LIVE



UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Wed Sep 18 04:32:44 EDT 2002

PTO HOME TRADERARK TESS HOME NEW USER STRUCTURED FREE FORM GROWSE DICT EGITOM

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Record 1 out of 1

(TARR contains current status, correspondence address and attorney of record for this Check Status mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark

FORMULAS BY ECOLY BIG SEXY HAIR

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair

gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse. FIRST USE:

19980615. FIRST USE IN COMMERCE: 19981221

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number 75730741

Filing Date

June 17, 1999

Published for

Opposition

May 8, 2001

Registration

Number

2472793

Registration

Date

July 31, 2001

Owner

(REGISTRANT) Ecoly International, Inc. CORPORATION CALIFORNIA 9232

Eton Avenue Chatsworth CALIFORNIA 91311

Attorney of

Record

Roberta Jacobs-Meadway

Prior Registrations

1866675

Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAIR" APART

FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead Indicator

LIVE

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM EROWSE DICT TOP HELP



UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Wed Sep 18 04:32:44 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark

SEXY HAIR

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: hair care products for men, women and children, namely shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse. FIRST USE: 19980615. FIRST

USE IN COMMERCE: 19981221

Mark Drawing

Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search

Code

261112

Serial Number 75751842

Filing Date

July 15, 1999

Published for

Opposition

June 19, 2001

Registration

Number

2486702.

Registration

Date

September 11, 2001

Owner

(REGISTRANT) Ecoly International, Inc. CORPORATION CALIFORNIA 9232

Eton Avenue Chatsworth CALIFORNIA 91311

Attorney of Record

Roberta Jacobs-Meadway

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT 1. USE "HAIR" APART Disclaimer

FROM THE MARK AS SHOWN

Description of

Mark

THE MARK IS LINED FOR THE COLOR RED.

Type of Mark TRADEMARK

Register

PRINCIPAL -

Live/Dead

LIVE

Indicator

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM SKOWSK DICT



UNITED STATES PATENT AND TRADEMARK OFFICE



TESS was last updated on Wed Sep 18 04:32:44 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM GROWSE DICT BOTTOM

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

(TARR contains current status, correspondence address and attorney of record for this Check Status mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark

HOT SEXY HIGHLIGHTS

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: hair care products for men, women and children, namely, shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse. FIRST USE: 20000700. FIRST

USE IN COMMERCE: 20000700

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number 76075306

Filing Date

June 22, 2000

Filed ITU

FILED AS ITU

Published for

Opposition

March 27, 2001

Registration

Number

2553996

Registration

Date

March 26, 2002

Owner

(REGISTRANT) Ecoly International, Inc. CORPORATION CALIFORNIA 9232

Eton Avenue Chatsworth CALIFORNIA 91311

Attorney of Record

ROBERTA JACOBS-MEADWAY

Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HIGHLIGHTS"

APART FROM THE MARK AS SHOWN

TRADEMARK Type of Mark

Register

PRINCIPAL

SH 1771

Live/Dead

LIVE

Rv.	
By:	
	BOX TTAB FEE
	ES PATENT AND TRADEMARK OFFICE EMARK TRIAL AND APPEAL BOARD
Ecoly International, Inc.	:
Opposer,	:
	: · ·
v.	: Opposition No.
	:
Performance Brands, Inc.	:
Applicant.	:
NOT	ICE OF OPPOSITION
Honorable Assistant Commissioner for 2900 Crystal Drive Arlington, Virginia 22202-3513	Trademarks
Dear Sir/Madam:	
In the matter of Tradema	ark Application Serial No. 78/021257 for the mark

In the matter of Trademark Application Serial No. 78/021257 for the mark
"SEXY BATH & BODY", filed August 15, 2000 and published for opposition in the Official
Gazette on May 8, 2001 at page TM 159:

Ecoly International, Inc., a California corporation having a place of business at 9232 Eton Avenue, Chatsworth, California 91311 ("Opposer"), believes that it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes the same. The grounds for opposition are as follows:

1. Opposer is and has been engaged in the development, manufacture and sale of beauty products and hair care products for men, women and children and has built a successful business in connection therewith.

MD_DOCS_A #1144439 v2

- 2. Performance Brands, Inc., a Florida corporation ("Applicant"), seeks to register "SEXY BATH & BODY" as a trademark for use in connection with skin care products, namely liquid body wash, moisturizing lotions, shampoo and conditioner, as evidenced by the publication of said mark in the Official Gazette on May 8, 2001, at page TM 159.
- 3. Opposer filed an application to register its trademark "SEXY HAIR" with the United States Patent and Trademark Office (the "PTO") on February 5, 1999. The registration for Opposer's mark "SEXY HAIR" was issued on November 14, 2000 (Registration No. 2403396). Opposer first used this mark no later than June 15, 1998, and first used this mark in commerce no later than December 21, 1998. Promotional material showing the "SEXY HAIR" product is attached as Exhibit A.
- 4. Opposer filed an application to register its trademark "FORMULAS BY ECOLY BIG SEXY HAIR" with the PTO on June 17, 1999 (Serial No. 75/730741). Opposer first used this mark no later than June 15, 1998, and first used this mark in commerce no later than December 21, 1998. Promotional material showing the "FORMULAS BY ECOLY BIG SEXY HAIR" product is attached as Exhibit B.
- 5. Opposer filed an application to register its trademark "SEXY HAIR" and design with the PTO on July 15, 1999 (Serial No. 75/751842). Opposer first used this mark no later than June 15, 1998, and first used this mark in commerce no later than December 21, 1998. Promotional material showing the "SEXY HAIR" and design product is attached as Exhibit C.
- 6. Opposer filed an application to register its trademark "SEXY HAIR CONCEPTS" and design with the PTO based on Opposer's bona fide intent to use this mark on April 4, 2000 (Serial No. 76/017117). Opposer first used this mark no later than July 1, 2000,

and first used this mark in commerce no later than July 1, 2000. Promotional material showing the "SEXY HAIR CONCEPTS" and design product is attached as Exhibit D.

- 7. Opposer filed an application to register its trademark "HOT SEXY HIGHLIGHTS" with the PTO based on Opposer's bona fide intent to use this mark on June 22, 2000 (Serial No. 76/075306). Opposer first used this mark no later than ______, and first used this mark in commerce no later than ______. Promotional material showing the "HOT SEXY HIGHLIGHTS" product is attached as Exhibit E.
- 8. Opposer, prior to the filing date of the application herein opposed, filed applications to register its marks "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR CONCEPTS" and design and "HOT SEXY HIGHLIGHTS". Opposer has, since prior to the filing date of the application herein opposed, used and continues to use the marks "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR CONCEPTS" and design [and "HOT SEXY HIGHLIGHTS"] as trademarks in connection with hair care products.
- 9. Opposer's trademarks "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR CONCEPTS" and design and "HOT SEXY HIGHLIGHTS" are inherently distinctive as applied to Opposer's hair care products.
- 10. By virtue of Opposer's use in commerce of its "SEXY HAIR",
 "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR
 CONCEPTS" and design and "HOT SEXY HIGHLIGHTS" trademarks in connection with its
 goods, such goods have become favorably known to the relevant trade and public under such
 marks.

- 11. By virtue of sales in commerce of hair care products under the "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design and "SEXY HAIR CONCEPTS" and design trademarks, the relevant trade and public have come to recognize products sold under these trademarks and associate such products with Opposer and with no other entity.
- 12. By virtue of Opposer's use of the "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR CONCEPTS" and design and "HOT SEXY HIGHLIGHTS" trademarks, Opposer has created a family of marks which is recognized by the relevant trade and public as used in connection with its products.
- 13. Applicant bases its application to register "SEXY BATH & BODY" on a claim of an intent to use the mark.
- 14. Opposer's dates of first use for its "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design and "SEXY HAIR CONCEPTS" and design trademarks predate Applicant's filing date for its "SEXY BATH & BODY" mark. Opposer has priority based on actual use.
- 15. Opposer's filing dates for its "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR CONCEPTS" and design and "HOT SEXY HIGHLIGHTS" trademarks predate Applicant's filing date for its "SEXY BATH AND BODY" mark. Opposer has priority based on constructive use.
- 16. Applicant's mark uses the term "SEXY", which is the term that Opposer has used, and continues to use, to distinguish its family of marks.
- 17. Applicant's mark is highly similar in appearance, sound and overall commercial impression to Opposer's marks.

- 18. The goods of Applicant are closely related and complementary to the goods of Opposer. Opposer sells beauty and hair care products. The goods identified in Applicant's application for "SEXY BATH & BODY" are skin care products such as liquid body washes and moisturizing lotions, and shampoos and conditioners that are traditionally considered hair care products. Hair care products, skin care products and other health and beauty products are customarily sold and marketed through the same channels of trade.
- 19. It is common and therefore expected for companies to use the same mark for hair care products and skin care products as part of a line of related health and beauty products, all distributed under a common mark. The following third party registrations demonstrate the related nature of hair care products and other health and beauty products, including skin care products:

Mark	Registration No.	Goods
JOHNSON'S ULTRA SENSITIVE and Design	2,155,403	Cosmetics and toiletries, namely, hair shampoo, skin lotion, skin cleansers, skin cream, body soap
TCB (Stylized)	1,256,544	Hair shampoo, hair conditioner, hair lotion, skin lotion, hair relaxer, hair spray
GARNIER EXPERT	1,889,558	Non-medicated hair care preparations, namely, shampoo, conditioner, lotion, spray and mousse; hair color preparations; skin and body creams and lotions; shave cream, after-shave lotion
SILKY KARE	1,655,196	Non-medicated skin and hair care preparations; namely, skin lotion, emollients, shampoo and conditioners
GLY SILK	2,038,351	Skin and hair care products, namely, hair shampoo, facial cleanser, body wash, hand cream, body lotion, face toner, facial peels, foot cream, sunblock, face creams, and moisturizers
PALMER'S (Stylized)	1,610,344	Inter alia, cocoa butter, suntan oil cream, moisturizing lotion and cream, hair shampoo and conditioners, hair color, hair holding spray, hair

		moisturizers
PAUL MITCHELL THE CONDITIONER and Design	1,750,932	Non-medicated hair and skin care conditioner for detangling hair, moisturizing hair, treating scalp and skin, thermal control during waving and drying, shaving lotion, skin massage and skin protein additive
NEXXUS (Stylized)	1,376,635	Inter alia, hair shampoo, hair conditioners, hair sprays, skin cleaning preparations, and skin conditioners
ALL SENSITIVE and Design	2,096,884	Skin care products, namely, moisturizer, toner and cleanser; and hair care products, namely shampoo, conditioner and styling gel
BEESILK	2,006,197	Skin care cream; hair care cream; lip care cream; sunburn cream
REDKEN	971,521	Hair conditioners, wave sets, hair sprays, permanent wave lotions, hair lighteners, hand lotions, and face and skin creams; hair shampoos and women's beauty soap

Copies of printouts showing the pertinent information about these registrations are attached hereto as Exhibit F.

- 20. The goods of Applicant identified in the application herein opposed and the goods of Opposer are such as would be sold in the same areas of the same stores, namely the health and beauty aids sections in grocery stores and supermarkets and professional hair care salons.
- 21. The identification of goods in the application herein opposed is not limited as to channels of trade.
- 22. The products marketed and sold under Opposer's "SEXY HAIR",
 "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR
 CONCEPTS" and design and "HOT SEXY HIGHLIGHTS" trademarks, and the products

intended to be sold under Applicant's "SEXY BATH & BODY" mark are such as would be sold to an overlapping class of purchasers, namely men, women and children, generally.

- 23. Applicant's "SEXY BATH & BODY" trademark as applied to the goods set forth in the application herein opposed so resembles Opposer's "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR CONCEPTS" and design and "HOT SEXY HIGHLIGHTS" trademarks as applied to Opposer's products that it is likely to cause confusion, mistake, and/or deception.
- 24. If Applicant is permitted to register "SEXY BATH & BODY" for the goods set forth in the application, confusion of the relevant trade and public is likely to result which will damage and injure Opposer.
- 25. On seeing Applicant's "SEXY BATH & BODY" mark used in connection with Applicant's goods, purchasers and potential purchasers are likely to believe in error that such goods are offered in association with or under license from Opposer, that Opposer and Applicant are affiliated or that Opposer's goods and Applicant's goods are sold as parts of a single line of health and beauty products.
- 26. Any defect, objection to or fault found with Applicant's goods sold under its mark "SEXY BATH & BODY" would necessarily reflect on and seriously injure the reputation that Opposer has established for the goods provided under its "SEXY HAIR", "FORMULAS BY ECOLY SEXY HAIR", "SEXY HAIR" and design, "SEXY HAIR CONCEPTS" and design and "HOT SEXY HIGHLIGHTS" trademarks.
- 27. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Ecoly International, Inc. prays that registration of the mark of Application Serial No. 78/021257 be refused and that this opposition be sustained.

A duplicate copy of this Notice of Opposition is enclosed herewith.

A check in the amount of \$300 is enclosed for the filing fee. Any additional fees in connection with this opposition may be charged to Deposit Account No. _____ and any overpayment may be credited to this account.

Respectfully submitted,

By:

Roberta Jacobs-Meadway Tracy A. Bacigalupo BALLARD SPAHR ANDREWS & INGERSOLL, LLP 1735 Market Street, 51st Floor Philadelphia, Pennsylvania 19103-7599 (215) 665-8500

Dated:

ATTORNEYS FOR OPPOSER

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500

FAX: 215-864-8999 LAWYERS@BALLARDSPAHR.COM

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

BALTIMORE, MD
CAMDEN, NJ
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

October 10, 2001

VIA OVERNIGHT MAIL

Stacy Kaufman
Performance Brands Inc.
959 Shot Gun Road
Sunrise, FL 33326

Re:

Ecoly International Inc. and Performance Brands Inc.

Trademark Opposition No. 123,841

Our File No. 887165

Dear Ms. Kaufman:

In accordance with the first numbered paragraph of the Agreement, please find enclosed a copy of the Settlement Agreement fully executed on behalf of Ecoly International, Inc. along with Ecoly Check No. 21361 in the amount of \$2,500.00.

Also enclosed is a copy of the Notice of Withdrawal of Opposition as it was filed with the TTAB.

Thank you for your cooperation in resolving this matter amicably.

Very truly yours,

RJ/cda

Enclosure

cc:

Ecoly International Inc.

			·	
21361	NET CHECK AMOUNT	2500.00		
	DISCOUNT TAKEN	00.0		
	AMOUNT PAID	2500.00		
	INVOICE AMOUNT	2500.00		
NC NC	INVOICE DATE	09/28/01	·	
ECOLY INTERNATIONAL, INC	YOUR INVOICE	O34383 AGREEMENT		
ECOLY IN	OUR REF.	034383		

T 92		ⅎ
21361	CHECK AMOUNT	021361 \$******2500.00
BANK 2	CONTROL	021361
HARRIS TRUST AND SAVINGS BANK ROSELLE, ILLINOIS 60172 70-1558/719	CHECK DATE	10/05/01

PAY TWO Thousand Five Hundred and 00/100 ------

9232 ETON AVENUE CHATSWORTH, CA 91311 (818) 718-6982 TO THE ORDER DERFORMANCE BRANDS , OF 959 SHOTGUN ROAD SUNRISE FL 33326

INC

ECOUNINGERINGTIONAL, IN

-- dollars

SETTLEMENT AGREEMENT

This Settlement Agreement (Agreement) is entered into effective September 24, 2001 between Ecoly International, Inc., a California corporation having a place of business at 9232 Ethan Avenuc, Chatsworth, CA 91311 (Ecoly) and Performance Brands, Inc., a Florida corporation having an address of 959 Shotgun Road, Sunrise, FL 33326 (Performance Brands).

WHEREAS, Performance Brands on August 15, 2000 filed an application for registration of "SEXY BATH & BODY", which application was assigned Scrial No. 78-021,257 (the Performance Brands Application); and

WHEREAS, the mark of the Performance Brands Application was published for opposition on May 8, 2001 and Ecoly timely filed a notice of opposition to registration of the mark of the Performance Brands Application; and

WHEREAS, the Trademark Trial and Appeal Board has initiated the opposition proceeding as Opposition No. 123,841 (the Opposition Proceeding); and

WHEREAS, the parties have exchanged information and wish now to resolve amicably the dispute between them.

In consideration of the foregoing, and in consideration of the undertakings set forth hereinafter, and intending to be legally bound, the parties agree as follows:

1. Ecoly will within five (5) business days of the date of its receipt of this Agreement executed by Performance Brands pay to Performance Brands the sum of Twenty Five hundred dollars (\$2,500.00).

SH 1679

8871165

SENT BY:

1532483 v1

- 2. Performance Brands assigns to Ecoly the mark of the Performance Brands
 Application and the Performance Brands Application and, concurrent with its execution of this
 Agreement, will execute the Assignment which is Exhibit A to this Agreement.
- 3. Performance Brands agrees that it will not use "SEXY" as a mark or component of a mark for any hair care product.
- 4. Performance Brands will provide to Ecoly with this executed Agreement any information that Performance Brands has on the use of "SEXY" as a mark or a component of a mark by others on or in connection with any hair care product.
- 5. Performance Brands will terminate promptly all use of "SEXY BATH & BODY" and toward that end, Performance Brands:
 - (a) will discard all unfilled packaging which beats the "SEXY BATH & BODY" mark;
 - (b) will certify to the disposition of such unfilled packaging, except that;
 - (c) Performance Brands may keep for archival purposes four (4) examples of such packaging and will forward one (1) such example to Ecoly with the executed copy of this Agreement.
- 6. Within five (5) business days of the date of its receipt of this Agreement and Exhibit A executed by Performance Brands, Ecoly will cause its counsel to file a withdrawal of the Opposition Proceeding and will forward to Performance Brands an as-filed copy of the notice of withdrawal of the Opposition Proceeding.

SH 1680

4

SEAL BY:

1532483 v1

- 7. This Agreement constitutes the entire understanding of the parties with respect to its subject matter. There are no other agreements or understandings, express or implied.
- 8. This Agreement is binding on the parties, their successors, assigns, related companies and affiliates.

ECOLY INTERNATIONAL J

Ву:___

Title: ()

PERFORMANCE BRANDS INC.

Stacy Kaufman

Title: President

SH 1681

18

MAIL IN AN ENVELOPE ADDRESSED TO THE CONTROL OF THE

BOX TTAB - NO FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

INTERNATIONAL, INC.

OPPOSER,

OPPOSITION NO. 123,841

TORMANCE BRANDS, INC.

APPLICANT.

NOTICE OF WITHDRAWAL OF OPPOSITION

Ecoly International, Inc., by its undersigned counsel, expressly withdrawals its its into registration of the mark of the Application Serial No. 78/021,257 based on the agreement of said application to opposer by Performance Brands, Inc. A copy of the agent is submitted herewith.

Accordingly, it is submitted that the opposition proceeding is moot.

Respectfully submitted,

Roberta Jacobs-Meadway, Esq.
Ballard Spihr Andrews & Ingersoll, Llp
1735 Market Street, 51st Floor

Philadelphia, PA 19103

ATTORNEYS FOR OPPOSER

icda

CERTIFICATE OF SERVICE

I, Carolyn Andress, hereby certify that a true and correct copy of the Notice of Withdrawal of Opposition in the matter of Ecoly International, Inc. v. Performance Brands, Inc., trademark Opposition No. 123,841, has been served on counsel for Applicant on the date shown below.

Date: 10/10/01

Carlo andress

ASSIGNMENT OF TRADEMARK

WHEREAS, Performance Brands, Inc., a Florida corporation having an address of 959

Shotgun Road, sunrise, FL 33326, has adopted and is using in its business the "SEXY BATH & BODY" trademark as shown in U.S. Trademark Application Serial No. 78/021,257.

WHEREAS, Ecoly International, Inc., a California corporation having an address of 9232

Eton Avenue, Chatsworth, CA 91311, is desirous of acquiring the said mark together with the goodwill of the business symbolized by the mark and the application therefore; and

WHEREAS, it is desired that the assignment of said application be made of record in the United States Patent and Trademark Office,

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, and intending to be legally bound hereby, said Performance Brands, Inc. hereby assigns to said Ecoly International, inc., the said "SEXY BATH & BODY" mark, together with the goodwill of the business symbolized by the said mark, and the application therefore, Serial No. 78/021,257

PERFORMANCE BRANDS, INC.

sy: Stacy Kaufman

Title: President

Dated: 0-04-01

SH 1684

1532483 v1

8871165

(Rev. 03/01) TRADEMARKS	ONLY U.S. Patent and Trademark Office	
OMB No. 0651-0027 (exp. 5/31/2002) Tab settings	Our File: 887165	
To the Honorable Commissioner of Patents and Trademarks: Pl	· · · · · · · · · · · · · · · · · · ·	
Name of conveying party(les): Performance Brands, Inc.	Name and address of receiving party(les)	
	Name: <u>Ecoly International, Inc.</u>	
☐ Individual(s) ☐ Association	Internal Address:	
General partnership	Street Address: 9232 Eton Avenue	
X Corporate-State: Florida	City: Chatsowrth State: CA ZIP: 91311	
Other		
Additional name(s) of conveying party(les) attached? OYes O No	Individual(s) citizenship	
3. Nature of conveyance:	Association	
X Assignment	General partnership	
Security Agreement Change of Name	Limited Partnership	
Other	★ Corporate-State <u>California</u>	
	Other	
Execution Date: 10/01/01	If assignee is not domiciled in the United States, a domestic	
	representative designation is attached QYes Q No- (Designations must be a separate document from assignment)	
Application number(s) or registration number(s):	Additional name(s) & address(es) attached? QYes Q No	
•		
A. Trademark Application No.(s) 78/021,257	B. Trademark Registration No.(s)	
 Additional number(s) attached ☐ Yes X No		
Name and address of party to whom correspondence	6. Total number of applications and	
concerning document should be mailed:	registrations involved:1	
Name: Roberta Jacobs-Meadway, Esquire		
Internal Address:		
Ballard Spahr Andrews & Ingersoll, LLP	7. Total Fee (37 CFR 3.41) \$ 40.00	
Street Address: 1735 Market Street, 51st Floor	☐ Enclosed	
•.•	X Authorized to be charged to deposit account	
City: Philadelphia State: PA Zip: 19103	8. Deposit account number: 02-0755	
	(Attach duplicate copy of this page if paying by deposit account)	
	<u></u>	
DO NOT USE T	THIS SPACE	
9. Statement and signature.		
To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.		
Roberta Jacobs-Meadway Roberta Jacobs-Meadway Roberta Jacobs-Meadway		
Name of Person Signing Signature Date		
Total number of pages including cover sheet, attachments, and document:		
Mail documents to be recorded with required cover sheet information to: Commissioner of Patent & Trademarks, Box Assignments, Washington, DC 20231		
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED		
AN ENVELOPE ADDRESS TO: U.S. PATENT AND TRADEMARK OFFICE, WASHIJHOTON, QC 2023-1	OFFICE OF PUBLIC RECORDS, CRYSTAL GATEWAY 4, ROOM 335,	
Br. Cael, Undus	DATE: 10/10/01	
CAROLYN ANDRESS	SH 168	

ASSIGNMENT OF TRADEMARK

WHEREAS, Performance Brands, Inc., a Florida corporation having an address of 959 Shotgun Road, sunrise, FL 33326, has adopted and is using in its business the "SEXY BATH & BODY" trademark as shown in U.S. Trademark Application Serial No. 78/021,257.

WHEREAS, Ecoly International, Inc., a California corporation having an address of 9232 Eton Avenue, Chatsworth, CA 91311, is desirous of acquiring the said mark together with the goodwill of the business symbolized by the mark and the application therefore; and

WHEREAS, it is desired that the assignment of said application be made of record in the United States Patent and Trademark Office,

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, and intending to be legally bound hereby, said Performance Brands, Inc. hereby assigns to said Ecoly International, inc., the said "SEXY BATH & BODY" mark, together with the goodwill of the business symbolized by the said mark, and the application therefore, Serial No. 78/021,257

PERFORMAN	E BRAN	DS. INC.
	\mathcal{T}	

Stacy Kaufman

Title: President

Dated: 0-04-01

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513 ON THE DATE INDICATED BELOW

By: Carl and anches

Ą.

J'Allesandro 881165 Locke +

BOX TTAB - NO FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ECOLY INTERNATIONAL, INC.

OPPOSER,

OPPOSITION NO. 123,841

PERFORMANCE BRANDS, INC.

APPLICANT.

NOTICE OF WITHDRAWAL OF OPPOSITION

Ecoly International, Inc., by its undersigned counsel, expressly withdrawals its opposition to registration of the mark of the Application Serial No. 78/021,257 based on the assignment of said application to opposer by Performance Brands, Inc. A copy of the Assignment is submitted herewith.

Accordingly, it is submitted that the opposition proceeding is moot.

Respectfully submitted,

Roberta Jaobs-Meadway, Fsq.

Ballard Spihr Andrews & Ingersoll, Llp

1735 Market Street, 51st Floor Philadelphia, PA 19103

ATTORNEYS FOR OPPOSER

/cda

CERTIFICATE OF SERVICE

I, Carolyn Andress, hereby certify that a true and correct copy of the Notice of
Withdrawal of Opposition in the matter of Ecoly International, Inc. v. Performance Brands, Inc.,
trademark Opposition No. 123,841, has been served on counsel for Applicant on the date shown below.

Carlo andress

ASSIGNMENT OF TRADEMARK

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WHEREAS, Ecoly International, Inc., a California corporation having an address of 9232

Eton Avenue, Chatsworth, CA 91311, is desirous of acquiring the said mark together with the goodwill of the business symbolized by the mark and the application therefore; and

WHEREAS, it is desired that the assignment of said application be made of record in the United States Patent and Trademark Office,

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, and intending to be legally bound hereby, said Performance Brands, Inc. hereby assigns to said Ecoly International, inc., the said "SEXY BATH & BODY" mark, together with the goodwill of the business symbolized by the said mark, and the application therefore, Serial No. 78/021,257

PERFORMANCE BRANDS, INC.

By:

Stacy Kaufman

Title: President

Dated: 10-04-01

SH 1676

1532483 vi

8871165

UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office Trademark Trial and Appeal Board 2900 Crystal Drive Arlington, Virginia 22202-3513

Opposition No. 123,841 Ecoly International, Inc.

MAR 1 9 2002

FAI. & T.M. OFFICE

v.

Performance Brands, Inc.

On October 21, 2001, opposer filed a withdrawal of the opposition, and a photocopy of the assignment of application Serial No. 78/021,257, to opposer.

In view of the assignment to opposer of the application involved herein, the opposition is dismissed as moot.

By the Trademark Trial and Appeal Board

Because the assignment has been recorded in the Assignment Branch of this Office; and the recorded assignment information has been entered in the record of the application file, the application will proceed in the assignee's name. See Patent and Trademark Rules 3.71, 3.73, and 3.85.



LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500

FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

ROBERTA JACOBS-MEADWAY
DIRECT DIAL; 215-864-8201
PERSONAL FAX; 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

BALTIMORE, MD
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

June 21, 2002

VIA OVERNIGHT MAIL

Sexy Hair Plus.com 17655 E. Jackson South Bend, IN 46614

Attn: President

Re:

Sexy Hair Concepts, LLC and Sexy Hair Plus.com

Our File: 895452

Dear Sir/Madam:

This office represents Sexy Hair Concepts, LLC in connection with certain trademark and unfair competition matters.

Sexy Hair Concepts, LLC (SHC) and its predecessor in interest (collectively, SHC) have since at least as early as June 15, 1998 employed SEXY HAIR as a name and mark in connection with hair care products.

We know that you are aware of the SEXY HAIR name and mark since SHC products are promoted under such name and mark at the sexyhairplus.com site.

SHC has taken steps to protect the SEXY HAIR mark, and is the owner of U.S. Trademark Registrations No.s 2,403,396 and 2,486,702, *inter alia*. The pertinent information concerning these registrations is attached.

Use by Sexy Hair Plus.com of Sexy Hair plus as shown on the website is accordingly of concern to SHC. The use of the SEXY HAIR mark and name as the dominant component of a mark and name in connection with the sale of the products of SHC and others falsely suggests that there is some affiliation or sponsorship between SHC and your company (and others) which does not exist. The use of "plus" further suggests some affiliation or sponsorship in derogation of SHC's rights in its mark and name.

We are, accordingly, demanding on behalf of SHC that your company:

- 1. promptly take steps to discontinue use of SEXY HAIR as a mark or name or component of a mark or name or domain name;
- 2. cease all such use of SEXY HAIR by not later than August 1, 2002; and
- 3. confirm in writing to this office by the close of business on July 2 that Sexy hair Plus.com will comply with the above-stated demands.

Any offer of compromise is without prejudice to any claim or demand that may be made if further action is required to protect the interests of Sexy Hair Concepts, LLC in its trade name and mark.

Very truly yours,

Roberta Jacobs-Meadway

RJM/cda

cc: Sexy Hair Concepts, LLC

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 06/21/2002 15:43:34 ET

Serial Number: 75634213

Registration Number: 2403396

Mark (words only): SEXY HAIR

Current Status: Registered.

Date of Status: 2000-11-14

Filing Date: 1999-02-05

Registration Date: 2000-11-14

Law Office Assigned: TMEG Law Office 104

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Mair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse

International Class: 003 First Use Date: 19980615

First Use in Commerce Date: 19981221

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

PROSECUTION HISTORY

2000-11-14 - Registered - Principal Register

2000-08-22 - Published for opposition

2000-07-21 - Notice of publication

2000-06-03 - Approved for Pub - Principal Register (Initial exam)

1999-12-14 - Letter of suspension mailed

1999-10-18 - Communication received from applicant

1999-08-17 - Non-final action mailed

1999-08-04 - Case file assigned to examining attorney

1999-07-30 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY
AKIN GUMP STRAUSS HAUER & FELD LLP
ONE COMMERCE SQ STE 2200
2005 MARKET ST
PHILADELPHIA PA 19103
United States

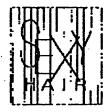
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 06/21/2002 15:44:04 ET

Serial Number: 75751842

Registration Number: 2486702

Mark



(words only): SEXY HAIR

Current Status: Registered.

Date of Status: 2001-09-11

Filing Date: 1999-07-15

Registration Date: 2001-09-11

Law Office Assigned: TMEG Law Office 102

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

hair care products for men, women and children, namely shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse

International Class: 003 First Use Date: 19980615

First Use in Commerce Date: 19981221

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

Lining and Stippling: THE MARK IS LINED FOR THE COLOR RED.

PROSECUTION HISTORY

2001-09-11 - Registered - Principal Register

2001-06-19 - Published for opposition

2001-06-06 - Notice of publication

2001-01-23 - Approved for Pub - Principal Register (Initial exam)

2000-07-05 - Communication received from applicant

2000-07-05 - Communication received from applicant

2000-06-07 - Communication received from applicant

2000-01-20 - Non-final action mailed

1999-12-15 - Case file assigned to examining attorney

1999-12-07 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY AKIN, GUMP, STRAUSS, HAUER & FELD, LLP ONE COMMERCE SQUARE 2005 MARKET STREET, 22ND FLOOR PHILADELPHIA, PA 19 103-7086 United States

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500 FAX: 215-864-8999

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VOORHEES, NJ
WASHINGTON, DC

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

July 30, 2002

By Fax 574-291-0398

Mary Bagley, President Sexy Hair Plus.com 17655 E. Jackson South Bend, IN 46614

Re:

Sexy Hair Concepts, LLC and Sexy Hair Plus.com

Our File No. 895452

Dear Ms. Bagley:

This has reference to our recent communications concerning the above-matter.

Based on your representation that you will cease using Sexy Hair Plus by August 1, 2002, we will take no other action in connection with the matter.

Thank you for your cooperation in resolving this matter amicably.

Very truly yours,

RJ/sew

cc:

Mr. Mark Stiller

Sexy Hair Plus 17655 E. Jackson Rd South Bend Indiana 46614 574 291 1138 574 291 0398 fax file # 895452

Dear sir,

We will agree to comply with your request to stop using the name Sexy Hair plus on our web site by Aug 1 2002. I am very sorry to have mistakenly used a trademark name.

Sincerely
Mary Bagley

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500

VOORHEES, NJ WASHINGTON, DC

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ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

May 22, 2003

Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513

Dear Madam:

We are enclosing herewith the following documents set forth below, which are to be filed in the Patent and Trademark Office.

Please charge all government filing fees with respect to the enclosed documents to our Miscellaneous Deposit Account 02-0755.

Please charge any additional fees or credit overpayment to Miscellaneous Deposit Account 02-0755.

Respectfully submitted,

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

ROBERTAJACOBS-MEADWAY

cc:

Dawn Deissler

Caren Burgoon

Enclosures: Notice of Opposition

Application of: Sexy Hair Concepts, LLC

Fee: \$300.00

International Class: 3 Mark: UNISEXY

Attorney Docket No.: 892469

BOX TTAB - FEE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on the date indicated below.

Bate 5/22/03

BOX TTAB FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Sexy Hair Concepts LLC,	:
Opposer,	: :
v.	: Opposition No.
Knowledge & Merchandising, Inc. Limited.	: :
Applicant.	: :

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513

Dear Madam:

In the matter of Trademark Application Serial No. 78/091,197 for the mark "UNISEXY," filed November 1, 2001 and published for opposition in the Official Gazette on May 20, 2003 at page TM 252:

Sexy Hair Concepts LLC, a California corporation having a place of business at 9232 Eton Avenue, Chatsworth, California 91311 ("Opposer"), believes that it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes the same. The grounds for opposition are as follows:

1. Knowledge & Merchandising, Inc. Limited, a United Kingdom corporation ("Applicant"), seeks to register "UNISEXY" as a trademark for use in connection

PHL_A #1754985 v1 Matter No. 892469 with the following goods, as evidenced by the publication of said mark in the Official Gazette on May 20, 2003 at page TM 252. Applicant seeks to register the mark in association with the following goods in International Class 3:

IC 003: toiletries, namely antiperspirants, deodorants, talcum powder; skin-care preparations; cleansers, namely skin cleansers, facial cleansers, facial scrubs, body scrubs; moisturizers, namely, skin moisturizers, facial moisturizers, body moisturizers; aftershave; shaving stones; after-shaving preparations; shaving preparations; shaving oil; shaving gel; shaving foam; shaving soaps; soaps; perfumery, namely, fragrances, cologne, toilet water, perfume; hair-care preparations and products, namely, shampoo, conditioners, styling gel, mousse, hair spray and hair oil; dentifrices.

- 2. The application herein opposed was filed November 1, 2001 on the basis of "intent to use." Applicant claims no date earlier than November 1, 2001 for the purpose of claiming priority.
- 3. Opposer is and has been engaged in the development, manufacture and sale of beauty products and hair care products for men, women, and children and has built a successful business in connection therewith.
- 4. Since at least as early as June 15, 1998, Opposer has used the mark "SEXY HAIR" for hair care products for men, women and children, including shampoo and conditioner. Since at least as early as December 21, 1998, Opposer has used such mark in commerce for such goods.
- 5. Use of the "SEXY HAIR" mark by Opposer has been continuous and commercially significant. Promotional material showing Opposer's use of "SEXY HAIR" is attached as Exhibit A.
- 6. Opposer has taken steps to protect the "SEXY HAIR" mark and has secured U.S. Trademark Registration No. 2,403,396 for such mark for hair care products for men, women, and children as identified therein. Registration No. 2,403,396 is valid and subsisting. A copy of the pertinent information about such registration from the PTO database is attached as Exhibit B.

- 7. Since 1998, Opposer has taken steps to develop a family of "SEXY" marks for hair care products, including: "SEXY HAIR CONCEPTS"; "HOT SEXY HIGHLIGHTS"; "HEALTHY SEXY HAIR;" "WILD SEXY HAIR," "FORMULAS BY ECOLY BIG SEXY HAIR"; and SEXY HAIR (Design). Promotional materials showing the "SEXY" marks of Opposer are attached as Exhibit C.
- 8. Opposer has also secured U.S. Reg. No. 2,486,702 for the mark "SEXY HAIR (Design)" for hair care products for men, women, and children; U.S. Reg. No. 2,553,996 for the mark "HOT SEXY HIGHLIGHTS" for hair care products for men, women, and children; and U.S. Reg. No. 2,707,751 for the mark "WILD SEXY HAIR" for hair care products for men, women, and children. The '702, '996, and '751 registrations are valid and subsisting. Copies of the pertinent information about such registrations from the PTO database are attached as Exhibit D.
- 9. Opposer has since prior to November 1, 2001 used "Sexy Hair Concepts" and "Sexy Hair" as trade names as well as a mark in connection with its business, which includes the sale of cosmetics and skin care products. Promotional materials showing Opposer's use of "Sexy Hair Concepts" are attached as Exhibit E.
- 10. Opposer's registered trademark "SEXY HAIR," Opposer's family of "SEXY" marks, and the "Sexy Hair" and "Sexy Hair Concepts" names are inherently distinctive as applied to Opposer's products and business.
- 11. By virtue of Opposer's continuous use in commerce of its registered "SEXY HAIR" trademark and its family of "SEXY" marks and the "Sexy Hair" and "Sexy Hair Concepts" names in connection with such goods and business, such goods and business have become favorably known to the relevant trade and public under such marks and names.

- 12. Because Opposer is the owner of U.S. trademark registrations for "SEXY HAIR," "SEXY HAIR (Design)," "HOT SEXY HIGHLIGHTS," and WILD SEXY HAIR, priority is not in issue.
- 13. In the application herein opposed, there are no restrictions on trade channels, so it must be assumed that the goods identified in the application will travel through all trade channels appropriate for goods of that type.
- 14. Applicant's mark is confusingly similar to Opposer's registered "SEXY HAIR" trademarks and also to the family of "SEXY" marks established by Opposer, and to Opposer's "Sexy Hair" and "Sexy Hair Concepts" trade names.
- 15. Each of Opposer's marks and its names, and Applicant's mark, has as its dominant element the identical term—"SEXY."
- 16. The goods of Opposer and the goods of Applicant are in part identical: hair care products; and, in part, are substantially similar: various skin care and cosmetic products.
- 17. Hair care products and skin care and cosmetic products such as are sold by Opposer and as are identified in the application herein opposed are customarily marketed through the same and overlapping channels of trade.
- 18. The products marketed and sold under Opposer's registered "SEXY HAIR," "HOT SEXY HIGHLIGHTS," and WILD SEXY HAIR trademarks, Opposer's family of "SEXY" marks, and through Opposer's "Sexy Hair" and "Sexy Hair Concepts" business, and the products intended to be sold under Applicant's "UNISEXY" mark, are such as would be sold to the same and to overlapping classes of purchasers, namely men, women and children, generally.

- Applicant's "UNISEXY" trademark as applied to the goods identified in the application herein opposed so resembles Opposer's registered "SEXY HAIR" trademarks, Copposer's family of "SEXY" marks as applied to Opposer's products, and Opposer's "Sexy likely" and "Sexy Hair Concepts" names as used in connection with Opposer's business, that it is likely to cause confusion, mistake, and/or deception.
- 20. If Applicant is permitted to register "UNISEXY" for the goods set forth in the application, confusion of the relevant trade and public is likely to result, which will damage and injure Opposer.
- 21. On seeing Applicant's "UNISEXY" mark used in connection with Applicant's products, purchasers and potential purchasers are likely to believe in error that such goods are offered by or in association with or under license from Opposer, that Opposer and Applicant are affiliated or that Opposer's goods and Applicant's goods are sold as components of the products.
- 22. Any defect, objection to, or fault found with Applicant's goods sold under mark "UNISEXY" would necessarily reflect on and seriously injure the reputation that
- 23. If Applicant is granted a registration for the mark herein opposed, it would whereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Sexy Hair Concepts LLC prays that registration of the mark of

Application Serial No. 78/091,197 be refused and that this opposition be sustained.

A duplicate copy of this Notice of Opposition is enclosed herewith.

The required fee of \$300 may be charged to Deposit Account No. 02-0755 and any overpayment may be credited to this account.

Respectfully submitted,

By:

Roberta Jacobs-Meadway

Lynn Rzonca

Patricia G. Cramer

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 Market Street, 51st Floor

Philadelphia, Pennsylvania 19103-7599

(215) 665-8500

Dated: 5/22/03

ATTORNEYS FOR OPPOSER

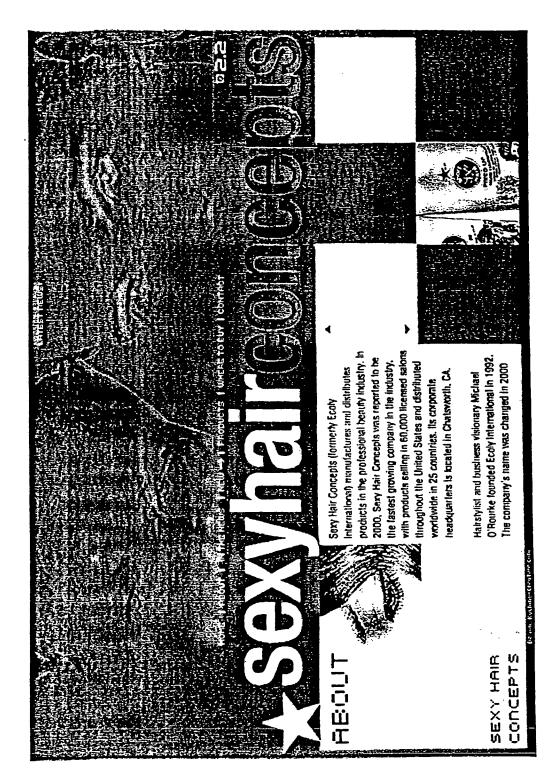
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FOR THE FOLLOWING:	RESPONSE TO ACTION
	TRANSMITTAL LETTER
TRADEMARK APPLICATION: USE ITU	ASSIGN/CHG_NAME/MERGER/SEC INT
SPECIMENS DRAWING PAGE	NOTICE OF APPEAL/APPEAL BRIEF
RENEWAL APPLICATION	I NOTICE OF OPPOSITION
AFF/DEC 8 / 15 / 8&15	PETITION TO CANCEL
AMEND TO ALLEGE USE	REQ.EXT. TIME TO OPPOSE
STATEMENT OF USE	PET/MOT FOR EXT. OF TIME
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COUNTRY REG. NO.	
AMEND/REQ. RECONSIDERATION	
OTHER (PAPER TITLE)	

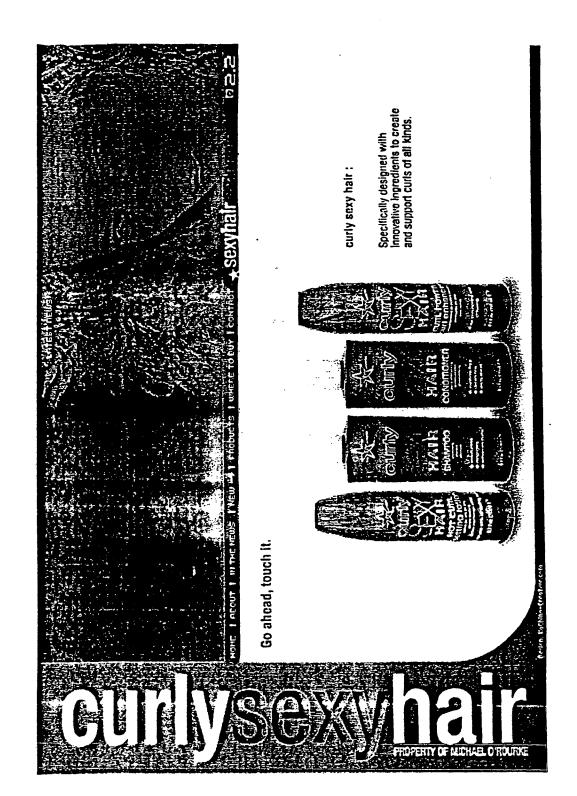




Ballard Spahr Andrews & Ingersoll, LLP 1735 Market Street - 51° Floor Philadelphia, PA 19103

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Sat Jul 13 04:31:15 EDT 2002

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Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark

SEXY HAIR

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair

sprays, hair color, hair dyes, hair rinses, hair mousse. FIRST USE: 19980615. FIRST

USE IN COMMERCE: 19981221

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number

75634213

Filing Date

February 5, 1999

Published for

Opposition

August 22, 2000

Registration

Number

2403396

Registration

November 14, 2000

Date

Owner

(REGISTRANT) Ecoly International, Inc. CORPORATION CALIFORNIA 9232 Eton Avenue Chatsworth CALIFORNIA 91311

Attorney of

Roberta Jacobs-Meadway

Record Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAIR" APART FROM THE

MARK AS SHOWN

Type of Mark

TRADEMARK

Register

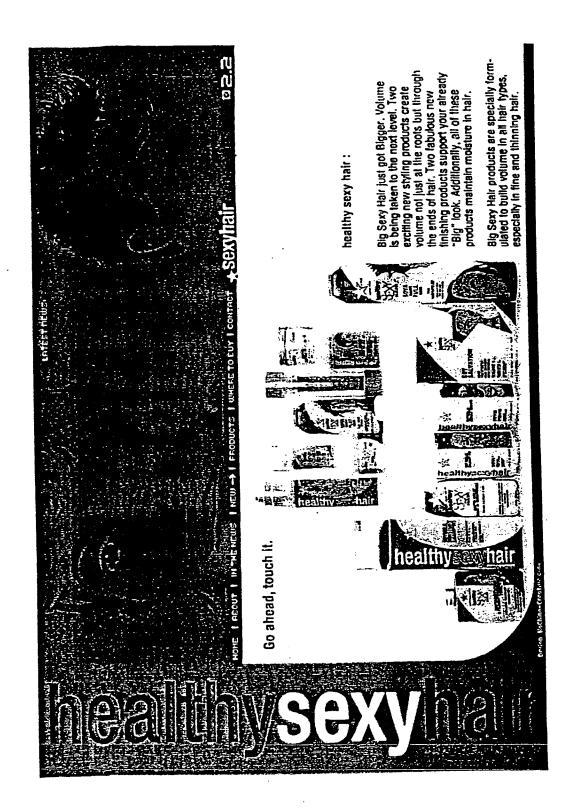
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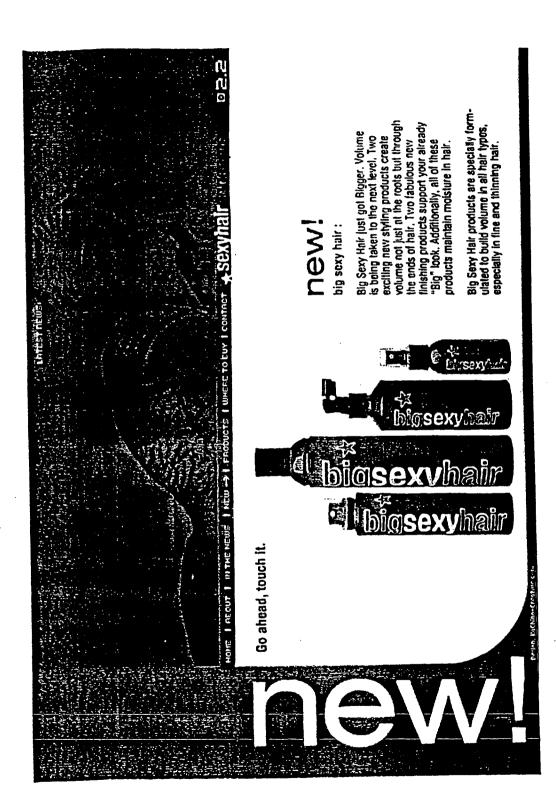
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Sat Jul 13 04:31:15 EDT 2002

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Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark

SEXY HAIR

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: hair care products for men, women and children, namely shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse. FIRST USE: 19980615. FIRST USE IN

COMMERCE: 19981221

Mark Drawing

Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search

Code

261112

Serial Number

75751842

Filing Date

July 15, 1999

Published for

June 19, 2001

Opposition

Registration Number

2486702

Registration

September 11, 2001

Date Owner

(REGISTRANT) Ecoly International, Inc. CORPORATION CALIFORNIA 9232 Eton

Avenue Chatsworth CALIFORNIA 91311

Attorney of Record

Roberta Jacobs-Meadway

Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAIR" APART FROM THE

MARK AS SHOWN

Description of

Mark

THE MARK IS LINED FOR THE COLOR RED.

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead Indicator

LIVE

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Sat Jul 13 04:31:15 EDT 2002

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Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark

HOT SEXY HIGHLIGHTS

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: hair care products for men, women and children, namely, shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse. FIRST USE: 20000700. FIRST USE IN

COMMERCE: 20000700

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number

76075306

Filing Date

June 22, 2000

Filed ITU

FILED AS ITU

Published for

Opposition

March 27, 2001

Registration

Number

2553996

Registration

Date

March 26, 2002

Owner[®]

(REGISTRANT) Ecoly International, Inc. CORPORATION CALIFORNIA 9232 Eton

Avenue Chatsworth CALIFORNIA 91311

Attorney of Record

ROBERTA JACOBS-MEADWAY

Disclaimer

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HIGHLIGHTS" APART

FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

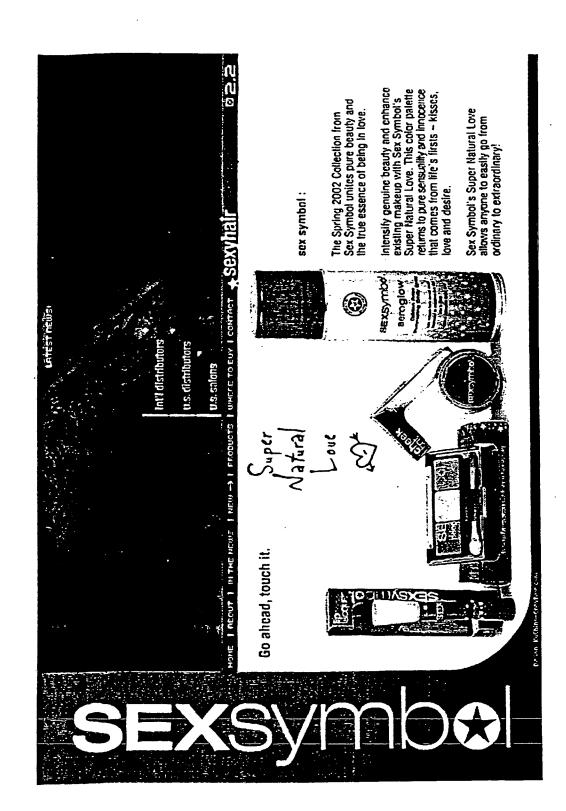
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SEXY HAIR CONCEPTS LLC,	§	Opposition No. 91156907
Opposer,	& & &	In the Matter of:
vs.	\$ \$ \$	Application Serial No.: 78/091,197 Mark: UNISEXY
Knowledge & Merchandising, Inc. Limited	§ §	Filed on November 1, 2001
Applicant.	§ .	Published in the Official Gazette on May 20, 2003

CERTIFICATE OF MAILING

I hereby certify that the enclosed Express Abandonment of Application and Certificate of Service is being deposited with the United States Postal Service with sufficient postage as Express Mail, Label No. EL 762459997 US in an envelope addressed to: Director of the U.S. Patent and Trademark Office, ATTN: TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date indicated below.

Name of Person Signing Certificate: Denise Hill

Signature:

Date of Signing: 8-5

Munsch Hardt Kopf & Harr, P.C. 4000 Fountain Place 1445 Ross Avenue

Dallas, Texas 75202-2790 Telephone: (214) 855-7500 Facsimile: (214) 855-7584

Docket No.: 5966.6-2

DALLAS 874865_1 5966.6



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SEXY HAIR CONCEPTS LLC.	\$ 0
Opposer,	§ Opposition No. 91156907
	§ In the Matter of:
vs.	§ Application Serial No.: 78/091,197
	§ Mark: UNISEXY
Knowledge & Merchandising, Inc. Limited	§ Filed on November 1, 2001
Applicant.	Published in the Official Gazette
	s on May 20, 2003

Assistant Commissioner for Trademarks Box TTAB 2900 Crystal Drive Arlington, Virginia 22202-3513

Sir:

EXPRESS ABANDONMENT OF APPLICATION

Knowledge & Merchandising, Inc. Limited, Applicant, hereby expressly abandons U.S. Trademark Application No. 78/091,197. The consent of the opposing party has not been sought.

Accordingly, Applicant respectfully requests that the above-identified opposition be dismissed.

Respectfully submitted,

Knowledge & Merchandising, Inc. Limited, Applicant

Marc A. Hubbard

ATTORNEY FOR APPLICANT

Date: Fragust 103 3 Munsch Hardt Köpf & Harr, P.C. 1445 Ross Avenue, Suite 4000 Dallas, Texas 75202

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing EXPRESS ABANDONMENT OF APPLICATION was served on attorneys for Opposer, Sexy Hair Concepts LLC, on the date indicated below, by placing a copy thereof in the United States Postal Service first class mail, proper postage prepaid, addressed as follows:

Roberta Jacobs-Meadway Attorneys for Opposer Ballard Spahr Andrews & Ingersoll, LLP 1735 Market Street, 51st Floor Philadelphia, PA 19103-7599

Date: 5 Heavst 200 2

Marc A. Hubbard Attorney for Applicant

DALLAS 874859_1 5966.6

Confirmation Report - Memory Send

: 001

Date & Time: Aug-22-03 09:39am

Line 1 : + Machine ID:

Job number

: 630

Date

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: Aug-22 09:37am

End time

: Aug-22 09:39am

Pages sent

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PHILADELPHIA, PENNSYLVANIA 10 103-7500
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FAU 2 19-081-0000
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PLEASE DELIVER AS SOON AS POSSIBLE TO:

RECIPIENT Mark Stiller COMPANY

FAX NO. 818-718-9353 PHONE NO. 818-718-6982

From:

August 22, 2003

Phone:

Patricia G. Cramer (215) 864-8607

892469

(215) 864-9744

Matter:

E-mail: cramerp@ballardspahr.com

Total number of pages including this page: If you do not receive all the pages, please call 215-864-8757

Ro: Sexy Hair Concepts, LLC v. Knowledge Merchandising, Inc. Limited/Our File No. 892469

Mark

Please see the attached correspondence regarding the express abandonment by Knowledge Merchandising, Inc. Limited of the application for UNISEXY, Serial No. 78/091,197, and request for dismissal of the opposition proceeding.

If you have any questions, please do not hesitate to contact us.

cc: Roberta Jacobs-Meadway, Esquire (w/o att.)

Please Note: The information contained in this facsimile message is privileged and confidential and is intended only for the use of the individual or entity named above and others who have been specifically authorized to receive it. If you are not the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received the communication in error, or if any problems occur with transmission, please notify us immediately by telephone. There were telephone. Thank you.

UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office Trademark Trial and Appeal Board 2900 Crystal Drive Arlington, Virginia 22202-3513

Baez



Mailed: September 10, 2003

Opposition No. 91156907

Sexy Hair Concepts LLC

ν.

Knowledge & Merchandising,
Inc. Limited

On August 5, 2003, applicant filed an abandonment of its application Serial No. 78091197.

Trademark Rule 2.135 provides that if, in an inter partes proceeding, the applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against applicant.

In view thereof, and because opposer's written consent to the abandonment is not of record, judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.

By the Trademark Trial and Appeal Board

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on the date indicated below.

By: Act Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on the date indicated below.

BOX TTAB FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Sexy Hair Concepts LLC,	:
Opposer,	: :
v.	Opposition No.
Nature's Formula, Inc.	:
Applicant.	; ;

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513

Dear Madam:

In the matter of Trademark Application Serial No. 78/152,763 for the mark "ZERO 2 SEXY," filed August 9, 2002 and published for opposition in the Official Gazette on April 29, 2003 at page TM 127:

Sexy Hair Concepts LLC, a California corporation having a place of business at 9232 Eton Avenue, Chatsworth, California 91311 ("Opposer"), believes that it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes the same. The grounds for opposition are as follows:

1. Nature's Formula, Inc., a Texas corporation ("Applicant"), seeks to register "ZERO 2 SEXY" as a trademark for use in connection with hair care preparations, as

PHL_A #1781181 v1 Matter No. 085664 evidenced by the publication of said mark in the Official Gazette on April 29, 2003 at page TM 127.

- 2. The application herein opposed was filed August 8, 2002 on the basis of "intent to use." Applicant claims no date earlier than August 8, 2002 for the purpose of claiming priority.
- Opposer is and has been engaged in the development, manufacture and sale of hair care preparations and has built a successful business in connection therewith.
- 4. Since at least as early as June 15, 1998, Opposer, through itself and its predecessor in interest, has used "SEXY" and "SEXY HAIR" as the dominant element of its name and marks for hair care preparations, including shampoo, conditioner, gels, sprays, color, dyes, rinses and mousses. Since at least as early as December 21, 1998, Opposer has used such mark in commerce in the United States for such goods.
- 5. Information about Opposer's business and products can be found at its website, www.sexyhairconcepts.com.
- 6. Opposer has taken steps to protect the "SEXY HAIR" mark and has secured U.S. Trademark Registration No. 2,403,396 for such mark for hair care preparations as identified therein. Registration No. 2,403,396 is valid and subsisting. A copy of the pertinent information about such registration from the PTO database is attached as Exhibit A.
- 7. Since 1998, Opposer has taken steps to develop a family of "SEXY" marks for hair care preparations, including: "SEXY HAIR CONCEPTS," "HOT SEXY HIGHLIGHTS," "HEALTHY SEXY HAIR," "WILD SEXY HAIR," "FORMULAS BY ECOLY BIG SEXY HAIR," "BIG SEXY HAIR," CURLY SEXY HAIR, ""SHORT SEXY HAIR," and SEXY HAIR (Design), among others. Promotional materials showing the "SEXY" marks of Opposer are attached as Exhibit B.

- 8. Opposer has also secured U.S. Reg. No. 2,486,702 for the mark "SEXY HAIR (Design)" for hair care preparations; U.S. Reg. No. 2,553,996 for the mark "HOT SEXY HIGHLIGHTS" for hair care preparations; and U.S. Reg. No. 2,707,751 for the mark "WILD SEXY HAIR" for hair care preparations. The '702, '996, and '751 registrations are valid and subsisting. Copies of the pertinent information about such registrations from the PTO database are attached as Exhibit C-E.
- 9. Use of the "SEXY HAIR" mark by Opposer has been continuous and commercially significant.
- 10. Opposer has since prior to August 9, 2002 used "Sexy Hair Concepts" and "Sexy Hair" as trade names as well as a mark in connection with its business, which includes hair care products and preparations.
- 11. Opposer's registered trademark "SEXY HAIR," Opposer's family of "SEXY" marks, and the "Sexy Hair" and "Sexy Hair Concepts" names are inherently distinctive as applied to Opposer's products and business.
- 12. By virtue of Opposer's continuous use in commerce of its registered "SEXY HAIR" trademark and its family of "SEXY" marks and the "Sexy Hair" and "Sexy Hair Concepts" names in connection with such goods and business, such goods and business have become favorably known to the relevant trade and public under such marks and names.
- 13. Because Opposer is the owner of U.S. trademark registrations for "SEXY HAIR," "SEXY HAIR (Design)," "HOT SEXY HIGHLIGHTS," and WILD SEXY HAIR, priority is not in issue.
- 14. In the application herein opposed, there are no restrictions on trade channels, so it must be assumed that the goods identified in the application will travel through all trade channels appropriate for goods of that type.

- 15. Applicant's mark is confusingly similar to Opposer's registered "SEXY HAIR" trademarks and also to the family of "SEXY" marks established by Opposer, and to Opposer's "Sexy Hair" and "Sexy Hair Concepts" trade names.
- 16. Each of Opposer's marks and its names, and Applicant's mark, employ the identical term—"SEXY," as a prominent element.
- 17. The goods of Opposer and the goods of Applicant are identical: hair care preparations.
- 18. Hair care preparations such as are sold by Opposer and as are identified in the application herein opposed are customarily marketed through the same and overlapping channels of trade.
- 19. The products marketed and sold under Opposer's registered "SEXY HAIR," "HOT SEXY HIGHLIGHTS," and WILD SEXY HAIR trademarks, Opposer's family of "SEXY" marks, and through Opposer's "Sexy Hair" and "Sexy Hair Concepts" business, and the products intended to be sold under Applicant's "ZERO 2 SEXY" mark, are such as would be sold to the same and to overlapping classes of purchasers, namely men, women and children, generally.
- 20. Applicant's "ZERO 2 SEXY" trademark as applied to the goods identified in the application herein opposed so resembles Opposer's registered "SEXY HAIR" trademarks, Opposer's family of "SEXY" marks as applied to Opposer's products, and Opposer's "Sexy Hair" and "Sexy Hair Concepts" names as used in connection with Opposer's business, that it is likely to cause confusion, mistake, and/or deception.
- 21. If Applicant is permitted to register "ZERO 2 SEXY" for the goods set forth in the application, confusion of the relevant trade and public is likely to result, which will damage and injure Opposer.

- 22. On seeing Applicant's "ZERO 2 SEXY" mark used in connection with Applicant's products, purchasers and potential purchasers are likely to believe in error that such goods are offered by or in association with or under license from Opposer or that Opposer and Applicant are affiliated.
- 23. Any defect, objection to, or fault found with Applicant's goods sold under its mark "ZERO 2 SEXY" would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods and business.
- 24. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Sexy Hair Concepts LLC prays that registration of the mark of Application Serial No. 78/152,763 be refused and that this opposition be sustained.

A duplicate copy of this Notice of Opposition is enclosed herewith.

The required fee of \$300 may be charged to Deposit Account No. 02-0755 and any overpayment may be credited to this account.

Dated: $\frac{\sqrt{1}}{0.3}$

Respectfully submitted,

Roberta Jacobs-Meadway
Patricia G. Cramer

Jody B. Greenberg

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 Market Street, 51st Floor

Philadelphia, Pennsylvania 19103-7599

(215) 665-8500

ATTORNEYS FOR OPPOSER

Latest Status Info Page 1 of 2

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-31 21:50:16 ET

Serial Number: 75634213

Registration Number: 2403396

Mark (words only): SEXY HAIR

Current Status: Registered.

Date of Status: 2000-11-14

Filing Date: 1999-02-05

Registration Date: 2000-11-14

Law Office Assigned: TMEG Law Office 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 - Warehouse (Newington)

Date In Location: 2002-10-18

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311 United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse

International Class: 003 First Use Date: 1998-06-15

First Use in Commerce Date: 1998-12-21

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

PROSECUTION HISTORY

2000-11-14 - Registered - Principal Register

2000-08-22 - Published for opposition

2000-07-21 - Notice of publication

2000-06-03 - Approved for Pub - Principal Register (Initial exam)

1999-12-14 - Letter of suspension mailed

1999-10-18 - Communication received from applicant

1999-08-17 - Non-final action mailed

1999-08-04 - Case file assigned to examining attorney

1999-07-30 - Case file assigned to examining attorney

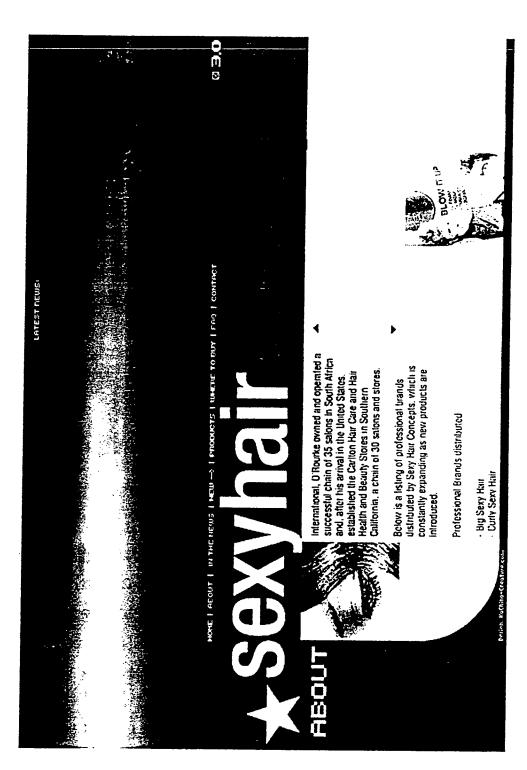
CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY
AKIN GUMP STRAUSS HAUER & FELD LLP
ONE COMMERCE SQ STE 2200
2005 MARKET ST
PHILADELPHIA PA 19103
United States

Sexy Han Concepts [Property of Michael O'Rourke]



Sexy Hair Concepts [Property of Michael O'Rourke]

7/31/2003

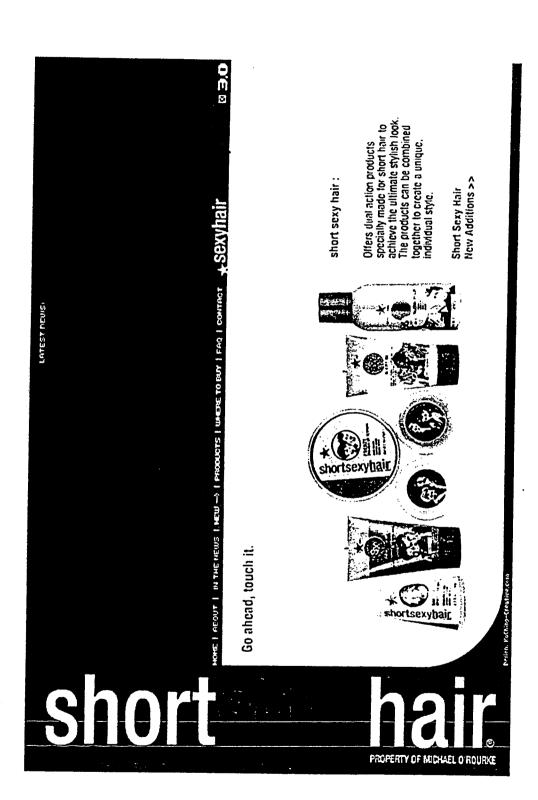
Deay than Concepts [Property of Michael O'Rourke]

Sexy Hair Concepts [Property of Michael O'Rourke]

7/31/2003

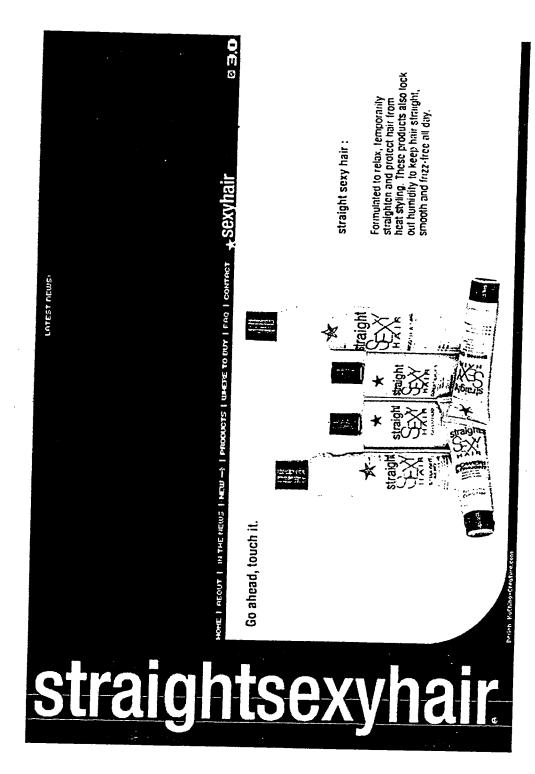
Sexy Hair Concepts [Property of Michael O'Rourke]

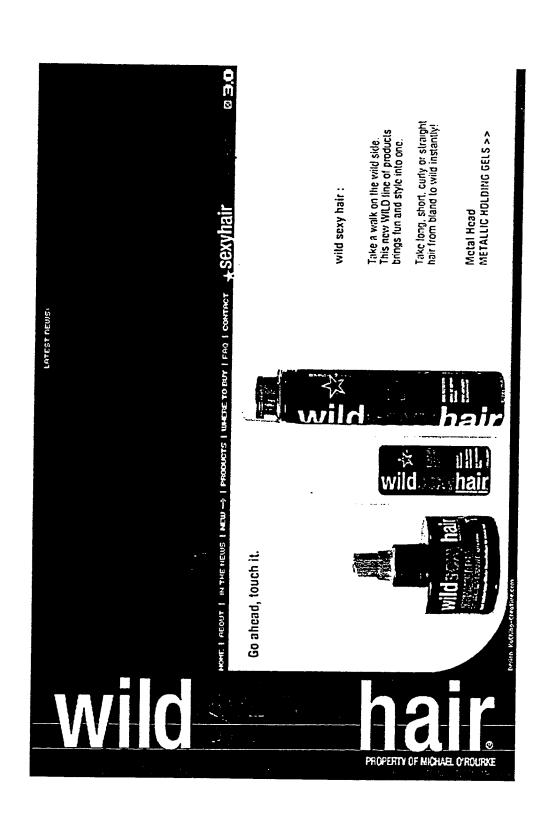
7/31/2003

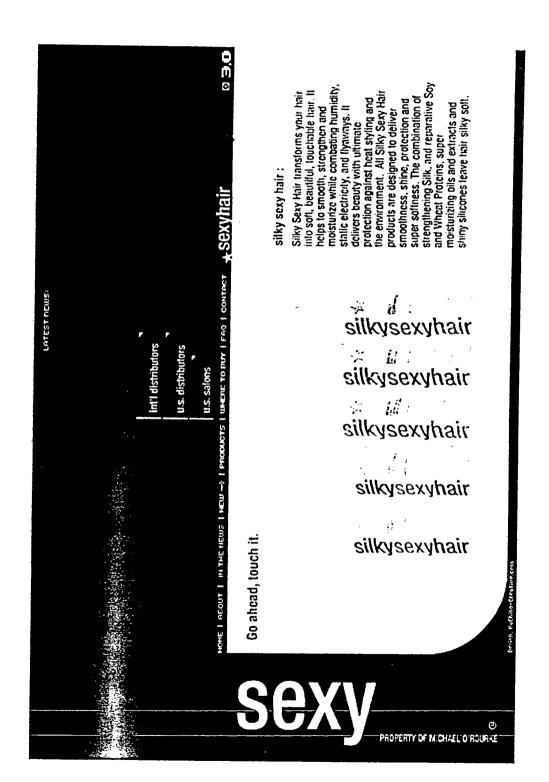


Sexy Hair Concepts | Property of Michael O'Rourke J

7/31/2003







Latest Status Info Page 1 of 3

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-31 21:51:00 ET

Serial Number: 75751842

Registration Number: 2486702

Mark



(words only): SEXY HAIR

Current Status: Registered.

Date of Status: 2001-09-11

Filing Date: 1999-07-15

Registration Date: 2001-09-11

Law Office Assigned: TMEG Law Office 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the

Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-10-18

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

hair care products for men, women and children, namely shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse

International Class: 003 First Use Date: 1998-06-15

First Use in Commerce Date: 1998-12-21

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

Lining and Stippling: THE MARK IS LINED FOR THE COLOR RED.

PROSECUTION HISTORY

2001-09-11 - Registered - Principal Register

2001-06-19 - Published for opposition

2001-06-06 - Notice of publication

2001-01-23 - Approved for Pub - Principal Register (Initial exam)

2000-07-05 - Communication received from applicant

2000-07-05 - Communication received from applicant

2000-06-07 - Communication received from applicant

2000-01-20 - Non-final action mailed

1999-12-15 - Case file assigned to examining attorney

1999-12-07 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY AKIN, GUMP, STRAUSS, HAUER & FELD, LLP ONE COMMERCE SQUARE 2005 MARKET STREET, 22ND FLOOR PHILADELPHIA, PA 19 103-7086 United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-31 21:51:20 ET

Serial Number: 76075306

Registration Number: 2553996

Mark (words only): HOT SEXY HIGHLIGHTS

Current Status: Registered.

Date of Status: 2002-03-26

Filing Date: 2000-06-22

Registration Date: 2002-03-26

Law Office Assigned: TMO Law Office 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-10-18

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311 United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

hair care products for men, women and children, namely, shampoos, conditioners, hair lotions, hair creams, hair gels, hair sprays, hair color, hair tint and hair mousse

International Class: 003 First Use Date: 2000-07-00

First Use in Commerce Date: 2000-07-00

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HIGHLIGHTS"

PROSECUTION HISTORY

2002-03-26 - Registered - Principal Register

2001-08-31 - Allowed for Registration - Principal Register (SOU accepted)

2001-08-08 - Statement of use processing complete

2001-07-26 - Amendment to Use filed

2001-06-19 - Notice of allowance - mailed

2001-03-27 - Published for opposition

2001-03-14 - Notice of publication

2001-01-05 - Approved for Pub - Principal Register (Initial exam)

2000-12-20 - Examiner's amendment mailed

2000-12-04 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

ROBERTA JACOBS-MEADWAY (Attorney of record)

ROBERTA JACOBS-MEADWAY
BALLARD SPAHR ANDREWS & INGERSOLL LLP
1735 MARKET STREET
51ST FLOOR
PHILADELPHIA PA 19103-7599
United States

Latest Status Info Page 1 of 3

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-31 21:51:44 ET

Serial Number: 76260669

Registration Number: 2707751

Mark (words only): WILD SEXY HAIR

Current Status: Registered.

Date of Status: 2003-04-15

Filing Date: 2001-05-22

Registration Date: 2003-04-15

Law Office Assigned: TMEG Law Office 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the

Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 - Warehouse (Newington)

Date In Location: 2003-04-21

CURRENT APPLICANT(S)/OWNER(S)

1. SEXY HAIR CONCEPTS, LLC

Address:

SEXY HAIR CONCEPTS, LLC 9232 ETON AVENUE CHATSWORTH, CA 91311

United States

Legal Entity Type: Ltd Liab Co

GOODS AND/OR SERVICES

hair care products for men, women, and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse

International Class: 003 First Use Date: 2002-08-15

First Use in Commerce Date: 2002-08-15

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

Prior Registration Number(s):

2403396

PROSECUTION HISTORY

2003-04-15 - Registered - Principal Register

2003-01-27 - Allowed for Registration - Principal Register (SOU accepted)

2003-01-27 - Case file assigned to examining attorney

2003-01-22 - Statement of use processing complete

2003-01-22 - Extension 1 granted

2002-10-09 - Amendment to Use filed

2002-10-09 - Extension 1 filed

2002-10-11 - PAPER RECEIVED

2002-04-16 - Notice of allowance - mailed

2002-01-22 - Published for opposition

2002-01-02 - Notice of publication

2001-09-06 - Approved for Pub - Principal Register (Initial exam)

2001-08-27 - Examiner's amendment mailed

2001-08-22 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

RICHARD E PEIRCE (Attorney of record)

RICHARD E PEIRCE

BALLARD SPAHR ANDREWS & INGERSOLL LLP

1735 MARKET ST 51ST FL

PHILADLEPHIA PA 19103-7599

United States

Phone Number: 215-665-8500 Fax Number: 215-864-8999

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RENEWAL APPLICATION	ASSIGN/CHG NAME/MERGER/SEC INT	
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OTHER (PAPER TITLE)		
FEE AUTH CHARGE B.S.A.I. DEPOSIT. ACCT. #02-0755 S 300 —		



Ballard Spahr Andrews & Ingersoll, LLP 1735 Market Street - 51° Floor Philadelphia, PA 19103

This document is an early draft - it was not finished

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on the date indicated below.	
By: Date:	
	BOX TTAB FEE
IN THE UNITED STATES I BEFORE THE TRADEM	PATENT AND TRADEMARK OFFICE ARK TRIAL AND APPEAL BOARD
Sexy Hair Concepts LLC,	· · · · · · · · · · · · · · · · · · ·
Opposer,	
v.	: Opposition No
Toni & Guy (USA) Limited	: :

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513

Dear Madam:

In the matter of Trademark Application Serial No. 76/422,372 for the mark "SEXY ROCK'N CHICK," filed June 18, 2002 and published for opposition in the Official Gazette on April 22, 2003 at page TM 135:

Sexy Hair Concepts, LLC, a California corporation having a place of business at 9232 Eton Avenue, Chatsworth, California 91311 ("Opposer"), believes that it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes the same. The grounds for opposition are as follows:

- 1. Toni & Guy (USA) Limited, a company organized under the laws of the United Kingdom ("Applicant"), seeks to register "SEXY ROCK'N CHICK" as a trademark for use in connection with hair care preparation cosmetics and non-medicated skin care preparations, as evidenced by the publication of said mark in the Official Gazette on April 22, 2003 at page TM 135.
- 2. The application herein opposed was filed June 18, 2002 on the basis of "intent to use." Applicant claims no date earlier than June 18, 2002 for the purpose of claiming priority.
- Opposer is and has been engaged in the development, manufacture and sale of hair care preparations and skin care preparations and has built a successful business in connection therewith.
- 4. Since at least as early as June 15, 1998, Opposer, through itself and its predecessor in interest, has used "SEXY" and "SEXY HAIR" as the dominant element of its name and marks for hair care preparations, cosmetics and skin care preparations. Since at least as early as December 21, 1998, Opposer has used such mark in commerce in the United States for such goods.
- 5. Information about Opposer's business and products can be found at its website, <u>www.sexyhairconcepts.com</u>.
- 6. Opposer has taken steps to protect the "SEXY HAIR" mark and has secured U.S. Trademark Registration No. 2,403,396 for such mark for hair care preparations as identified therein. Registration No. 2,403,396 is valid and subsisting. A copy of the pertinent information about such registration from the PTO database is attached as Exhibit A.
- 7. Since 1998, Opposer has taken steps to develop a family of "SEXY" marks, including: "SEXY HAIR CONCEPTS," "HOT SEXY HIGHLIGHTS," "HEALTHY

SEXY HAIR," "WILD SEXY HAIR," "FORMULAS BY ECOLY BIG SEXY HAIR," "BIG SEXY HAIR," CURLY SEXY HAIR, "SHORT SEXY HAIR," and SEXY HAIR (Design), among others. Promotional materials showing the "SEXY" marks of Opposer are attached as Exhibit B.

- 8. Opposer has also secured U.S. Reg. No. 2,472, 793 for the mark FORMULA BY ECOLY BIG SEXY HAIR for hair care preparations; U.S. Reg. No. 2,486,702 for the mark "SEXY HAIR (Design)" for hair care preparations; U.S. Reg. No. 2,553,996 for the mark "HOT SEXY HIGHLIGHTS" for hair care preparations; U.S. Reg. No. 2,636,664 the mark for SEXSYMBOL for cosmetics and hair care products; and U.S. Reg. No. 2,707,751 for the mark "WILD SEXY HAIR" for hair care preparations; and. The '793, '702, '996, '664 and '751 registrations are valid and subsisting. Copies of the pertinent information about such registrations from the PTO database are attached as Exhibit C-E.
- 9. Use of the "SEXY HAIR" mark by Opposer has been continuous and commercially significant.
- 10. Opposer has since prior to August 9, 2002 used "Sexy Hair Concepts" and "Sexy Hair" as trade names as well as a mark in connection with its business, which includes hair care products, cosmetics and skin care preparations.
- 11. Opposer's registered trademark "SEXY HAIR," Opposer's family of "SEXY" marks, and the "Sexy Hair" and "Sexy Hair Concepts" names are inherently distinctive as applied to Opposer's products and business.
- 12. By virtue of Opposer's continuous use in commerce of its registered "SEXY HAIR" trademark and its family of "SEXY" marks and the "Sexy Hair" and "Sexy Hair Concepts" names in connection with such goods and business, such goods and business have become favorably known to the relevant trade and public under such marks and names.

- 13. Because Opposer is the owner of U.S. trademark registrations for "SEXY HAIR," "SEXY HAIR (Design)," "HOT SEXY HIGHLIGHTS," "WILD SEXY HAIR," and "SEXSYMBOL" priority is not in issue.
- 14. In the application herein opposed, there are no restrictions on trade channels, so it must be assumed that the goods identified in the application will travel through all trade channels appropriate for goods of that type.
- 15. Applicant's mark is confusingly similar to Opposer's registered "SEXY HAIR" trademarks and also to the family of "SEXY" marks established by Opposer, and to Opposer's "Sexy Hair" and "Sexy Hair Concepts" trade names.
- 16. Each of Opposer's marks and its names, and Applicant's mark, employ the identical term—"SEXY," as a prominent element.
- 17. The goods of Opposer and the goods of Applicant are practically identical: hair care preparations, cosmetics and skin care preparations.
- 18. Hair care preparations and cosmetics such as are sold by Opposer and as are identified in the application herein opposed are customarily marketed through the same and overlapping channels of trade.
- 19. The products marketed and sold under Opposer's registered "SEXY HAIR," "HOT SEXY HIGHLIGHTS," "WILD SEXY HAIR" and "SEXSYMBOL" trademarks, Opposer's family of "SEXY" marks, and through Opposer's "Sexy Hair" and "Sexy Hair Concepts" business, and the products intended to be sold under Applicant's "SEXY ROCK'N CHICK" mark, are such as would be sold to the same and to overlapping classes of purchasers, namely men, women and children, generally.
- 20. Applicant's "SEXY ROCK'N CHICK" trademark as applied to the goods identified in the application herein opposed so resembles Opposer's registered "SEXY HAIR"

trademarks, Opposer's family of "SEXY" marks as applied to Opposer's products, and Opposer's "Sexy Hair" and "Sexy Hair Concepts" names as used in connection with Opposer's business, that it is likely to cause confusion, mistake, and/or deception.

- 21. If Applicant is permitted to register "SEXY ROCK'N CHICK" for the goods set forth in the application, confusion of the relevant trade and public is likely to result, which will damage and injure Opposer.
- 22. On seeing Applicant's "SEXY ROCK'N CHICK" mark used in connection with Applicant's products, purchasers and potential purchasers are likely to believe in error that such goods are offered by or in association with or under license from Opposer or that Opposer and Applicant are affiliated.
- 23. Any defect, objection to, or fault found with Applicant's goods sold under its mark "SEXY ROCK'N CHICK" would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods and business.
- 24. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Sexy Hair Concepts LLC prays that registration of the mark of Application Serial No. 76/422,372 be refused and that this opposition be sustained.

A duplicate copy of this Notice of Opposition is enclosed herewith.

The required fee of \$300 may be charged to Deposit Account No. 02-0755 and any overpayment may be credited to this account.

Dated:	Respectfully submitted,
	•

Roberta Jacobs-Meadway
Patricia G. Cramer
Jody B. Greenberg
BALLARD SPAHR ANDREWS & INGERSOLL, LLP
1735 Market Street, 51st Floor
Philadelphia, Pennsylvania 19103-7599
(215) 665-8500

ATTORNEYS FOR OPPOSER

SETTLEMENT AGREEMENT

This Settlement Agreement ("Agreement") is made effective March 10, 2003 between Scry Hair Concepts LLC, a California corporation having an address of 9232 Eton Avenue, Chatsworth, CA 91311 ("SHC") and George Montgomery, a citizen of the United States having an address of 348 Shore View Lane, Encinites, CA 92024 ("Montgomery").

Whereas Montgomery has filed an application for registration of SOFTSEXY for non-medicated skin care preparations, shampons, conditioners and hair care styling preparations, serial no. 78-132674 (the Montgomery Application); and

Whereas SHC has raised an objection with respect to use and registration of the mark of the Montgomery Application for the goods identified therein:

Whereas the parties have exchanged information and materials and wish now to resolve amountly the potential dispute between them.

In consideration of the forgoing and in consideration of the undertakings set forth hereinafter and intending to be legally bound, the parties agree as follows:

- 1. Concurrent with his execution of this Agreement, Montgomery will execute the Assignment of Mark which is attached as Exhibit A and will forward the executed Agreement and Assignment of Mark to counsel for SHC.
- 2. Counsel for SHC will, within three (3) business days of the date of her receipt of the executed Agreement and Assignment of Mark, forward to Montgomery a check in the amount of \$500.00 and will not until such check is sent, release to SHC either the Agreement or the Assignment of Mark.
- 3. SHC commits to execute promptly and return to Montgomery a copy of
- 4. Montgomery commits to make no use of SBXY as a mark or component of a mark on or in connection with any hair care product or preparation
- 5. This Agreement is the entire agreement of the parties with respect to its subject matter and there are no other agreements or understandings, express or implied.
- 6. This Agreement is binding on the parties, their heirs, assigns, related

SEXY HAIR (

By: ____ Name:

Date:

05/24

CRORGE MONTGAMPON

Date:

Harch 6 (1200

PHIL A #1720#10 W

E . q

Form PTO-1594 RECORDATION FORM COVER SHEET U.S. DEPARTMENT OF COMMERCE		
(Rev. 10/02) OMB No. 0651-0027 (exp. 6/30/2005) TRADEMARKS ONLY U.S. Patent and Trademark Office		
Tab settings ⇔⇔⇔ ▼	y y y	
	Please record the attached original documents or copy thereof.	
1. Name of conveying party(ies): George Montgomery Individual(s)	2. Name and address of receiving party(ies) Name:_Sexy Hair Concepts, LLC Internal Address: Street Address: 9232 Eton Avenue City:_Chatsworth State:_CA_Zip:_91311 Individual(s) citizenship	
Additional numbered at	Inched D Voc Fd No.	
5. Name and address of party to whom correspondence concerning document should be mailed: Name: Roberta Jacobs-Meadway, Esquire	6. Total number of applications and registrations involved:	
Internal Address: Ballard Spahr Andrews & Ingersoll, LLP 51st Floor	7. Total fee (37 CFR 3.41)	
Street Address: 1735 Market Street	8. Deposit account number: 02-0755	
City: Philadelphia State: PA Zip:19103-7599		
DO NOT USE THIS SPACE		
9. Signature. Roberta Jacobs-Meadway Name of Person Signing Total number of pages including cover that all property and the statements are statements and the statements and the statements are statements and the statements are statements and the statements ar		

Mail documents to be recorded with required cover sheet information to: Commissioner of Patent & Trademarks, Box Assignments Washington, D.C. 20231

SIGNMENT OF TRADEMARK

WHEREAS, George Montgomery, a citizen of the United States of America, having an address of 348 Shore View Lane, Encinitos, CA 92024 ("Montgomery"), has adopted for his business the trademark SOFTSEXY;

WHEREAS, Sexy Hair Concepts, LLC, a California corporation having an address of 9232 Eton Avenue, Chatsworth, CA 91311 ("SHC"), is desirous of acquiring all right, title and interest in and to the said trademark, together with the business which pertains to the said trademark, and the application therefor, Scrial No. 78/132674;

WHEREAS, it is desired that the assignment of said application be made of record in the United States Patent and Trademark Office,

For good and valuation consideration, the receipt of which is hereby acknowledged, and intending to be legally bound hereby, said Montgomery hereby assigns to said SHC all rights, title and interest in and to the said trademark, together with the business which pertains to said trademark and the goodwill associated therewith, and the application therefor.

GEORGE MONTCOMERY

Dated: 3 - 6 - 0 =

PHL_A#1727316 v1

TRADEMARK RETURN POSTCARD		
ATTY SECTION DATE NO CEPT OF MAIL/CERT OF SERVICE/EXPRESS MA	LIOLO ATTY DOCKET NO. 081957	
OF: SVY HOLL CONCOS. LIC LA ASSESSION OF: SOUTH CONCOS. LIC LA ASSESSION OF THE FOREIGN OF THE FOLLOWING: TRADEMARK APPLICATION: USE _ITU SPECIMENS _ DRAWING PAGE RENEWAL APPLICATION AFF/DEC 8 / 15 / 8&15 AMEND TO ALLEGE USE STATEMENT OF USE REQ.EXT. TIME FOR SOU FOREIGN REG _ TRANSLATION COUNTRY _ REG. NO. AMEND/REQ. RECONSIDERATION	711	
OTHER (PAPER TITLE) FEE AUTH CHARGE B.S.A.I. DEPOSIT. ACCT. #	02-0755 \$ 40 —	



Ballard Spahr Andrews & Ingersoll, LLP 1735 Market Street - 51st Floor Philadelphia, PA 19103

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LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500

> FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

BALTIMORE, MD
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC
WILMINGTON, DE

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

February 20, 2004

via Federal Express

Sexy Hair Beauty Salon 12827 1/2 Washington BL. Los Angeles, CA 90066

Re:

Sexy Hair Concepts LLC and Sexy Hair Beauty Salon

Our file: 091203

Dear Sir or Madam:

This office represents Sexy Hair Concepts, LLC of Chatsworth CA (Sexy Hair) in connection with certain trademark and unfair competition matters.

SHC has for more than five years employed the name and mark SEXY HAIR and a family of SEXY HAIR marks in connection with hair care products and preparations marketed through salons.

The SEXY HAIR name and marks have been widely used and extensively promoted. Representative examples of such use and promotion are attached (Exhibit A).

SHC has taken steps to protect the SEXY HAIR marks, and it has secured numerous U.S. trademark registrations on the Principal Register of the U.S. Patent & Trademark Office. A printout of the pertinent information about a number of these registrations from the U.S. Patent & Trademark Office website is also attached (Exhibit B).

You will appreciate that the SEXY HAIR name and marks are valuable assets of SHC.

It has come to our attention that you are operating a salon under the name SEXY HAIR, as shown in the attached (Exhibit C).

This use of SEXY HAIR in connection with salon services is likely to cause confusion and has in fact already caused actual confusion as to the source of the services, or your

affiliation with SHC, all in derogation of the rights of SHC. Granted the nature and extend of SHC's use of is SEXY HAIR name and mark, and SHC's federal registrations, it is clear that you have proceeded with constructive if not with actual notice of the rights of SHC.

We are interested in a prompt resolution, however.

Accordingly, if you will do the following, we are prepared to resolve the matter without resort to litigation:

- 1. immediately take steps to terminate all use of SEXY HAIR in connection with salon services as a mark or name or component of a mark or name or otherwise to attract attention;
 - 2. cease all such use by the close of business on March 1, 2004;
- 3. confirm in writing by the close of business on February 24 that you will comply with all demands set forth herein; and
- 4. provide to this office by the close of business on March 8 a copy of all filings with the State made to replace SEXY HAIR with some name that does not include SEXY for any phonetic equivalent as a component.

If we do not receive the written commitment as requested, and if you do not terminate use of SEXY HAIR accordingly, we are authorized to bring suit against you with no further delay or discussion and to seek all relief available under 15 U.S.C. § 1117, copy attached (Exhibit D).

Any offer of compromise is without prejudice to any claim or demand that may be made for relief under Title 15 of the United States Code in the event that other action is required to terminate this infringement of the rights of Sexy Hair Concepts, LLC.

Very truly yours,

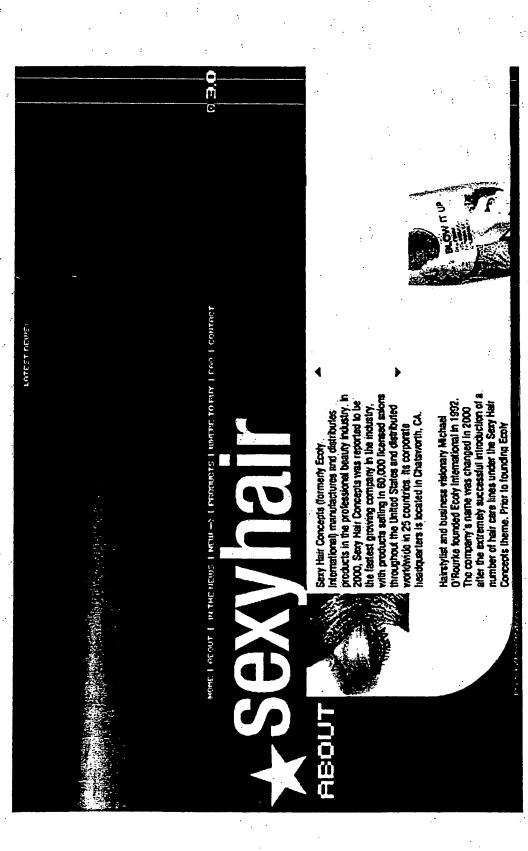
Robert Just his

RJM/vlm

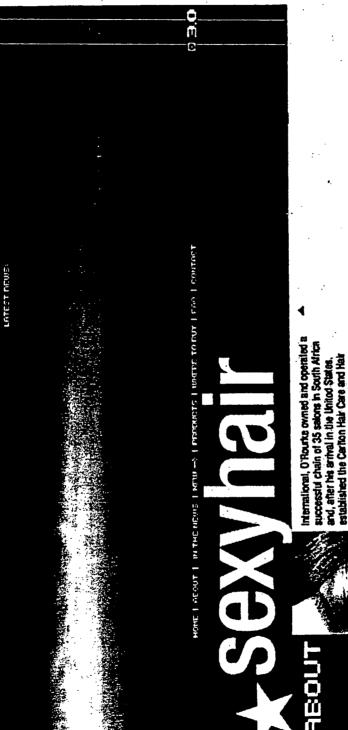
cc: Sexy Hair Concepts, LLC

Exhibit A

SCAY F



2774 PM



established the Certion Hair Care and Hair Health and Beauty Stores in Southern Catifornia, a chain of 30 salons and stores

Betow is a listing of professional brands distributed by Saxy Hair Concepts, which is constantly expanding as new products are

Professional Brands distributed:

- Big Sery Hair
 Curty Serv Hair

LATEST NEUS:

0 **3** 0

NOME | REQUT | IN THE NEWS | NEW \Rightarrow | PRODUCTS | UNABLIC TO BUY | FAX | CONTACT

Bolow is a listing of profossional brands distributed by Snry Hair Concepts, which is constantly expanding as new products are introduced.

Professional Brands distributed:

- Big Sexy Hair Curty Sexy Hair
- · Healthy Sexy Hair . Short Sery Hair
- Straight Sery Hair
 Wild Sery Hair

- Sex Symbol Cosmetic Enhancers · Formulas by Ecoh



big

LATEST NEWS:

NO OT STOROGY | V— HEN | CHISH SHI MI | INDIE | SHOW

0,∈ 0

Go ahead, touch it.



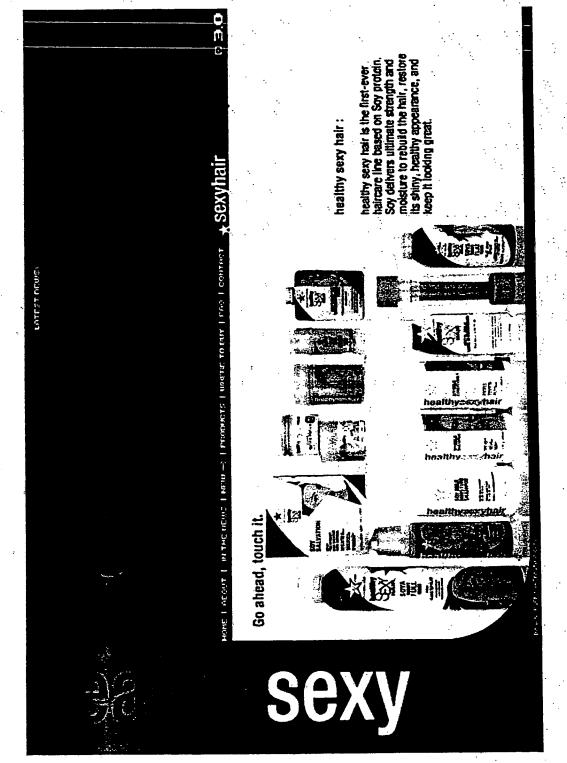
PROPERTY OF MICHAEL O'ROURKE

big sexy hair:

Specifically designed to add, support and enhance maximum fullness and body to the hair while maintaining moisture and protecting hair color from feding.

http://sexyhairconcepts.com/index_intro1.html

7/31/2003



Short

THE PROOF INTRODUCTION TO PRODUCTS INMERICATION INTO I CONTROL

Go ahead, touch it.

*Sexynall

9 6

short sexy hair:

Offers dust action products specially made for short hair to achieve the ultimate stylish look. The products can be combined together to create a unique, individual style.

Short Sexy Hair New Additions >>

PROPERTY OF MICHAEL O ROURKE

http://sexyhairconcepts.com/index_intro1.html

Sexy F.

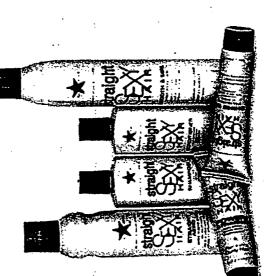
CATEST REUS:

Go ahead, touch it.

straightsexyhair

straight sexy hair:

Formulated to retax, temporarily straighten and protect hair from heat styling. These products also lock out humidity to keep hair straight, smooth and frizz-free all day.



7/31/2003



http://sexyhairconcepts.com/index_intro1.html

in concepts I a reporty on intichast o nounce j

Exhibit B

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-02-20 10:06:36 ET

Serial Number: 75634213 Assignment Information

Registration Number: 2403396 Assignment Information

Mark (words only): SEXY HAIR

Standard Character claim: No

Current Status: Registered.

Date of Status: 2000-11-14

Filing Date: 1999-02-05

Transformed into a National Application: No

Registration Date: 2000-11-14

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 - Warehouse (Newington)

Date In Location: 2003-11-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

SH 2785

GOODS AND/OR SERVICES

ir care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair mes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse

International Class: 003 irst Use Date: 1998-06-15

First Use in Commerce Date: 1998-12-21

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2000-11-14 - Registered - Principal Register

2000-08-22 - Published for opposition

2000-07-21 - Notice of publication

^000-06-03 - Approved for Pub - Principal Register (Initial exam)

1999-12-14 - Letter of suspension mailed

1999-10-18 - Communication received from applicant

1999-08-17 - Non-final action mailed

1999-08-04 - Case file assigned to examining attorney

1999-07-30 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY AKIN GUMP STRAUSS HAUER & FELD LLP ONE COMMERCE SQ STE 2200 2005 MARKET ST PHILADELPHIA PA 19103

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-02-20 10:07:14 ET

Serial Number: 75751842 Assignment Information

Registration Number: 2486702 Assignment Information

Mark



(words only): SEXY HAIR

Standard Character claim: No

Current Status: Registered.

Date of Status: 2001-09-11

Filing Date: 1999-07-15

Transformed into a National Application: No

Registration Date: 2001-09-11

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at <u>TrademarkAssistanceCenter@uspto.gov</u>

Current Location: 900 - Warehouse (Newington)

Date In Location: 2003-11-05

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Ecoly International, Inc.

Address:

coly International, Inc.

9232 Eton Avenue

http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=75751842

"natsworth, CA 91311

nited States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

hair care products for men, women and children, namely shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse

International Class: 003 First Use Date: 1998-06-15

First Use in Commerce Date: 1998-12-21

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

Lining and Stippling: THE MARK IS LINED FOR THE COLOR RED.

MADRID PROTOCOL INFORMATION

(JOT AVAILABLE)

PROSECUTION HISTORY

2001-09-11 - Registered - Principal Register

2001-06-19 - Published for opposition

2001-06-06 - Notice of publication

2001-01-23 - Approved for Pub - Principal Register (Initial exam)

2000-07-05 - Communication received from applicant

2000-07-05 - Communication received from applicant

2000-06-07 - Communication received from applicant

2000-01-20 - Non-final action mailed

1999-12-15 - Case file assigned to examining attorney

1999-12-07 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY AKIN, GUMP, STRAUSS, HAUER & FELD, LLP ONE COMMERCE SQUARE 2005 MARKET STREET, 22ND FLOOR PHILADELPHIA, PA 19 103-7086

Exhibit C



LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500

FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950

JACOBSMEADWAYR@BALLARDSPAHR.COM

BALTIMORE, MD
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

April 30, 2002

VIA OVERNIGHT MAIL

Teresa A. Lee, Esquire Pryor Cushman Sherman & Flynn LLP 410 Park Avenue New York, NY 10022-4441

Re:

Trademark Application for NOW EVERYONE GETS TO BE SEXY

owned by Sweetface Fashion Company, LLC

Your File: 08779.0001 Our File: 885200

Dear Teresa:

This has reference to our recent communications.

Please find attached two copies of the Agreement executed on behalf of Sexy Hair Concepts.

I look forward to receiving back from you a fully executed copy of the Agreement and confirmation that the agreed amendments have been entered.

Sincerely,

Roberta Jacobs-Meadway

RJM/cda

Enclosure

cc: Sexy Hair Concepts, LLP f/k/a Ecoly International, Inc.

AGREEMENT

This AGREEMENT (hereinafter the "Agreement") is entered into effective March ____, 2002 between Sexy Hair Concepts LLC, a California corporation having an address of 9232 Eaton Avenue, Chadsworth, California 91311 (hereinafter "SHC") as the successor in interest and title to the rights of Ecoly International, Inc. and Sweetface Fashion Company, LLC, a New York limited liability company having an address of 1071 Avenue of the Americas, Suite 502, New York, New York 10018 (hereinafter "Sweetface").

WHEREAS. Sweetface has made application for registration of the mark, NOW EVERYONE GETS TO BE SEXY (hereinafter the "Sweetface Mark"), as shown in U.S. Application Serial No. 76-302,825 and U.S. Application Serial No. 76-302,830 (hereinafter the "Sweetface Applications"); and

WHEREAS, SHC through its predecessor in interest and in title has requested extensions of time to oppose the Sweetface Applications based on its use of various marks containing the term "SEXY" for hair care products, namely; SEXY HAIR, Registration No. 2,403,396; FORMULAS BY ECOLY BIG SEXY HAIR, Registration No. 2,472,793; SEXY HAIR & DESIGN, Registration No. 2,486,702; and SEXY HAIR CONCEPTS & DESIGN, U.S. Application Serial No. 76-017,117 (hereinafter the "SHC Marks"); and

WHEREAS, the parties have exchanged information and materials and wish now to resolve the potential opposition to Sweetface's use and registration of the Sweetface Mark;

In consideration of the undertakings set forth hereinafter, and intending to be legally bound, the parties agree as follows:

08779.00001/269121

- Sweetface shall amend the Sweetface Applications to delete references to 1. hair care products (hereinafter the "Amendments"). Such Amendments will be filed within ten (10) business days of the date of Sweetface's receipt of a copy of this Agreement executed by SHC.
- Sweetface commits to make no use of the Sweetface Mark on and in 2. connection with any hair care products.
- Subject to Sweetface's adherence to Sections 1. and 2. above, SHC agrees 3. that it will not file any further Extensions of Time to File a Notice of Opposition, oppose or otherwise object to either or both of the Sweetface Applications and/or object to Sweutface's use and/or registration of the Sweetface Mark.
- SHC agrees that it will not use the Sweetface Mark on any products and/or services.
- Subject to Sweetface's and SHC's adherence to their mutual obligations as 5. set forth in Sections 1. through 4., inclusive, the parties agree that their respective uses of their marks can coexist in the marketplace and that confusion between the Sweetface Mark and the SHC Marks is highly unlikely. Accordingly, the parties agree not to oppose, cancel, or take any action to contest the use of each other's marks provided that each party adheres to the terms set forth herein.
- In the event that any instance of actual confusion in the marketplace 6. (hereinafter "Actual Confusion") should come to the attention of either party, such party will

2

From-PRYOR CASHMAN SHERMAN & FLYN LL D Apr-11-2002 05:41pm

> attempt to jointly remedy the causes underlying the Actual Confusion and shall use commercially reasonable efforts to attempt to avoid the recurrence of such Actual Confusion.

- SHC releases Sweetface, and its employees, agents, successors and assigns 7. from any liability and all liability, claims, demands, losses, or causes of action under the Lanham Trademark Act, 15 U.S.C. Section 1127, or under any federal or state law, common law or the law of any country or place related to or arising from the use or exploitation of the Sweetface Mark in connection with any goods and/or services that are the same as or related to the goods and/or services that will be noted in the Sweetface Applications subsequent to the filing Amendments as set forth in Section 1 hereinabove.
- Nothing contained herein shall be construed to preclude either party from 8. objecting to any use by the other of any other mark or name on or in connection with any other product or service.
- This Agreement is a binding agreement and constitutes the complete, final 9. and exclusive statement of the terms of the understanding between the parties with respect to the subject matter hereof and supercedes any and all other understandings, written or oral, prior or contemporaneous, with respect thereto. This Agreement may not be modified except by a written instrument signed by both parties. If any provision or provisions of this Agreement shall be held to be invalid, illegal or unenforceable, the validity, legality and enforceability of the remaining provisions shall not in any way be affected or be impaired thereby. A waiver of a breach or default under this Agreement shall not be a waiver of any other or subsequent breach or default. The failure or delay in enforcing compliance with any term or condition of this Agreement shall not constitute a waiver of such term or condition unless such term or condition

3

SEAL BY:

T-RIR P DOR/DIR F-448

is expressly waived in writing. This Agreement shall be governed by the laws of the State of New York, without reference to its provisions on conflicts of law. Each party represents that it has full power and authority to enter into and perform this Agreement, and that the person signing this Agreement on its behalf has been duly authorized and empowered to execute this Agreement. This Agreement shall be binding upon the parties hereto and inure to the benefit of the parties hereto, their respective successors and assigns.

[Signature page follows, remainder of page intentionally left blank]

4

IN WITNESS WHEREOF, the parties hereto have executed this Agreement, intending as of the date first above written,

By: Mark Stiller

2123280812

Title: Chief Financial Officer

SWEETFACE FASHION COMPANY, LLC

By: Andrew Hilfiger Title: Co-President

5

SH 1965

3:53 - 71-4

PRYOR CASHMAN SHERMAN & FLYNN LLP

410 PARK AVENUE, NEW YORK, NEW YORK 10022-4441

TELEPHONE: 212-421-4100 FAX: 212-376-0806

EMAIL: FIRM@PRYORCASHMAN.COM

WWW.PRYORCASHMAN.COM

WRITER'S DIRECT DIAL:

(212) 326-0831

writer's EMAIL: tlee@pryorcashman.com

May 6, 2002

VIA EXPRESS MAIL

Assistant Commissioner for Trademarks Trademark Trial And Appeal Board 2900 Crystal Drive Arlington, VA 22202-3513

2U SE785P742 T3

BOX: NO FEE

RE:

In the Matter of Sweetface Fashion Company, LLC

Appl. Serial Nos. 76/302,825 (cl. 3) and '830 (cl. 35)

Dear Sir or Madam:

On behalf of our client, Sweetface Fashion Company, LLC, enclosed herewith for filing is a Request to Amend the foregoing Applications in consideration of a mutual settlement entered into by and between Sweetface Fashion Company, LLC (hereinafter "Sweetface") and Sexy Hair Concepts LLC (hereinafter the "Potential Opposer") in the above-referenced matters:

- 1. two (2) originals and two (2) copies of Sweetface's REQUEST TO AMEND, with notice of service on Potential Opposer; and
- 2. a self-addressed, pre-stamped return post card that the U.S. Patent and Trademark Office is requested to stamp as "RECEIVED".

Very trally yours,

TAL:je Encls.

cc:

Sweetface Fashion Company, LLC (via Express Mail w/enclosures), Roberta Jacobs-Meadway, Esq. (via Express Mail w/enclosures),

ET 547928729 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Serial Nos. 76/302,825 (cl. 3) and 7 for the mark, NOW EVERYONE G	ETS TO	BE SEXY
SEXY HAIR CONCEPTS LLC	X	
as successor-in-interest of	:	
ECOLY INTERNATIONAL, INC. Potential	: :	
Opposer,	:	Opposition No.:
-against-	:	opposition 110
SWEETFACE FASHION	:	
COMPANY, LLC Applicant.	:	

APPLICANT'S REQUEST TO AMEND APPLICATIONS, WITHOUT PREJUDICE, IN CONSIDERATION OF MUTUAL SETTLEMENT ENTERED INTO BY AND BETWEEN THE PARTIES

Applicant SWEETFACE FASHION COMPANY, LLC (hereinafter "Sweetface" or "Applicant"), a limited liability company organized and existing under the laws of the State of New York, having a business address of 1071 Avenue of the Americas, Suite 502, New York, NY 10018, by its attorneys, Pryor Cashman Sherman & Flynn LLP, and *Potential* Opposer SEXY HAIR CONCEPTS LLC, as successor-in-interest to Ecoly International, Inc. (hereinafter "SHC" or "Potential Opposer"), a corporation organized and existing under the laws of the State of California, having a business address of 9232 Eaton Avenue, Chadsworth, CA 91311, by its attorneys, Ballard Spahr Andrews & Ingersoll, LLP, mutually agree to settle this matter that is

08779.00001/273937

the subject of the foregoing applications, and in an effort to resolve such differences, Sweetface hereby states, without prejudice, the following:

Sweetface initially filed with the United States Patent and Trademark (1) Office (hereinafter the "USPTO") an Application to register the mark NOW EVERYONE GETS TO BE SEXY (hereinafter the "Sweetface Mark") in connection with "cosmetics; facial makeup, concealers, blushers, facial powders, foundation makeup, eye makeup, eye pencils, eyebrow pencils, mascara, false eyelashes, cosmetic compacts, cosmetic pencils, lipstick, lip gloss, lip pencils, eye makeup removers, makeup remover creams, facial cleansers, toners, facial exfoliants, facial soaps, facial scrubs, facial creams, facial moisturizers, facial lotions and nonmedicated facial treatments; non-medicated topical skin creams, ointments, gels, toners, lotions, sprays and powders; exfoliants for skin and hair; fragrances, namely, perfumes, colognes, eau de parfum, eau de toilette and after-shave lotions; hand creams, skin moisturizers, body and hand moisturizing lotions, massage oils, bath beads, bath crystals, bath foam, bath gels, bath oils, bath powders, bath salts, bath soaps, skin soaps, bubble baths, body cleansers, body fragrances, body and hand lotions, body gels, body powders, body exfoliants, body scrubs, body creams, body oils, body masks, body mask powders, body mask lotions, body mask creams, shaving balm, non-medicated lip balm and lip creams; nail care preparations, nail polishes, nail polish removers, nail creams and artificial fingernails; sunscreen preparations, sunscreen wipe preparations, sun-tanning preparations, self-tanning preparations and after-sun lotions; hair care preparations, hair color and hair color removers; hair care products, namely, shampoos, conditioners, mousse, hair spray, hair gels and creams; antibacterial pre-moistened cosmetic wipe preparations for use on the skin; cosmetic pads, pre-moistened cosmetic wipes, pre-moistened

cosmetic tissues and towelettes; toothpaste; and deodorant" in cl. 3 (hereinafter the "cl. 3 Application")1, and an Application to register the Sweetface Mark in connection with "retail and wholesale stores featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; on-line retail store services featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; on-line ordering services featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; electronic retailing services via computer featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; retail store services, available through computer communications and interactive television, featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and

¹ Appl. Serial No. 76/302,825.

accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; providing an on-line computer database in the field of cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear" in cl. 35 (hereinafter the "cl. 35 Application")² (collectively referred to as the "Applications").

- (2) The subject Applications were filed on August 9, 2001. On September 30, 2001, both Applications were assigned to an Examining Attorney for review. On <u>same</u> date, both Applications were immediately approved for publication. Shortly thereafter, the Applications were published for opposition on November 27, 2001.
- (3) On December 17, 2001, SHC filed a Request for an Extension of Time to File a Notice of Opposition (hereinafter the "Extension") in connection with both Applications.³
- (4) Thereafter, the parties have been engaged in extensive negotiations in an effort to resolve the parties' differences concerning the subject Applications. The result of such negotiations is a Settlement Agreement now affected and entered into by and between the parties as of May 3, 2002 (hereinafter the "Agreement") memorializing certain terms and conditions in consideration of their mutual desire to resolve the instant matter. A copy of the subject Agreement is attached hereto as Exhibit A.
 - (5) As per numeral 1. as set forth in the subject Agreement, Sweetface hereby

² Appl. Serial No. 76/302,830.

³ Thereafter, SHC filed additional subsequent Extensions in connection with both Applications thereby extending its deadline to file a Notice of Opposition to May 26, 2002.

requests that the USPTO amend the subject Applications by deleting references to "hair care products" from each of the current goods and service descriptions noted in the Applications. Accordingly, the descriptions for each should be amended and entered as follows (hereinafter the "Amendments"):

- (a) In connection with the cl. 3 Application, please delete the identification of goods currently noted therein and insert in lieu of the same, the following goods description: "cosmetics; facial makeup, concealers, blushers, facial powders, foundation makeup, eye makeup, eye pencils, eyebrow pencils, mascara, false eyelashes, cosmetic compacts, cosmetic pencils, lipstick, lip gloss, lip pencils, eye makeup removers, makeup remover creams, facial cleansers, toners, facial exfoliants, facial soaps, facial scrubs, facial creams, facial moisturizers, facial lotions and non-medicated facial treatments; non-medicated topical skin creams, ointments, gels, toners, lotions, sprays and powders; exfoliants for skin; fragrances, namely, perfumes, colognes, eau de parfum, eau de toilette and aftershave lotions; hand creams, skin moisturizers, body and hand moisturizing lotions, massage oils, bath beads, bath crystals, bath foam, bath gels, bath oils, bath powders, bath salts, bath soaps, skin soaps, bubble baths, body cleansers, body fragrances, body and hand lotions, body gels, body powders, body exfoliants, body scrubs, body creams, body oils, body masks, body mask powders, body mask lotions, body mask creams, shaving balm, non-medicated lip balm and lip creams; nail care preparations, nail polishes, nail polish removers, nail creams and artificial fingernails; sunscreen preparations, sunscreen wipe preparations, sun-tanning preparations, self-tanning preparations and after-sun lotions; antibacterial pre-moistened cosmetic wipe preparations for use on the skin; cosmetic pads, pre-moistened cosmetic wipes, pre-moistened cosmetic tissues and towelettes; toothpaste; and deodorant"; and
- (b) In connection with the cl. 35 Application, please delete the recitation of services currently noted therein and insert in lieu of the same, the following service description: "retail and wholesale stores featuring cosmetic products, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; online retail store services featuring cosmetic products, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; on-line ordering services featuring cosmetic products, skin and nail products, toiletry products,

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(6) As per numeral 3. as set forth in the subject Agreement, SHC hereby agrees that SHC will not file any further Extensions, oppose, or otherwise object to either or both of the subject Applications and/or object to Sweetface's use and/or registration of the Sweetface Mark.

WHEREFORE, Applicant requests that the foregoing Amendments be entered (as noted in paragraph (5) above). Upon entrance of said Amendments, Applicant requests that the USPTO issue and send to both parties official notification confirming that said Amendments have been duly accepted and entered by the USPTO. Upon entrance and acceptance of the subject Amendments, Sweetface hereby requests that the USPTO immediately allow the subject Applications to proceed on to registration.

POWER OF ATTORNEY

Applicant hereby appoints Teresa A. Lee and Brad D. Rose, members of the Bar of the State of New York whose address is Pryor Cashman Sherman & Flynn LLP, 410 Park Avenue, New York, NY 10022, (212) 421-4100, as its duly authorized agents and attorneys in this matter to defend this *Potential* Opposition proceeding, to transact all business in the United States Patent and Trademark Office and in the United States Courts in connection with the *Potential* Opposition proceeding, to sign their names to all papers which may be hereinafter filed in connection therewith and to receive all communications relating to same.

Dated: New York, NY May 6, 2002

Respectfully submitted,

Bv:

Teresa A. Lee Brad D. Rose

Pryor Cashman Sherman & Flynn LLP 410 Park Avenue New York, NY 10022 (212) 421-4100

Attorneys for Applicant, Sweetface Fashion Company, LLC

CERTIFICATE OF MAILING BY EXPRESS MAIL

I, January Chuz hereby certify that on May 6, 2002, this Request to Amend Applications was deposited as "Express Mail" with the United States Postal Service addressed to:

Assistant Commissioner for Trademarks Trademark Trial And Appeal Board 2900 Crystal Drive Arlington, VA 22202-3513

"Express Mail" Label No. E T 5479 2873 = US

and to:

Roberta Jacobs-Meadway, Esq. Ballard Spahr Andrews & Ingersoll, LLP 1735 Market Street, 51st Floor Philadelphia, PA 19103-7599

"Express Mail" Label No. ET5479287294.

Signed: Janna Elkin

EXHIBIT A

AGREEMENT

This AGREEMENT (hereinafter the "Agreement") is entered into effective March 2, 2002 between Sexy Hair Concepts LLC, a California corporation having an address of 9232 Eaton Avenue, Chadsworth, California 91311 (hereinafter "SHC") as the successor in interest and title to the rights of Ecoly International, Inc. and Sweetface Fashion Company, LLC, a New York limited liability company having an address of 1071 Avenue of the Americas, Suite 502, New York, New York 10018 (hereinafter "Sweetface").

WHEREAS, Sweetface has made application for registration of the mark, NOW EVERYONE GETS TO BE SEXY (hereinafter the "Sweetface Mark"), as shown in U.S. Application Serial No. 76-302,825 and U.S. Application Serial No. 76-302,830 (hereinafter the "Sweetface Applications"); and

WHEREAS, SHC through its predecessor in interest and in title has requested extensions of time to oppose the Sweetface Applications based on its use of various marks containing the term "SEXY" for hair care products, namely; SEXY HAIR, Registration No. 2,403,396; FORMULAS BY ECOLY BIG SEXY HAIR, Registration No. 2,472,793; SEXY HAIR & DESIGN, Registration No. 2,486,702; and SEXY HAIR CONCEPTS & DESIGN, U.S. Application Serial No. 76-017,117 (hereinafter the "SHC Marks"); and

WHEREAS, the parties have exchanged information and materials and wish now to resolve the potential opposition to Sweetface's use and registration of the Sweetface Mark;

In consideration of the undertakings set forth hereinafter, and intending to be legally bound, the parties agree as follows:

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Apr-11-2002 08:41pm

- Sweetface commits to make no use of the Sweetface Mark on and in 2. connection with any hair care products.
- Subject to Sweetface's adherence to Sections 1. and 2. above, SHC agrees 3. that it will not file any further Extensions of Time to File a Notice of Opposition, oppose or otherwise object to either or both of the Sweetface Applications and/or object to Sweetface's use and/or registration of the Sweetface Mark.
- SHC agrees that it will not use the Sweetface Mark on any products and/or 4. services.
- Subject to Sweetface's and SHC's adherence to their mutual obligations as 5. set forth in Sections 1. through 4., inclusive, the parties agree that their respective uses of their marks can coexist in the marketplace and that confusion between the Sweetface Mark and the SHC Marks is highly unlikely. Accordingly, the parties agree not to oppose, cancel, or take any action to contest the use of each other's marks provided that each party adheres to the terms set forth herein.
- In the event that any instance of actual confusion in the marketplace (hereinafter "Actual Confusion") should come to the attention of either party, such party will

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attempt to jointly remedy the causes underlying the Actual Confusion and shall use commercially reasonable efforts to attempt to avoid the recurrence of such Actual Confusion.

- SHC releases Sweetface, and its employees, agents, successors and assigns 7. from any liability and all liability, claims, demands, losses, or causes of action under the Lanham Trademark Act, 15 U.S.C. Section 1127, or under any federal or state law, common law or the law of any country or place related to or arising from the use or exploitation of the Sweetface Mark in connection with any goods and/or services that are the same as or related to the goods and/or services that will be noted in the Sweetface Applications subsequent to the filing Amendments as set forth in Section 1 hereinabove.
- Nothing contained herein shall be construed to preclude either party from 8. objecting to any use by the other of any other mark or name on or in connection with any other product or service.
- This Agreement is a binding agreement and constitutes the complete, final 9. and exclusive statement of the terms of the understanding between the parties with respect to the subject matter hereof and supercedes any and all other understandings, written or oral, prior or contemporaneous, with respect thereto. This Agreement may not be modified except by a written instrument signed by both parties. If any provision or provisions of this Agreement shall be held to be invalid, illegal or unenforceable, the validity, legality and enforceability of the remaining provisions shall not in any way be affected or be impaired thereby. A waiver of a breach or default under this Agreement shall not be a waiver of any other or subsequent breach or default. The failure or delay in enforcing compliance with any term or condition of this Agreement shall not constitute a waiver of such term or condition unless such term or condition

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is expressly waived in writing. This Agreement shall be governed by the laws of the State of New York, without reference to its provisions on conflicts of law. Each party represents that it has full power and authority to enter into and perform this Agreement, and that the person signing this Agreement on its behalf has been duly authorized and empowered to execute this Agreement. This Agreement shall be binding upon the parties hereto and inure to the benefit of the parties hereto, their respective successors and assigns.

[Signature page follows, remainder of page intentionally left blank]

Apr-11-2002 DE:42pm

IN WITNESS WHEREOF, the parties hereto have executed this Agreement, intending as of the date first above written.

By: Mark Stiller

Title: Chief Financial Officer

Title: Co-President

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192.672

UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Trial and Appeal Board 2900 Crystal Drive Arlington, Virginia 22202-3513

Reference and the

August 1, 2002

Applicant: Sweetface Fashion Company, LLC

Serial No.: 76/302,830 Filed: August 9, 2001

Mark: NOW EVERYONE GETS TO BE SEXY

Sirs:

The proposed amendment filed by applicant on July 24, 2002, is noted. (A copy is enclosed for potential opposer).

The amendment requires consideration by the Trademark Examining Attorney in charge of this case. Accordingly, the application file is being forwarded to the Examining Attorney for consideration of the proposed amendment.

Pursuant to a request for extension of time to oppose granted May 13, 2002, the potential opposer herein, Ecoly International, Inc., has been allowed until May 26, 2002, in which to file an opposition to this application. Inasmuch as the filing of the amendment occurred prior to the expiration of potential opposer's extension of time to oppose, the filing of the amendment served to suspend the running of the extension period.

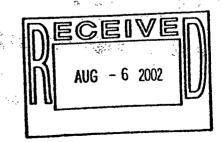
After the Examining Attorney has acted on the amendment, either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file, the application should be returned (through the Photocomp Coordinator at the Publication and Issue Section) to the Board; proceedings with respect to the potential opposition will be resumed; and further appropriate action will be taken with respect thereto.

Respectfully,

Henry D. Jefferson Legal Assistant,

Trademark Trial and Appeal Board

(703) 308-9330, Ext. 142



cc:

Roberta Jacobs-Meadway BALLARD SPAHR ANDREWS & INGERSOLL, LLP 1735 Market Street - 51st Floor Philadelphia, PA 19103-7599

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial Nos. 76/302,825 (cl. 3) and 76/302,830 (cl. 35) for the mark, NOW EVERYONE GETS TO BE SEXY

SEXY HAIR CONCEPTS LLC

as successor-in-interest of ECOLY INTERNATIONAL, INC.

Posential Opposer,

-against-

SWEETFACE FASHION COMPANY, LLC

Applicant.

Opposition No.:

APPLICANT'S REQUEST TO AMEND APPLICATIONS, WITHOUT PREJUDICE, IN CONSIDERATION OF MUTUAL SETTLEMENT ENTERED INTO BY AND BETWEEN THE PARTIES

Applicant SWEETFACE FASHION COMPANY, LLC (hereinafter "Sweetface" or "Applicant"), a limited liability company organized and existing under the laws of the State of New York, having a business address of 1071 Avenue of the Americas, Suite 502, New York, NY 10018, by its attorneys, Pryor Cashman Sherman & Flynn LLP, and *Potential* Opposer SEXY HAIR CONCEPTS LLC, as successor-in-interest to Ecoly International, Inc. (hereinafter "SHC" or "Potential Opposer"), a corporation organized and existing under the laws of the State of California, having a business address of 9232 Eaton Avenue, Chadsworth, CA 91311, by its attorneys, Ballard Spahr Andrews & Ingersoll, LLP, mutually agree to settle this matter that is

ONT79.000001/27303

the subject of the foregoing applications, and in an effort to resolve such differences, Sweetface hereby states, without prejudice, the following:

Sweetface initially filed with the United States Patent and Trademark (1) Office (hereinafter the "USPTO") an Application to register the mark NOW EVERYONE GETS TO BE SEXY (hereinafter the "Sweetface Mark") in connection with "cosmetics; facial makeup, concealers, blushers, facial powders, foundation makeup, eye makeup, eye pencils, eyebrow pencils, mascara, false eyelashes, cosmetic compacts, cosmetic pencils, lipstick, lip gloss, lip pencils, eye makeup removers, makeup remover creams, facial cleansers, toners, facial exfoliants, facial soaps, facial scrubs, facial creams, facial moisturizers, facial lotions and nonmedicated facial treatments; non-medicated topical skin creams, ointments, gels, toners, lotions, sprays and powders; exfoliants for skin and hair; fragrances, namely, perfumes, colognes, eau de parfirm, eau de toilette and after-shave lotions; hand creams, skin moisturizers, body and hand moisturizing lotions, massage oils, bath beads, bath crystals, bath foam, bath gels, bath oils, bath powders, bath salts, bath soaps, skin soaps, bubble baths, body cleansers, body fragrances, body and hand lotions, body gels, body powders, body exfoliants, body scrubs, body creams, body oils, body masks, body mask powders, body mask lotions, body mask creams, shaving balm, non-medicated lip balm and lip creams; nail care preparations, nail polishes, nail polish removers, nail creams and artificial fingernails; sunscreen preparations, sunscreen wipe preparations, sun-tanning preparations, self-tanning preparations and after-sun lotions; hair care preparations, hair color and hair color removers; hair care products, namely, shampoos, conditioners, mousse, hair spray, hair gels and creams; antibacterial pre-moistened cosmetic wipe preparations for use on the skin; cosmetic pads, pre-moistened cosmetic wipes, pre-moistened

cosmetic tissues and towelettes; toothpaste; and deodorant" in cl. 3 (hereinafter the "cl. 3 Application")', and an Application to register the Sweetface Mark in connection with "retail and wholesale stores featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; on-line retail store services featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; on-line ordering services featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; electronic retailing services via computer featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; retail store services, available through computer communications and interactive television, featuring cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and

^{&#}x27; Appl. Serial No. 76/302,825.

accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; providing an on-line computer database in the field of cosmetic products, hair, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear" in cl. 35 (hereinafter the "cl. 35 Application")² (collectively referred to as the "Applications").

- The subject Applications were filed on August 9, 2001. On September 30, (2) 2001, both Applications were assigned to an Examining Attorney for review. On same date, both Applications were immediately approved for publication. Shortly thereafter, the Applications were published for opposition on November 27, 2001.
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 - As per numeral 1. as set forth in the subject Agreement, Sweetface hereby (5)

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³ Thereafter, SHC filed additional subsequent Extensions in connection with both Applications thereby extending its deadline to file a Notice of Opposition to May 26, 2002.

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- (a) In connection with the cl. 3 Application, please delete the identification of goods currently noted therein and insert in lieu of the same, the following goods description: "cosmetics; facial makeup, concealers, blushers, facial powders, foundation makeup, eye makeup, eye pencils, eyebrow pencils, mascara, false eyelashes, cosmetic compacts, cosmetic pencils, lipstick, lip gloss, lip pencils, eye makeup removers, makeup remover creams, facial cleansers, toners, facial exfoliants, facial soaps, facial scrubs, facial creams, facial moisturizers, facial lotions and non-medicated facial treatments; non-medicated topical skin creams, ointments, gels, toners, lotions, sprays and powders; exfoliants for skin; fragrances, namely, perfumes, colognes, eau de parfum, eau de toilette and aftershave lotions; hand creams, skin moisturizers, body and hand moisturizing lotions, massage oils, bath beads, bath crystals, bath foam, bath gels, bath oils, bath powders, bath salts, bath soaps, skin soaps, bubble baths, body cleansers, body fragrances, body and hand lotions, body gels, body powders, body exfoliants, body scrubs, body creams, body oils, body masks, body mask powders, body mask lotions, body mask creams, shaving balm, non-medicated lip balm and lip creams; nail care preparations, nail polishes, nail polish removers, nail creams and artificial fingernails; sunscreen preparations, sunscreen wipe preparations, sun-tanning preparations, self-tanning preparations and after-sun lotions; antibacterial pre-moistened cosmetic wipe preparations for use on the skin; cosmetic pads, pre-moistened cosmetic wipes, pre-moistened cosmetic tissues and towelettes; toothpaste; and deodorant"; and
- (b) In connection with the cl. 35 Application, please delete the recitation of services currently noted therein and insert in lieu of the same, the following service description: "retail and wholesale stores featuring cosmetic products, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, all-purpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; online retail store services featuring cosmetic products, skin and nail products, toiletry products, fragrances, perfumes, colognes, jewelry, watches and accessories therefor, luggage and related bag items and accessories therefor, allpurpose sporting bags, business card and credit card cases and the like, attache cases and the like, umbrellas and parasols, clothing and footwear; on-line ordering services featuring cosmetic products, skin and nail products, toiletry products,

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Dated: New York, NY May 6, 2002

Respectfully submitted,

By:

Teresa A. Lee

Brad D. Rose

Pryor Cashman Sherman & Flynn LLP 410 Park Avenue New York, NY 10022

(212) 421-4100

Attorneys for Applicant,

Sweetface Fashion Company, LLC

CERTIFICATE OF MAILING BY EXPRESS MAIL

I, <u>Icanno Elkerhereby</u> certify that on May 6, 2002, this Request to Amend Applications was deposited as "Express Mail" with the United States Postal Service addressed to:

Assistant Commissioner for Trademarks Trademark Trial And Appeal Board 2900 Crystal Drive Arlington, VA 22202-3513

"Express Mail" Label No. ETSY 7928732US

and to:

Roberta Jacobs-Meadway, Esq.
Ballard Spahr Andrews & Ingersoll, LLP
1735 Market Street, 51st Floor
Philadelphia, PA 19103-7599

"Express Mail" Label No. <u>FT5479387294</u>

Signed: janna Elkin

EXHIBIT A

Apr-11-7002 05:41pm

From-PRYOR CASHIAN SHERMAN & FLYN LL D

2122280912

7-813 P.003/013 F-448

AGREEMENT

This AGREEMENT (hereinafter the "Agreement") is entered into effective March 2, 2002 between Sexy Hair Concepts LLC, a California corporation having an address of 9232 Eaton Avenue, Chadsworth, California 91311 (hereinafter "SHC") as the successor in interest and ritle to the rights of Ecoly International, Inc. and Sweetface Fashion Company, LLC, a New York limited liability company having an address of 1071 Avenue of the Americas, Suite 502, New York, New York 10018 (hereinafter "Sweetface").

WHEREAS, Sweetface has made application for registration of the mark, NOW EVERYONE GETS TO BE SEXY (hereinafter the "Sweetface Mark"), as shown in U.S. Application Scrial No. 76-302,825 and U.S. Application Serial No. 76-302,830 (hereinafter the "Sweetface Applications"); and

WHEREAS, SHC through its predecessor in interest and in title has requested extensions of time to oppose the Sweetface Applications based on its use of various marks containing the term "SEXY" for hair care products, namely; SEXY HAIR, Registration No. 2,403,396; FORMULAS BY ECOLY BIG SEXY HAIR, Registration No. 2,472,793; SEXY HAIR & DESIGN, Registration No. 2,486,702; and SEXY HAIR CONCEPTS & DESIGN, U.S. Application Serial No. 76-017,117 (hereinafter the "SHC Marks"); and

WHEREAS, the parties have exchanged information and materials and wish now to resolve the potential opposition to Sweetface's use and registration of the Sweetface Mark;

In consideration of the undertakings set forth hereinafter, and intending to be legally bound, the parties agree as follows:

09779.0000\/249131

Jul-24-2002 02:29pm

- 1. Sweetface shall amend the Sweetface Applications to delete references to hair care products (hereinafter the "Amendments"). Such Amendments will be filed within ten (10) business days of the date of Sweetface's receipt of a copy of this Agreement executed by SHC,
- 2. Sweetface commits to make no use of the Sweetface Mark on and in connection with any hair care products.
- 3. Subject to Sweetface's adherence to Sections 1. and 2. above, SHC agrees that it will not file any further Extensions of Time to File a Notice of Opposition, oppose or otherwise object to either or both of the Sweetface Applications and/or object to Swentface's use and/or registration of the Sweetface Mark.
- 4. SHC agrees that it will not use the Sweetface Mark on any products and/or services.
- 5. Subject to Sweetface's and SHC's adherence to their mutual obligations as set forth in Sections 1. through 4., inclusive, the parties agree that their respective uses of their marks can coexist in the marketplace and that confusion between the Sweetface Mark and the SHC Marks is highly unlikely. Accordingly, the parties agree not to oppose, cancel, or take any action to contest the use of each other's marks provided that each party adheres to the terms set forth herein.
- 6. In the event that any instance of actual confusion in the marketplace (hereinafter "Actual Confusion") should come to the attention of either party, such party will

2

FTOM-PRYOR CASHMAN SHERMAN & FLYN LL D

2128280812

attempt to jointly remedy the causes underlying the Actual Confusion and shall use commercially reasonable efforts to attempt to avoid the recurrence of such Actual Confusion.

- SHC releases Sweetface, and its employees, agents, successors and assigns from any liability and all liability, claims, demands, losses, or causes of action under the Lanham Trademark Act, 15 U.S.C. Section 1127, or under any federal or state law, common law or the law of any country or place related to or arising from the use or exploitation of the Sweetface Mark in connection with any goods and/or services that are the same as or related to the goods and/or services that will be noted in the Sweetface Applications subsequent to the filling Amendments as set forth in Section 1 hereinabove.
- Nothing contained herein shall be construed to preclude either party from objecting to any use by the other of any other mark or name on or in connection with any other product or service.
- This Agreement is a binding agreement and constitutes the complete, final 9. and exclusive statement of the terms of the understanding between the parties with respect to the subject matter hereof and supercedes any and all other understandings, written or oral, prior or contemporameous, with respect thereto. This Agreement may not be modified except by a written instrument signed by both parties. If any provision or provisions of this Agreement shall be held to be invalid, illegal or unenforceable, the validity, legality and enforceability of the remaining provisions shall not in any way be affected or be impaired thereby. A waiver of a breach or default under this Agreement shall not be a waiver of any other or subsequent breach or default. The failure or delay in enforcing compliance with any term or condition of this Agreement shall not constitute a waiver of such term or condition unless such term or condition

3

t-11- 5 : 2:25km

APT-11-2002 DE:41PD FICK-PRYOR CASHO-HERMAN & FLYR LL D

2123260812

T-818 P.008/018 F-448

is expressly waived in writing. This Agreement shall be governed by the laws of the State of New York, without reference to its provisions on conflicts of law. Each party represents that it has full power and authority to enter into and perform this Agreement, and that the person signing this Agreement on its behalf has been duly authorized and empowered to execute this Agreement. This Agreement shall be binding upon the parties hereto and inure to the benefit of the parties hereto, their respective successors and assigns.

[Signature page follows, remainder of page intentionally left blank]

SH 1558

SENT BY:

BALLARD SPAHR-

2123260812

-262 P.016/019 F-

Apr-11-2002 06:4200

From-PRYOR CASHAL SHERHAN & FLYN LL D

2123280812

T-813 P.007/018 F-448

IN WITNESS WHEREOF, the parties hereto have executed this Agreement,

intending as of the date first above written.

SEXY HAIR CONCEPTS, LLC

By: Mark Stiller

Title: Chief Financial Officer

SWEETFACE FASHION COMPANY, LLC

By: Andrew Hilfiger Title: Co-President

ς

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR PHILADELPHIA, PENNSYLVANIA 19103-7599 215-665-8500

FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

BALTIMORE, MD
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

October 8, 2003

via Federal Express

Ms. Mindi Smith 8210 Garden Grove Avenue Reseda, California 91335

Re:

U.S. Trademark Application Serial No. 76/433,440 for S.EXY L.OVELY U.NIQUE T.IMELESS

Our file 087918

Dear Ms. Smith:

This office represents Sexy Hair Concepts, LLC of Chatsworth CA ("SHC") in connection with trademark and unfair competition matters.

SHC has, since at least as early as June 1998, employed SEXY as the dominant component of its marks and name in connection with hair care preparations. The nature and extent of the business of SHC and its use of SEXY may be seen at the website, www.sexyhairconcepts.com.

SHC has taken steps to protect its SEXY marks and name and has secured U.S. Trademark Registration Nos. 2,403,396; 2,486,702; 2,553,996; and 2,636,664 among others.

SHC has taken steps to protect its marks and name from encroachment by others.

The application that you have filed for S.EXY L.OVELY U.NIQUE T.IMELESS, Serial no. 76/433,440, for, <u>inter alia</u>, hair mascaras, has come to our attention and is of concern granted the overlap in goods and the dominant nature of the term "SEXY" in your mark.

In the circumstances, we believe the matter may most simply be resolved if you would amend the description of goods to delete hair mascaras from the application, and commit to make no use of the mark on any hair care products or preparations.

Ms. Mindi Smith October 8, 2003 Page 2

Any offer of compromise is, of course, without prejudice to any claim or demand that may be made in the event that other action is deemed appropriate to protect the interests of SHC.

May we please hear from you with respect to your client's intentions in the matter by October 28, 2003.

Sincerely,

VSolvest Jack In

RJM/pgc

cc: Mark Stiller (via facsimile)

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500

FAX: 215-864-8999 WWW.BALLARDSPAHR.COM

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201

PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR@BALLARDSPAHR.COM

BALTIMORE, MD
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC
WILMINGTON, DE

November 21, 2003

via Federal Express

Brian J. Smith, Esquire 16000 Ventura Blvd. Suite 400 Encino, CA 91436

Re:

S.exy L.ovely U.nique T.imeless

Our file: 087918

Dear Mr. Smith:

Please find enclosed the agreement we have discussed, signed on behalf of Sexy Hair Concepts. If you concur that all is in order, please have the document signed on behalf of your client and return a copy of the same to me. I will then look forward to receiving a copy of the as-filed amendment to the application to delete the references to hair care products.

Very truly yours,

Roberta Jacobs-Meadway

RJM/vlm Enclosure

AGREEMENT

This Agreement is entered into effective December 1, 2003 between Sexy Hair Concepts, LLC, having an address of 9232 Eton Avenue, Chatsworth, CA 91311 (SHC) and Mindi Smith, d/b/a S.L.U.T. Cosmetics, having an address of 8210 Garden Grove Avenue, Reseda, CA 91335 (Smith).

Whereas Smith has filed application serial no. 76/433,440 to register S.exy L.ovely U.nique T.imeless (the Smith Application); and

Whereas SHC has filed a request to extend time to oppose registration of the mark of the Smith Application for the goods set forth therein; and

Whereas the parties have exchanged information and materials and wish to resolve amicably the potential dispute between them;

In consideration of the forgoing and in consideration of the undertakings set forth hereinafter, and intending to be legally bound, the parties agree:

- 1. Smith will within five (5) business days of the date of her receipt of a copy of this Agreement executed on behalf of SHC cause her counsel to file in the Trademark Office an amendment to the Smith Application to conform the Smith Application to the agreed use of the mark of such Application.
- 2. Smith agrees that the mark of the Smith Application will not be used on or in connection with any hair care product, any product intended for use in or on hair.
- 3. Smith agrees that when the mark of the Smith Application is depicted in any form in which it may visually be perceived, the initial letters "S" "L" "U" and "T" will always be presented more prominently than the remaining letters of the words which comprise the mark.
- 4. Smith further agrees that the letter segments "exy", "ovely", "nique", and "imeless" will always be presented in the same color, size, and typestyle, so that the term "Sexy" does not stand out from the remaining elements of the mark.
- 5. Subject to Smith's compliance with the above-stated terms of this Agreement, SHC waives any objection to the use or registration of the mark of the Smith Application for products other than hair care products.
- 6. This Agreement is the entire understanding between the parties with respect to its subject matter, and there are no other agreements or understandings, express or implied.
- 7. This Agreement may only be modified in a writing signed by the party to be bound.

PHL_A#1819711 v1

Date:

8. This Agreement is binding on the parties, their successors, heirs, assigns, related companies and affiliates.

Date:

UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Trial and Appeal Board 2900 Crystal Drive Arlington, Virginia 22202-3513

ROBERTA JACOBS-MEADWAY
BALLARD SPAHR ANDREWS & INGERSOLL, LLP.
1735 MARKET STREET - 51ST FLOOR
PHILADELPHIA, PA 19103

Mailed: December 18, 2003

Serial No.: 76433440

TAMMY LOGAN, LEGAL ASSISTANT

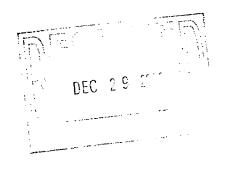
The request to extend time to oppose is granted until 1/14/04 on behalf of potential opposer SEXY HAIR CONCEPTS LLC

Please do not hesitate to contact the Trademark Trial and Appeal Board for any questions relating to this extension.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABVue at http://ttabvue.uspto.gov.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.



11-26-2003

U.S. Patint & TMOfc/TM Mail Rept Dt. #73

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS EXPRESS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, P.O. BOX NEW APP – FEE, 2900 CRYSTAL DRIVE, ABLINGTON, VA 22202-3513, ON THE DATE INDICATED BELOW

03

BOX TTAB - NO FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re

: Trademark Application of Smith, Mindi, d/b/a S.L.U.T. Cosmetics

Seria. No. : 76/433,440

Filed

: July 23, 2002

Mark

: S.EXY L.OVELY U.NIQUE T.IMELESS

Docket No. 885200

REQUEST UNDER RULE 2.102 TO EXTEND TIME FOR FILING NOTICE OF OPPOSITION

Commissioner Trademarks 2900 Crystal Drive Arlington, VA 22202-3513

Dear Sir:

In the matter of the above-identified application which was published in the Official Gazette of September 16, 2003, on page TM 200, Sexy Hair Concepts LLC requests that the time for filing a Notice of Opposition to the above application be extended for an additional period of thirty (30) days up to and including January 14, 2004. The extension of time is needed in order to review the file of the published application and to permit our client to consult with us about the advisability of filing an opposition.

Respectfully submitted,

PAHR AMDREWS &

Dated: November 24, 2003

Patricia G. Cramer Roberta Jacobs-Meadway 1735 Market Street - 51st Floor Philadelphia, PA 19103-7599 (215)864-8201 / (215)665-8500

ATTORNEY FOR POTENTIAL OPPOSER

Law Office of BRIAN J. SMITH

16000 Ventura Blvd., Suite 400 Encino, California 91436 Telephone (818) 783-7060 Facsimile (818) 501-7720

FAX COVER SHEET

FAX NO.:	(215) 864-9950	
FROM:	Brian J. Smith	
RE:	S.exy L.ovely U.nique T.imeless - Serial No. 76/433,440 Your File No. 087918	
DATE:	February 16, 2004	
TOTAL NU	MBER OF PAGES INCLUDING FAX COVER:9	
MESSAGE:	Please see attached.	

Not counting cover sheet, if you do not receive all pages, please telephone immediately at (818) 783-7060 to have missing pages transmitted.

CONFIDENTIALITY NOTICE: The document(s) accompanying this telecopy transmission contains confidential information belonging to the sender which is legally privileged. The information is intended only for the use of the individual or entity named above. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this telecopied information is strictly prohibited. If you have received this telecopy in error, please immediately notify the sender by telephone to arrange for return of the original document(s) to us.

Law Office of BRIAN J. SMITH

16000 Ventura Boulevard, Suite 400 Encino, California 91436

Telephone: (818) 783-7060

Facsimile: (818) 501-7720

February 16, 2004

YIA FACSIMILE (215) 864-9950

Roberta Jacobs-Meadway, Esq.
Law Offices of Ballard Spahr Andrews & Ingersoll, LLP
1735 Market Street, 51st Floor
Philadelphia, PA 19103-7599

Re:

S.exy L.ovely U.nique T.imeless - Serial No. 76/433,440

Your File No.: 087918

Dear Ms. Meadway:

Attached hereto please find an executed copy of the Settlement Agreement and a copy of the Amendment as submitted to the USPTO/TTAB.

Please advise the Board that SHC will not oppose the "Amended" trademark application and confirm same in writing to my office.

Your courtesy and cooperation is greatly appreciated.

Very traly yours

Grian J. Smith

Enclosures

AGREEMENT

This Agreement is entered into effective February 9, 2004 between Sexy Hair Concepts, LLC, having an address of 9232 Eton Avenue, Chatsworth, CA 91311 (SHC) and Mindi Smith, d/b/a S.L.U.T. Cosmetics, having an address of 8210 Garden Grove Avenue, Reseda, CA 91335 (Smith).

Whereas Smith has filed application serial no. 76/433,440 to register S.exy L.ovely U.nique T.imeless (the Smith Application); and

Whereas SHC has filed a request to extend time to oppose registration of the mark of the Smith Application for the goods set forth therein; and

Whereas the parties have exchanged information and materials and wish to resolve amicably the potential dispute between them;

In consideration of the forgoing and in consideration of the undertakings set forth hereinafter, and intending to be legally bound, the parties agree:

- 1. Smith will within five (5) business days of the date of her receipt of a copy of this Agreement executed on behalf of SHC cause her counsel to file in the Trademark Office an amendment to the Smith Application to conform the Smith Application to delete hair mascara and hair care products.
- 2. Smith agrees that the mark of the Smith Application will not be used on any hair care product, any product intended for use in or on the hair.
- 3. SHC agrees that Smith may use the mark of the Smith Application in any manner or fashion with regard to products that are not hair care products. Smith agrees that the term "sexy" as used in the Smith Application will not appear more prominent from the remaining elements of the mark.
- 4. SHC agrees that it has no right or interest in Smith's "S.L.U.T." trademark, Registration number 2421257, and Smith may use "S.L.U.T." or any phonetic equivalent on or in connection with products and services, including but not limited to, hair mascara and hair care products.
- 5. SHC acknowledges that Smith uses the S.L.U.T. trademark on and in connection with hair mascara and hair care products and SHC agrees to make no objection if "S.L.U.T." hair mascara is shipped with other of Smith's products in shipping boxes or other multi-product or unit outer/packaging which bears the mark of the Smith Application.
- 6. SHC agrees to make no objections to "S.L.U.T." hair mascara shown in a subsidiary manner as part of a background display of Smith's products in advertising or promotional materials for Smith's full product line bearing the mark of the Smith Application.

PHL A #1819711 v3

IN THE UNITED STATES TRADEMARK OFFICE TRADEMARK APPLICATION - PRINCIPAL REGISTER

In re Application:) Law Office 115	
Serial No.: 76/433440) Examiner: Robert (Coggins
For: S.EXY L.OVELY U.NIQUE T.IMELESS)	
Applicant: Smith, Mindi DBA S.L.U.T. Cosmetics)))	
Filed: July 23, 2002)	

Commissioner for Trademarks

Photocomposition Coordinators in the Publication and Issue Section of the Office.

BOX: NO FEE 2900 Crystal Drive

Arlington, Virginia 22202-3513

AMENDMENT TO IDENTIFICATION OF GOODS/SERVICES

Applicant hereby proposes to amend the identification of goods or services after publication by restricting or deleting items in the existing identification pursuant to TMEP §1505.01(a).

I. Goods and Services Amendment

Applicant hereby amends the following class of goods/services in the application as follows:

Mark: S.EXY L.OVELY U.NIQUE T.IMELESS

Serial No.: 76/33440

Page 2

A. <u>Original</u>

Beauty products, cosmetics, skin care products and accessories, namely,

lipsticks, lip glosses/stains, nail colors, eye shadows, eye shadows and eye shadow

applicator/brush, sold as a unit, eye color dust, eye liners, foundations, concealers,

make-up cover sticks, blushes and blush applicator/brush, sold as a unit, bronzers and

bronzer applicator/brush, sold as a unit, face powders and face powder

applicator/brush, sold as a unit, mascaras, glitter body gels, vitamin E Sticks for Lips

and Around Eyes, hair mascaras, lip and eye pencils, skin care cleansers, skin

masques, skin toners, skin lotions/creams, skin moisturizers, skin exfoliators, soaps,

fragranced body sprays and mists, eau de toilette, perfurne, cologne, fragranced body

wash and shower gels, eye gels/creams, body/face mists, and cosmetic cases

containing an assortment of the aforementioned goods in International Class 003.

B. <u>Proposed</u>

Beauty products, cosmetics, skin care products and accessories, namely,

lipsticks, lip glosses/stains, nail colors, eye shadows, eye shadows and eye shadow

applicator/brush, sold as a unit, eye color dust, eye liners, foundations, concealers,

make-up cover sticks, blushes and blush applicator/brush, sold as a unit, bronzers and

bronzer applicator/brush, sold as a unit, face powders and face powder

applicator/brush, sold as a unit, mascaras, glitter body gels, vitamin E Sticks for Lips

Mark: S.EXY L.OVELY U.NIQUE T.IMELESS

Serial No.: 76/33440

Page 3

and Around Eyes, lip and eye pencils, skin care cleansers, skin masques, skin toners,

skin lotions/creams, skin moisturizers, skin exfoliators, soaps, fragranced body sprays

and mists, eau de toilette, perfume, cologne, fragranced body wash and shower gels.

eye gels/creams, body/face mists, and cosmetic cases containing an assortment of the

aforementioned goods in International Class 003.

C. Specification of Amendment

The proposed amendment set forth above involves exclusively the elimination of

the words "hair mascaras" from the Goods and Services description.

II. Further Handling

Pursuant to TMEP Section 1505.02(c), involving "Processing Amendments in

Cases Where an Extension of Time for Filing an Opposition Has Been Granted,"

Applicant hereby requests that the Trademark Trial and Appeal Board suspend the time

for filing an opposition, and that the Board forward the file to the Photocomposition

Coordinators in the Publication and Issue Section of the Office to process the

amendment.

Mark: S.EXY L.OVELY U.NIQUE T.IMELESS

Serial No.: 76/33440

Page 4

III. Conclusion

Applicant respectfully requests that the above-referenced amendments be entered. Should you have any questions, please contact the undersigned.

Executed this February 14, 2004 at Reseda, California.

By:

Mindi Smith, Applicant 8210 Garden Grove Avenue Reseda, California 91335

mira miti

(818) 349-1838

email: mindee10@earthlink.net

Mark: S.EXY L.OVELY U.NIQUE T.IMELESS

Serial No.: 76/33440

Page 5

Certificate of Mailing under 37 C.F.R. Section 1.8:

I hereby certify that this correspondence is being deposited with **Federal Express** (Priority Overnight - Next Business Day Delivery) prepaid in an envelope addressed to: Commissioner for Trademarks, P.O. Box: No Fee, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on the date indicated below.

By:

Minds Smith

Date: February / i.o., 2004

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500
FAX: 215-864-8999

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SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

ROBERTA JACOBS-MEADWAY
DIRECT DIAL: 215-864-8201
PERSONAL FAX: 215-864-9950
JACOBSMEADWAYR®BALLARDSPAHR.COM

March 12, 2002

Via Fax

R. Scott Weide, Esq. Weide & Associates, Ltd. 11th Floor, Suite 1130 330 S. 3d Street Las Vegas, NV 89101

Re:

Appln. Serial No.:

76/240,849

For:

AS SEXY AS SKIN CARE GETS

Applicant:

Robert Schmidt

Our File No.:

892467

Dear Mr. Weide:

This office represents Sexy Hair Concepts, LLC in connection with certain trademark and unfair competition matters.

Sexy Hair Concepts, LLC uses and has used, through its predecessor in interest and title, a family of "SEXY" marks in connection with hair care products. The nature and extent of the use of the SEXY marks by Sexy Hair Concepts, LLC may be seen at the Company's website, www.sexyhairconcepts.com.

Sexy Hair Concepts, LLC has taken steps to protect its SEXY marks and has secured, inter alia, U.S. Trademark Registration No. 2,403,396 for the mark SEXY HAIR; Registration No. 2,472,793 for the mark FORMULAS BY ECOLY BIG SEXY HAIR; and Registration No. 2,486,702 for the mark SEXY HAIR & Design. A copy of the pertinent information about each of these registrations from the Patent and Trademark Office website is enclosed.

Sexy Hair Concepts, LLC recently learned that that your client, Robert Schmidt, has applied to register the mark AS SEXY AS SKIN CARE GETS for use in association with skin care products and hair care products.

In view of our client's established family of "SEXY" marks for hair care products, Mr. Schmidt's proposed use of the term AS SEXY AS SKIN CARE GETS in association with hair care products is of concern. Our client is willing to resolve this matter if Mr. Schmidt will:

R. Scott Weide, Esq. March 12, 2002 Page 2

- 1. commit to make no use of SEXY as a mark or component of a mark on any products for hair care;
- 2. amend the description of goods in Application No. 76/240,849 to delete "hair shampoo" and "hair conditioner;" and
- 3. commit to use and register the mark AS SEXY AS SKIN CARE GETS only in connection with skin care products.

Please let us know your client's intentions in connection with the matter at your early convenience. Of course, any offer of compromise is without prejudice to any claim or demand that may be made in the event further action is necessary for Sexy Hair Concepts, LLC to protect its interest in its SEXY family of marks for hair care products.

Sincerely,

RJM/cda Encl.

cc: Sexy Hair Concepts, LLC

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 03/12/2002 15:38:11 ET

Serial Number: 75634213

Registration Number: 2403396

Mark (words only): SEXY HAIR

Current Status: Registered.

Date of Status: 2000-11-14

Filing Date: 1999-02-05

Registration Date: 2000-11-14

Law Office Assigned: TMEG Law Office 104

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

Country of Citizenship: United States Incorporated in State: California Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse

International Class: 003 First Use Date: 19980615

First Use in Commerce Date: 19981221

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

SH 1854

PROSECUTION HISTORY

2000-11-14 - Registered - Principal Register

2000-08-22 - Published for opposition

2000-07-21 - Notice of publication

2000-06-03 - Approved for Pub - Principal Register (Initial exam)

1999-12-14 - Letter of suspension mailed

1999-10-18 - Communication received from applicant

1999-08-17 - Non-final action mailed

1999-08-04 - Case file assigned to examining attorney

1999-07-30 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY
AKIN GUMP STRAUSS HAUER & FELD LLP
ONE COMMERCE SQ STE 2200
2005 MARKET ST
PHILADELPHIA PA 19103
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 03/12/2002 15:38:32 ET

Serial Number: 75730741

Registration Number: 2472793

Mark (words only): FORMULAS BY ECOLY BIG SEXY HAIR

Current Status: Registered.

Date of Status: 2001-07-31

Filing Date: 1999-06-17

Registration Date: 2001-07-31

Law Office Assigned: TMEG Law Office 102

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

Country of Citizenship: United States Incorporated in State: California Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse

International Class: 003 First Use Date: 19980615

First Use in Commerce Date: 19981221

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

Prior Registration Number(s):

SH 1856

1866675

PROSECUTION HISTORY

2001-07-31 - Registered - Principal Register

2001-05-08 - Published for opposition

2001-04-25 - Notice of publication

2000-11-06 - Approved for Pub - Principal Register (Initial exam)

2000-03-31 - Communication received from applicant

1999-10-28 - Non-final action mailed

1999-09-27 - Case file assigned to examining attorney

1999-09-27 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY AKIN GUMP STRAUSS HAUER & FELD LLP 2005 MARKET ST 22ND FL ONE COMMERCE SQ PHILADELPHIA PA 19103-7086 United States **Smank you for your request. Here are the latest results from the <u>TARR web server.</u>**

This page was generated by the TARR system on 03/12/2002 15:38:47 ET

Serial Number: 75751842

Registration Number: 2486702

Mark



(words only): SEXY HAIR

Current Status: Registered.

Date of Status: 2001-09-11

Filing Date: 1999-07-15

Registration Date: 2001-09-11

Law Office Assigned: TMEG Law Office 102

CURRENT APPLICANT(S)/OWNER(S)

1. Ecoly International, Inc.

Address:

Ecoly International, Inc. 9232 Eton Avenue Chatsworth, CA 91311

United States

Country of Citizenship: United States Incorporated in State: California Legal Entity Type: Corporation

GOODS AND/OR SERVICES

hair care products for men, women and children, namely shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse

International Class: 003
First Use Date: 19980615

SH 1858

First Use in Commerce Date: 19981221

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "HAIR"

Lining and Stippling: THE MARK IS LINED FOR THE COLOR RED.

PROSECUTION HISTORY

2001-09-11 - Registered - Principal Register

2001-06-19 - Published for opposition

2001-06-06 - Notice of publication

2001-01-23 - Approved for Pub - Principal Register (Initial exam)

2000-07-05 - Communication received from applicant

2000-07-05 - Communication received from applicant

2000-06-07 - Communication received from applicant

2000-01-20 - Non-final action mailed

1999-12-15 - Case file assigned to examining attorney

1999-12-07 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Roberta Jacobs-Meadway (Attorney of record)

ROBERTA JACOBS-MEADWAY AKIN, GUMP, STRAUSS, HAUER & FELD, LLP ONE COMMERCE SQUARE 2005 MARKET STREET, 22ND FLOOR PHILADELPHIA, PA 19 103-7086 United States

SH 1859

EIDE

ILLER. I.I.

11th Floor, Suite 1130, Phoenix Building 330 South 3d Street Lis Vegas, NV 89101 Telephone (102) 382-4804 Facaimile (702)-382-4805

E-mail: SWcido@WeideMiller.com On the web: www. WeideMiller.com

R. SCOTT WEIDE REGISTERED PATENT ATTORNEY LICENSED IN CALIFORNIA & NEVADA

> May 6, 2002 VIA FACSIMILE

Ms. Lynn E. Rzonca Ballard Spahr Andrews & Ingersoll, LLP 1735 Market Street, 51st Floor Philadelphia, PA 19103-7599

Re:

Application Serial No.: 76/240,849 Mark: AS SEXY AS SKIN CARE GETS Our Reference No.: SMIDT.0001T

Your File No.: 892467

Dear Ms. Rzonca:

This is in response to Ms. Jacobs-Meadway's correspondence dated March 12, 2002, with respect to the above-referenced matter. As indicated therein, your firm's client, Sexy Hair Concepts, LLC is concerned about our client's use of the mark AS SEXY AS SKIN CARE GETS in

While we do not discern the legal right upon which your client has raised its objections, our client has indicated that he is not selling or distributing any hair care products under the mark and does not now intend to do so in the future. The U.S. Patent and Trademark Office has issued a Notice of Allowance for our client's mark for use with skin care and hair care products. When we prepare and file the Statement of Use with the U.S. Patent and Trademark Office, it will reflect use of the mark with skin care products and the registration will issue with the listed goods as skin care products (not including hair shampoo or hair conditioner). Thus, it would appear that your client's concerns and requests are satisfied. If you have any questions or concerns, please contact me.

ott Weide

cc. Robert Schmidt

rsw-10390.wpd 5/6/02

WEIDE & MILLER.Ld.

11th Floor, Suite 1130, Phoenix Building 330 South 3th Street Las Vegas, NV 89101 Telephone (702)-382-4804 Faosimile (702)-382-4805

E-mail: SWeide@WeideMiller.com
On the web: www.WeideMiller.com

R. SCOTT WHIDE REGISTERED PATENT ATTORNEY IJCENSED IN CALIFORNIA & NEVADA PATENT, TRADEMARK, COPYRIGHT & TRADE SECRET MATTERS

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To:

Ms. Lynn E. Rzonca

FIRM:

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

FACSIMILE NO.:

(215) 864-9278

FROM:

R. Scott Weide

REFERENCE NO.:

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May 7, 2002

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MESSAGE:

Please see attached letter.

LAW OFFICES

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

1735 MARKET STREET, 51st FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500
FAX: 215-864-8999

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BALTIMORE, MD
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DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

LYNN E. RZONCA
DIRECT DIAL: 215-864-8109
PERSONAL FAX: 215-864-9278
RZONCAL@BALLARDSPAHR.COM

May 7, 2002

R. Scott Weide, Esq. Weide & Associates, Ltd. 11th Floor, Suite 1130 330 S. 3d Street Las Vegas, NV 89101 FILE COPY

Re:

Appln. Serial No.:

76/240,849

For:

AS SEXY AS SKIN CARE GETS

Applicant:

Robert Schmidt

Our File No.:

892467

Dear Scott:

Thank you for your letter of May 6, 2002 confirming that your client, Mr. Schmidt, will make no use of the mark AS SEXY AS SKIN CARE GETS in conjunction with hair care products, and that any registrations that issues for the mark will not cover hair care products. We will, of course, monitor the situation to confirm that your client complies.

Contingent on such compliance, we will close our file on the matter, reserving our right to reopen the matter should your client fail to comply.

Thank you for your assistance.

Sincerely,

vnn/E. Rzonca

LER/maa

cc: Sexy Hair Concepts, LLC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

	X	•
	:	
Ecoly International, Inc.,	:	
	:	
Opposer,	:	
	:	Opposition No. 121,272
v.	:	
	:	
Kiss My Cosmetics Pty, Inc.,	:	
	:	
Applicant.	:	
	:	
	X	

STIPULATION TO EXTEND TIME TO ANSWER

The parties to the proceeding referenced above, have consented to and hereby jointly request, that the time for Applicant to Answer or otherwise respond be extended for thirty days, i.e., until February 17, 2001. The trial and testimony periods set in this case shall remain in effect.

The foregoing is consented to by the parties in order to provide sufficient time for the parties to discuss settlement.

This document is being submitted to the Board in triplicate.

Bazerman & Drangel, P.C.

Attorneys for Kiss My Cosmetics Pty, Inc.

1/15/2001 Dated:

By: Steven H. Bazerman

Jason M. Drangel

New York, NY 10165

Tel: 212-292-5390

Fax: 212-292-5391

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing STIPULATION TO EXTEND TIME TO ANSWER was served by First Class Mail, with sufficient postage prepaid, on this 15 day of January 2001, upon respondent's attorney:

Roberta Jacobs-Meadway Akin Gump Strauss Hauer & Feld 2005 Market Street, 22nd Floor Philadelphia, PA 19103-7086

Dated: January 15, 2001

New York, New York

Phyllis Buchálter

CERTIFICATE OF MAILING

I hereby certify that STIPULATION TO EXTEND TIME TO ANSWER is being deposited with the U. S. Postal Service as First Class Mail, with sufficient postage prepaid, in an envelope addressed to: BOX TTAB NO FEE, Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on January/5, 2001.

Dated: January 5, 2001 New York, New York

Phyllis Buchalter

TO KIM ETS

MARI 2

UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office Trademark Trial and Appeal Board 2900 Crystal Drive Arlington, Virginia 22202-3513

Ricks

MAILED
MAR 7 2001
PAT. & T.M. OFFICE

Opposition No. 121,272

Ecoly International, Inc.

v.

Kiss My Cosmetics Pty, Inc.

On February 1, 2001, applicant filed an abandonment of its application Serial No. 75/826,990.

Trademark Rule 2.135 provides that if, in an inter partes proceeding, the applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against applicant.

In view thereof, and because opposer's written consent to the abandonment is not of record, judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.

By the Trademark Trial and Appeal Board

THIS OPINION IS NOT A CITABLE PRECEDENT OF THE TTAB

Hearing: March 23, 2006

Mailed: April 20, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sexy Hair Concepts, LLC.
v.
Victoria's Secret Stores Brand Management, Inc. 1

Opposition No. 91125739 to Application No. 78094035 filed on November 19, 2001

Roberta Jacobs-Meadway of Ballard Spahr Andrews & Ingersoll for Sexy Hair Concepts, LLC.

Frank J. Colucci of Colucci & Umans for Victoria's Secret Stores Brand Management, Inc.

Before Quinn, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Sexy Hair Concepts, LLC. filed its opposition to the application of Victoria's Secret Stores Brand Management, Inc. to register the mark SO SEXY for "hair care products,"

¹ While the owner of record of the application when this opposition was filed was V Secret Catalogue, Inc., the USPTO records show that the current owner of this mark and application, via merger with V Secret Catalogue, Inc., is Victoria's Secret Stores Brand Management, Inc. The caption has been changed to reflect the current ownership.



namely, hair conditioner, hair dyes, hair glitter, hair highlighter, hair mascara, hair pomade, hair rinses, hair removing creams, hair shampoo, hair spray, hair straightener, hair styling gel and hair styling mousse," in International Class 3.²

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark SEXY HAIR for "hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse" as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

In particular, opposer asserts that it has used the mark SEXY HAIR in connection with hair care products since at least June 15, 1998, and so used this mark in commerce since at least December 21, 1998; that this mark is the subject of Registration No. 2403396, owned by opposer; that opposer also owns additional registrations - No. 2486702 for SEXY HAIR and design, and No. 2553996 for HOT SEXY HIGHLIGHTS for hair care products; that it owns a family of

² Application Serial No. 78094035, filed November 19, 2001, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

³ Registration No. 2403396, issued November 14, 2000, in International Class 3. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

SEXY marks for hair care products; that it has used the mark and trade name SEXY HAIR CONCEPTS since prior to November 19, 2001, in connection with hair care, skin care and cosmetic products; and that its marks and trade name are inherently distinctive in connection with opposer's business.

Applicant, in its answer, denied the salient allegations of the claim and asserted affirmatively, inter alia, that no one company is entitled to the exclusive right to use or register as a mark the word "sexy" for personal care products; that opposer does not have a family of SEXY marks; and that numerous third parties have registered or used the word "sexy" as part of marks for personal care and related products.

Both parties filed briefs on the case and submitted evidence by notice of reliance and through testimony, with exhibits. The Board has carefully reviewed the parties' respective evidence and arguments, and the familiarity of the parties therewith is presumed.

Factual Findings

Opposer has established its ownership and the validity of the following six registrations⁴:

⁴ Although Registration Nos. 2472793 (FORMULAS BY ECOLY BIG SEXY HAIR), 2707751 (WILD SEXY HAIR), and 2757856 (SEXY HAIR CONCEPTS and design) were not pled in the notice of opposition, we have considered them because applicant has not objected to the unpleaded registrations and moreover has treated them as of record. Therefore, the notice of

- Registration No. 2403396 for the mark SEXY HAIR for "Hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse," in International Class 3, with a disclaimer of HAIR apart from the mark as a whole. [Application filed February 5, 1999; Registered November 14, 2000; Sections 8 (six-year) and 15 affidavits accepted and acknowledged, respectively.]
- Registration No. 2472793 for the mark FORMULAS BY ECOLY BIG SEXY HAIR for "hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair crèmes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse" with a disclaimer of HAIR apart from the mark as a whole. [Application filed June 17, 1999; Registered July 13, 2001.]
- Registration No. 2486702 for the mark shown below for "hair care products for men, women and children, namely shampoos, conditioners, hair lotions, hair conditioning creams, hair gels, hair sprays, hair color, hair tint and hair mousse.," in International Class 3, with a disclaimer of HAIR apart from the mark as a whole and a statement that the trademark is lined for the color red. [Application filed July 15, 1999; Registered September 11, 2001.]



• Registration No. 2553996 for the mark HOT SEXY
HIGHLIGHTS for "hair care products for men, women and
children, namely, shampoos, conditioners, hair lotions,
hair conditioning creams, hair gels, hair sprays, hair
color, hair tint and hair mousse," in International
Class 3, with a disclaimer of HIGHLIGHTS apart from the
mark as a whole. [Application filed March 27, 2001;
Registered March 26, 2002.]

opposition is deemed amended to conform to the evidence under $\ensuremath{\mathsf{FRCP}}$ 15(b).

- Registration No. 2707751 for the mark WILD SEXY HAIR
 for "hair care products for men, women, and children,
 namely hair shampoos, hair conditioners, hair lotions,
 hair cremes, hair gels, hair sprays, hair color, hair
 dyes, hair rinses, hair mousse," in International Class
 3, with a disclaimer of HAIR apart from the mark as a
 whole. [Application filed May 22, 2001; Registered
 April 15, 2003.]
- Registration No. 2757856 for the mark shown below for "hair care products for men, women and children, namely hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, hair mousse," in International Class 3, with a disclaimer of HAIR apart from the mark as a whole. [Application filed June 10, 2003; Registered September 2, 2003.]



Opposer produces and distributes its own brands of hair care products (Mark Stiller discovery deposition "Stiller" at 9). Opposer's founder and CEO is Michael O'Rourke, a celebrity hair stylist. Mr. O'Rourke has an artistic team of about twenty people that assist him in putting out two haircut collections per year. He appears with opposer's hair care products at various celebrity events and in various media, including on television programs such as Good Morning America (Donna Federici testimonial deposition "Federici" at 17, 73). He also arranges for product placement of opposer's hair care products in movies and on

television shows such as The Tonight Show with Jay Leno and Queer Eye for the Straight Guy (Stiller at 36-37).

Opposer first developed the SEXY HAIR mark in 1998 and shipped its first product, a root pump, under the mark BIG SEXY HAIR in December 1998. In 1999, it expanded the BIG SEXY HAIR line to include additional products, and added additional brands, STRAIGHT SEXY HAIR and SHORT SEXY HAIR, each including approximately four to six different products. Additional brands, all featuring a number of products that have been added include CURLY SEXY HAIR (2000), HEALTHY SEXY HAIR (2001), WILD SEXY HAIR (2002), SILKY SEXY HAIR (2003), and HOT SEXY HAIR (2003). (Stiller at 11-16, 68.) For example, products under opposer's STRAIGHT SEXY HAIR line include Arrow Straight, Smooth and Seal, and Straight Shampoo and Conditioner (Federici at 33). While opposer has a few other hair care product lines that do not use SEXY as part of their marks, the product lines that use SEXY as part of their marks make up 90% of opposer's business, and this percentage increases each year (Stiller at 20). At the time of trial, opposer had sixty products identified by marks that include the term SEXY (Federici at 45).

Opposer sells its hair care products through distributors to professional salons and directly to professional salon chains. Opposer sells approximately 20-30% of its products directly to salon chains including

Regis, Ulta, Beauty Brands, JC Penney, Dollar Cuts and Beauty First. (Stiller at 40-41, 87.) Salons usually offer and sell a variety of hair care products from different manufacturers to their clients, the general consumer (id. at 40); and the salons use a small percentage of the hair care products they buy at wholesale in rendering hair care services to their clients (id. at 43). Opposer does not have data concerning the percentage of its products used by salons in rendering their services and the percentage sold directly to the salon's customers; nor does opposer have data pertaining to consumers' awareness of the brand of hair care products used by a salon in rendering its services.

Opposer's shampoos sell at retail for approximately \$6-7; and its styling products sell at retail for approximately \$18-19 (id. at 46). Opposer's products are mid-priced among professional brands. Opposer's principal competition consists of hair care products sold through salons, such as TG, Redken and Sebastian, as well as the professional salon lines of L'Oreal and Wella hair care products. (Id. at 47.) There is a small and regular, but unapproved, diversion of opposer's products to mass retailers such as Target, Wal-Mart and CVS for sale directly to consumers (id. at 31).

Opposer's sales of its hair care products identified by marks including the term SEXY to its professional clients are substantial, increasing from \$15 million in 2001 to

anticipated sales of \$34 million in 2004. International sales comprise less than 15% of these totals. For the ten months ending October 2003, opposer's net sales were approximately \$27 million, which translates into approximately \$50 million in sales by distributors to salons, which is approximately \$100 million in sales by salons to consumers. (Id. at 41-44).

Opposer conducts substantial advertising and promotion directed to salons, hair stylists and general consumers. Its promotional activities include distributing point-of-purchase displays and bi-monthly promotional materials for display by, as well as giving samples to, its professional clients; advertising in professional magazines such as Modern Salon and American Salon, and in consumer magazines such as Seventeen; personal and television appearances with the products by Michael O'Rourke; maintaining an informational website; providing booths at trade shows; holding regular educational seminars and demonstrations for professional hair stylists; and sponsoring a variety of events and donating to charities (See Stiller at 22-37; Federici at 65-80).

The packaging for opposer's products identified by marks including the term SEXY is consistent among the aforementioned brands. The containers are generally uniform in appearance. Most containers for the various products

include a small depiction of the mark shown in Registration No. 2757856, SEXY HAIR CONCEPTS and star design. All marks appear in the same lower-case font with SEXY appearing in a different color from other wording in the mark, the marks appear vertically down the side of the packaging (originally the marks appeared horizontally), and each brand has distinctive package coloring. (Stiller at 17-19.) For example, STRAIGHT SEXY HAIR products are in silver packaging and BIG SEXY HAIR products are in red packaging (Federici at 36).

The record includes print advertisements and promotions by opposer that show its various brands of products identified by marks including the term SEXY together and also as a business name or mark SEXY HAIR CONCEPTS.

(Stiller exhibits 5-10; Federici exhibits 36-43, 56-59 and 101-106.) For example, Stiller exhibits, consisting of promotional materials directed to professionals and salons, include the following:

2001 promotional material consisting of several pages directed to professionals. It includes the following copy on the first page: "Sexy Hair Concepts presents Sexy Package Deals for 2001!" and "Carry your SEXY with Style!" One of the products listed in the promotional package is "The Sexy Stylist Kit," which includes products from the BIG SEXY HAIR, STRAIGHT SEXY HAIR, SHORT SEXY HAIR, CURLY SEXY HAIR, and HOT SEXY HIGHLIGHTS lines, as well as a "Sexy Hair Concepts Stylist Bag." (Exhibit 5)

July/August 2002 promotional sheet directed to professionals advertises and pictures together the

BIG SEXY HAIR, STRAIGHT SEXY HAIR, HEALTHY SEXY HAIR, and CURLY SEXY HAIR shampoos and conditioners under the heading "STOCK UP NOW ON SEXY HAIR LITERS." (Exhibit 6)

January 2003 promotional material consisting of several pages, with the block lettering SEXY HAIR CONCEPTS (SEXY HAIR is one color and CONCEPTS is another) appearing vertically on the left-hand side of each page. There are separate entries advertising WILD SEXY HAIR, SHORT SEXY HAIR, STRAIGHT SEXY HAIR and HEALTHY SEXY HAIR products, as well as an entry advertising together "liter duos" of shampoo and conditioner of all of the preceding brands. (Exhibit 9)

Magazine advertisement featuring a photograph of Michael O'Rourke showcasing three of the brands that include SEXY as part of the mark, showing several products from each product line - SHORT SEXY HAIR, BIG SEXY HAIR, and STRAIGHT SEXY HAIR. The advertisement includes the copy "IT'S ALL SO SEXY!" (Exhibit 10)

Numerous articles in various publications ranging from newspapers and magazines to trade publications refer to opposer using the terms SEXY HAIR CONCEPTS and SEXY HAIR, and refer to opposer's line of products as the SEXY HAIR line (opposer's notice of reliance, September 17, 2004; Federici exhibits 60-65).

The record also includes articles in consumer and professional magazines that use the word "sexy" to discuss various types of haircuts, hair styles and products unrelated to opposer (Stiller exhibits A-L).

Opposer submitted excerpts of articles retrieved from the Lexis-Nexis database (notice of reliance September 17, 2004). Some of the excerpts refer to opposer as "Sexy Hair Concepts," and refer to its various hair care lines using the trademarks, such as SHORT SEXY HAIR. Some of these excerpts use the word "sexy" in a non-trademark manner unrelated to opposer. Some excerpts include both trademark and non-trademark uses of "sexy." The following are several examples:

"Michael O'Rourke formed Sexy Hair in 1999..." "The trendy edge led JCPenney to stock his wares, adding the Big, Short and Healthy Sexy Hair lines." [Los Angeles Daily News, June 28, 2003.]

"You won't pass for a true Maui maid without a glass-like sheen to your hair, so we suggest Sexy Hair Concepts' Straight Sexy Hair." [The Express, May 17, 2003.]

"Sexy Hair Concepts launched the Disruptive Texture Collection of haircuts ..." "John Paul Mitchell Systems features sexy looks this spring such as Tousled Texture..." [Household and Personal Products Industry, May 1, 2003.]

Article about the Chicago Midwest Beauty Show includes the following statements: "The booth of Italian company Dawa was doing a brisk business in flat irons with interchangeable patterned inserts, including some with the word 'sexy,' and had none left by the end of the show's second day." and "At Sexy Hair Concepts, a new product line called Wild Sexy Hair was being promoted" [Chicago Tribune, March 12, 2003.]

Article about Catherine Zeta-Jones' role in the movie "Chicago" includes reference to a Sexy Hair Concepts product used to style her wig, and a reference to her garters worn as part of her costume. The costume designer is quoted as saying, "I made the ones in the film, but Victoria's Secret has a very sexy line of them right now." [CNN.com, December 27, 2002.]

An article entitled "The hair care market: Hundreds of competing hair care brands answer increasingly diverse needs" includes the following: "This month Sebastian launched three new Raw hair products under the Xtah

line Xtah Loose Locks separates the hair with a flexible, sexy and 'undone' look." and "Sexy Hair Concepts ... introduced its new Healthy Sexy Hair Moisture Collection" [Household and Personal Products Industry, December 1, 2002.]

An article entitled "Hair Styling Update" includes the following statement about a study: "According to a study conducted by Yale University ... hair style can communicate a wide variety of perceived character traits, from intelligence to sexiness to whether the wearer may be the correct candidate for a job or trustworthy enough to date. ... The images showcased a variety of hairstyles which were rated by the respondents on a scale of one to six using adjectives: sexy, intelligent, outgoing, self-centered" The same article discussed various hair products, including reference to "Sexy Hair Concepts," naming several of its SEXY HAIR lines.

Opposer does not use the word "sexy" alone as a mark (Federici at 180), although opposer does use promotional language suggesting that use of its products will result in sexy hair (see Federici exhibits S-U). Opposer's senior vice president for sales and marketing, Donna Federici, stated her view that "sexy" is an emotional trigger word that is intended to motivate a buyer and, as such, is a powerful marketing tool (Federici at 143-148).

Applicant also submitted excerpts from numerous publications, including both publications directed to hair salon professionals and publications directed to the general consumer, that show use of "sexy" and "sexy hair" both in reference to hair generally and to opposer (notice of reliance, February 10, 2005). The following are several examples:

An article entitled "Love Sexy" in Hairdressers Journal International (January 11-17, 2002) is about opposer's SEXY HAIR products. It pictures together products from opposer's different brands that include the term SEXY in the mark, and calls them "The Sexy Hair Concepts Range."

An article entitled "Too Sexy" in American Salon, (March 2001) quotes opposer's CEO, Michael O'Rourke as stating "Sexy hair is exactly what we are about and I believed it was time to own it."

Opposer's senior vice president for sales and marketing, Donna Federici, is quoted in *Modern Salon*, (March 2001) as stating "The word 'sexy' is a powerful marketing tool ... It allows the consumer to drum up connotations on a very personal level."

An article in Salon (April 2001) entitled "Size Matters" discusses and quotes several celebrity hair stylists, including Michael O'Rourke. It includes the following statement: "This season Irvin Rusk has 'come hither' hair on his mind. Separated, loose locks with heaps of volume are the sexiest according to this style maverick..."

A make-over article in *Allure* (August 2002) entitled "The Beauty Insider," states "Allure found this Dallas student sipping coffee and gave her look a jolt with sexy curls and gleaming skin."

The cover of *Allure* (April 2001) includes the statement "Fresh Sexy Hair - Hollywood's Best Styles".

The cover of Mademoiselle (September 1998) includes the statement "Sexy Hair and Make-Up for a Melt-Proof Summer."

The cover of *Cosmopolitan* (undated) includes the statement "Super Sexy Ideas for Hair, Eyes, Mouth, Cleavage."

A sub-heading in an article entitled "Red Hot Hair" in Redbook (February 2000) is entitled "Sexy-Smelling Shampoos He'll Love."

An article entitled "Flaw Fixing Styles" in Redbook (October 2000) includes reference to "Sexy, Casual Hair."

Turning to applicant, the Victoria's Secret franchise, of which applicant is a part, includes a range of clothing and beauty products sold in its own lingerie stores and beauty stores, as well as catalog and Internet sales. Applicant considers its Victoria's Secret beauty products to be competitive with both the mass and prestige markets and priced between the two markets. (Sherry Helene Baker discovery deposition "Baker DD" at 44-46, 69.) These beauty products are sold only through its 500 Victoria's Secret beauty stores, of which about 100 are freestanding stores, about 300 are next door to Victoria's Secret lingerie stores, and about 100 are niches within Victoria's Secret lingerie stores (id. at 47-48). Between 1999 and April 2002, the only Victoria's Secret products that included "sexy" in the brand name were VERY SEXY FOR HIM, a fragrance for men, and a nail enamel color (id. at 12). Since April 2002, Victoria's Secret has launched a fragrance collection for women, the SEXY SECRETS COLLECTION, consisting of five different scents, including VERY SEXY FOR HER, and the VERY SEXY color (cosmetics) collection (id. at 12-13, 29-31).

Applicant's marketing image is intended to be consistent across the entire franchise and portrays young women as sophisticated, glamorous, and sexy. Applicant and

its related companies own several trademark registrations for marks including the term "sexy," such as BEACH SEXY, THE NEW SHAPE OF SEXY, and VERY SEXY, for various products, none of which include hair care products (applicant notice of reliance, February 10, 2005). Applicant's aspirational target market is educated, single, urban women in their midtwenties, although its actual market is much broader, encompassing essentially all general consumers. (Baker testimonial deposition "Baker TD" at 13-14, 36.) To demonstrate its image-marketing, applicant submitted sample pages from various Victoria's Secret catalogs dating back to at least 1997 that include the following copy:

- "Very Sexy Lingerie Collection" (IBC 0430),
- "The Very Sexy Plunge Bra, The New Shape Of Sexy" (IBC 0426),
- "8 super sexy panties any 3 for \$30" (IBC 0445),
- "Its all about a sexy look and how to get it." (IBC 0558),
- "Drop Dead Sexy and Very Comfortable" (IBC 0560),
- "Sexy Gowns & Chemises save \$10 each" (IBC 0573), and
- in its 2002 Christmas catalog, copy stating "A Very Sexy Christmas" (IBC 0424).

Applicant began discussing the development of a line of hair care products at the end of 2002 (id. at 17-18), test marketed the resulting products under the brand SO SEXY in

⁵ Many of the catalogs submitted by applicant are its "London" catalogs and, as there is no indication that these were distributed in the United States, they are of no probative value.

sixty to ninety stores (Kathi Van Zandt testimonial deposition "Van Zandt" at 18-19), and launched the product with a press release in the fall of 2004 (Baker TD at 22-23, 49-50). Since at least 1999 and prior to the product launch, applicant did not sell hair care products under the "sexy" mark, although an earlier hair care line was marketed under the brand VICTORIA'S SECRET GARDEN. The SO SEXY line, as tested, consists of six styling aids and eight shampoos and conditioners (id. at 23-25), and the packaging appears in different shades of pink because pink is part of Victoria's Secret's "iconic imagery" (id. at 25). Applicant decided not to name the individual products in the line in order to emphasize the SO SEXY name (id. at 39-40). product packaging includes the statement "Everyday, sexy hair, so shiny, so touchable, SO SEXY" (Van Zandt at 21; Exh. AA). At the time of trial, applicant had done no advertising of this product in any media (Baker TD. at 50). However, applicant did use a shelf-talker (Van Zandt Exh. BB) 6 in the test stores and sent a direct mail announcement to store credit card holders (Van Zandt at 23, Exh. DD). Opposer submitted an excerpt from an article in the August 2004 edition of Marie Claire, a beauty magazine, entitled "What's Hot." The article includes a paragraph about

⁶ The shelf-talker includes, in part, the following language: "New! So Sexy products offer everyone sexy hair everyday."

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Victoria's Secret's new SO SEXY hair care products entitled "Secret to Sexy Hair."

Applicant considers its competitors in the hair care products field to include Pantene, Herbal Essence, Paul Mitchell, Nexxus, Redken and Clinique (applicant's answers to interrogatories, no. 14, October 15, 2002).

Victoria's Secret launched another line of hair care products in 2004 identified by the trademark GARDEN SENSUOUS SHINE and sold in the same stores as the SO SEXY line (id. at 33). Applicant has decided that any additional hair care product lines it adds will not be marketed under the SO SEXY mark (Baker TD at 52).

Analysis

Standing.

Because opposer has properly made its pleaded registrations of record, and because opposer's likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority.

Opposer's pleaded registrations are of record and, therefore, Section 2(d) priority is not an issue in this

case as to the marks and goods covered by said registrations. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer began using several of its marks, including, at least, BIG SEXY HAIR (1998) and HEALTHY SEXY HAIR (2001), prior to the filing date of applicant's intent-to-use application on November 19, 2001, which is the earliest date on which applicant can rely.

Likelihood of Confusion.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24,

29 (CCPA 1976). See also In re Azteca Restaurant

Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999) and the cases
cited therein.

We turn first to the du Pont factor of the similarity of the goods. Opposer contends that the goods, all of which are hair care products, are essentially identical. Applicant does not dispute opposer's contention. In fact, there is a substantial overlap in the goods identified in the application and in the pleaded registrations. following goods are identical: hair conditioner, hair dyes, hair rinses, hair shampoo, hair spray, hair styling gel and hair styling mousse. Applicant's goods identified as "hair highlighter, hair mascara, hair pomade, hair straightener" are hair care products closely related to the hair care products identified in opposer's registrations because each product is used to care for or style hair, as are opposer's products. The remaining identified product, "hair removing creams," is also a hair care product and, as such, it is sufficiently related to opposer's hair care products that, if identified by a similar mark, confusion as to source is likely. Thus, we conclude that the goods of the parties are either identical or related products. This factor clearly favors opposer.

Applicant contends that the parties' respective channels of trade are different because its products are

sold only in its own stores to retail purchasers; whereas, opposer's products are primarily sold directly to professional hair salons and to distributors who, in turn, sell to professional hair salons; and that there is no evidence of the extent to which retail consumers are aware of opposer's brand on such goods. Applicant contends that the classes of purchasers for the parties' goods are different because the targeted purchasers of its goods are "sophisticated and highly educated" and opposer's products are distributed through professional hair salons and also directed towards a discriminating clientele." [Brief, p. 37.]

However, both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume that the hair care products of the applicant and opposer are sold in all of the normal channels of trade to all of the usual purchasers for goods of the type identified. See Canadian Imperial Bank v. Wells Fargo, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and classes of purchasers of the parties' goods are the same.

Moreover, while the record establishes that opposer markets and sells its products to professional salons, in addition to using the products on their clients,

professional salons sell these products as labeled by opposer to their clients. Some of opposer's advertising is clearly directed to this retail consumer. Regarding applicant, while the evidence shows that its identified goods are currently sold only through its own stores, the identification of goods, which determines our decision, is not so limited.

While professional salons are likely to be sophisticated and knowledgeable purchasers of hair care products, the evidence shows that salons carry hair care products from a variety of different producers to sell at retail to their clients, the general retail consumer. There is no evidence to warrant the conclusion that the parties' overlapping retail purchasers of hair care products are highly sophisticated or particularly discriminating as to such purchases, or that the products are sufficiently expensive that they would be purchased with a high degree of care. Therefore, the factors of the trade channels and classes of purchasers favor opposer.

We turn to the *du Pont* factor of the similarity of the marks. Opposer claims a family of marks based on the common term SEXY.

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of

similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Opposer contends that it has established a family of marks with the term SEXY as the common element of its family; that its SEXY marks are inherently distinctive; and that "SEXY does not immediately or directly describe any specific quality or characteristic of hair care products" (brief, p. 11). On the other hand, applicant contends that opposer has not met the requirements for establishing a family of SEXY marks and, further, that it cannot claim a family of SEXY marks because SEXY is a laudatory and commonly used term for the identified products.

We consider, first, applicant's contention that "sexy" cannot function as the common element of a family of marks because, essentially, it is not inherently distinctive in connection with hair care products. There is ample evidence submitted by both parties (see factual findings, supra) that "sexy" is an adjective that is used in

⁷ Because opposer does not own a registration or use a mark consisting of only the word "sexy," we do not consider this argument a collateral attack, in the absence of a counterclaim, on opposer's registrations.

connection with hair; and that "sexy" is a qualitative term applied to a wide variety of things. However, the record does not establish that "sexy" is merely descriptive or only laudatory with respect to hair care products. We take judicial notice of the definition in Merriam-Webster's Collegiate Dictionary (11th ed. 2003) of "sexy" as "1. sexually suggestive or stimulating: erotic. 2. generally attractive or interesting: appealing." "Sexy" is, at most, suggestive of an amorphous, yet desirable, quality of hair or hair care products. The advertising and articles of record clearly imply that a purchaser or reader should desire "sexy hair"; but it is not clear that "sexy hair" is a specific quality that means the same thing to all people. Particularly with respect to opposer's products, "sexy hair" could be straight, or curly or wild; or it could pertain to hair length, color or texture. The record does not establish a direct connection between the term "sexy" and a specific quality, characteristic, function, ingredient, attribute or feature of the identified hair care products or of hair after the use of these products. Therefore, "sexy" is, at most, a suggestive term that is inherently distinctive in connection with the identified goods.

Recognition of a family of marks is achieved when the pattern of usage of the common element is sufficient to be

indicative of the origin of the family. <u>Id</u>. In the present case, the evidence clearly establishes that opposer promotes a group of marks for which the common characteristic is the term "sexy." Except for the mark SEXY HAIR, opposer's family of marks is characterized by the term SEXY preceded by a word that suggests an intended result of the product and followed by a generic noun in the hair care field (e.g., SEXY HAIR, BIG SEXY HAIR, STRAIGHT SEXY HAIR, SHORT SEXY HAIR, HEALTHY SEXY HAIR, HOT SEXY HAIR, WILD SEXY HAIR, HOT SEXY HIGHLIGHTS).

The evidence establishes that consumers are likely to view marks following this pattern as having a common origin. Opposer advertises and promotes together its marks containing the word SEXY. For example, the different "SEXY" brands and their respective products are shown together on television, at trade shows, demonstrations, and seminars, and in promotional brochures for professional clients (see factual findings, supra). The SEXY element is emphasized by the use of different fonts and colors for the SEXY or SEXY HAIR portion of opposer's marks on packaging and in promotional materials. In addition to using the particular SEXY brand on products in promotional materials and advertising, opposer uses SEXY HAIR CONCEPTS or SEXY HAIR CONCEPTS and star design (with SEXY appearing larger and in a different font than other wording) on most packaging and

promotional materials across all SEXY brands, thereby reinforcing opposer's portrayal, and the likely perception by consumers, of SEXY as a common element among numerous hair care products from the same source. Opposer's significant advertising in this manner has resulted in periodicals discussing several of the SEXY brands together in articles about hair care and referring to the various brands as the SEXY HAIR or SEXY HAIR CONCEPTS "collection" or "line" of products (see factual findings, supra). We are persuaded that opposer has established a family of marks based on the common element SEXY.8

We consider, next, the strength of opposer's family of marks. Applicant would have us consider this question in the context of all "beauty products" rather than in the context of the more limited field of "hair care products." It is clear that applicant has used the term "sexy" in a non-trademark manner for many years both to cultivate its image and as a trademark in connection with lingerie and, more recently, with fragrances. Third parties have also used this term suggestively. However, we are not persuaded

⁸ Although opposer pleaded likelihood of confusion with respect to several of its individual marks as well as its family, its brief discusses likelihood of confusion only with respect to its family of marks, and we will therefore do the same.

⁹ Applicant contends that "the notion that its products are "sexy" is critical to its image and brand"; and that "[s]ince using 'sexy' as a marketing enticement is hardly novel or exclusive to any one company, [applicant] takes great care in fashioning a total brand and marketing image that is unique." [Brief, p. 6]

by applicant's argument. Not only is the record unclear as to the nature and scope of "the field of beauty products," but applicant's and opposer's respective goods are limited to hair care products that are either identical or closely related. Thus, we continue our consideration of the issue of likelihood of confusion, including determining the strength of the involved marks, in the context of the field of hair care products.

Applicant contends that marks using the term "sexy" are entitled to only a narrow scope of protection "preclud[ing] any one company in the beauty field from claiming any exclusivity to such term," apart from use in combination with other terms in a mark. [Brief, p. 4.] The record shows non-trademark use by third parties of the suggestive term "sexy" in writings about hair care. However, limiting ourselves to the field of hair care, the record contains few, if any, third party trademarks that include the term "sexy" for hair care products, other than opposer's family of marks and applicant's proposed mark. Further, the use of the term "sexy" as part of a mark, even in the expanded field of all beauty products, does not defeat or limit opposer's family of marks characterized by the term SEXY preceded by a word that suggests an intended result of the product and followed by a generic noun in the hair care field. Thus, opposer's family of marks is entitled to the

scope of protection normally accorded a family of marks for whom the common element is a suggestive, rather than an arbitrary, term, i.e., a more limited scope of protection than for an arbitrary mark. See Motorola, Inc. v. Griffiths Electronics, Inc., 317 F.2d 397, 137 USPQ 551, 553 (CCPA 1963) ("As a matter of logic it would seem to us that if opposer has a family of six marks all starting with the [same] word ..., it still has that family notwithstanding there may be some others using the same word").

Regarding the parties' respective marks, opposer argues that the parties' marks are substantially similar because SEXY is the dominant element of applicant's mark as well as of its family of marks; that VICTORIA'S SECRET forms no part of applicant's mark and should not be considered a distinguishing feature; and that the other components of opposer's marks are generic terms and, thus, the "emotive imagery" conveyed by its SEXY marks and applicant's SO SEXY mark is the same.

Applicant argues that the parties' marks are "strikingly different" in appearance [brief, p. 27], noting that the packaging for the parties' products is distinctly different; and that the connotations of the parties' respective marks is very different.

Opposer is correct that we will not consider VICTORIA'S SECRET as a distinguishing feature of applicant's mark, nor

will we consider the packaging of applicant's products, as neither forms a part of the mark in the instant application.

In comparing opposer's marks with applicant's mark, the question is not whether applicant's mark is similar to opposer's individual marks, but whether applicant's mark would be likely to be viewed as a member of opposer's SEXY family of marks. The Black & Decker Corporation v. Emerson Electric Co., ___ USPQ2d ___, Opposition No. 91158891, March 23, 2007 (TTAB). We agree with opposer that SEXY is the dominant element of applicant's mark, as well as the dominant element of opposer's family of marks and each individual mark. The terms preceding SEXY in opposer's marks suggest an intended result of the product (e.g., CURLY, STRAIGHT, HEALTHY). We take judicial notice of the definition in Merriam-Webster's Collegiate Dictionary (11th ed. 2003) of "so" as "to a great extent or degree: very, extremely." Applicant's mark, SO SEXY, can also be described as the term SEXY preceded by a word that suggests an intended result of the product, i.e., that the user's hair will be "so," or "very," SEXY. This is the same pattern that is used in opposer's family of marks. Although all but one of opposer's marks include the term HAIR following SEXY, neither party disagrees that "hair" is a generic term in connection with the identified hair care products. Thus, even though applicant's mark does not

include the term HAIR, it is the only possible object of the phrase SO SEXY.

We find that applicant's mark contains the same element, SEXY, that is common to all of opposer's family of marks and that, as discussed above, its mark also follows the common pattern present in opposer's family of marks so that applicant's mark is substantially similar to opposer's family of marks. This element of the similarity of the parties' marks favors opposer.

Finally, applicant argues that it is unaware of any instances of actual confusion between its mark and opposer's marks. However, while the record shows that applicant has made some use of its mark, the application remains based on intent-to-use. The record contains no indication that the nature and scope of applicant's and opposer's actual use of their marks have been such as to have created any meaningful opportunity for actual confusion to occur. The absence of actual confusion, under the seventh du Pont factor, therefore is counterbalanced by the absence of evidence of any opportunity for actual confusion to have occurred, under the eighth du Pont factor.

Therefore, we conclude that applicant's mark, SO SEXY, for hair care products is sufficiently similar to opposer's family of marks, for identical and related hair care products, that it is likely to be perceived as part of

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opposer's SEXY family of marks and, thus, confusion as to source is likely.

Decision: The opposition is sustained.





SCRUNCH SPRAY

FOR SEXY YOLUME SASSY BODY

8 FL, OZ, 237 ML



Sec 1997, 10 () 2849.